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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 1005

EARL E. HOWE,

Petitioner,

VS.

GENERAL MOTORS CORPORATION,

Respondent.

Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit

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Petitioner, Earl E. Howe, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in this case on October 16, 1968.

OPINIONS BELOW

For the Court's greater convenience (Rule 23 (i)), they are printed in a separate 70 page booklet, "Opinions and Statutes Accompanying Petition for Writ of Certiorari."

The opinions of the four trial court judges, of whom Judges La Buy and Perry heard the case before juries, are those of Judge Picard in a related case, *Earl E. Howe* v. *Atwood Vacuum Machine Co.*, 47 F. Supp. 979-990 (E.D. Mich., S.D., October 7, 1942) (D.A. III 2141-52; separately printed booklet pp. 1-9), in which, after trial for recovery of royalties from Atwood which had repudiated its sublicense from Howe under strange circumstances in the hope, with General Motors' aid, to defeat Howe's patent, the verdict was for Howe; of Judge La Buy in the case at bar, 54 C 1893, 167 F. Supp. 330 (N.D. Ill., E.D., October 17, 1958) (P.A. 51-62; printed booklet pp. 10-21), in which, after a separate trial before him alone on the defense of laches and acquiescence, he found for Howe (the jury later hung on the other issues); of Judge Perry, in the case at bar, 54 C 1893, on why he granted a new trial, *unreported,* but it appears in the proceedings before him on September 29, 1961, upon defendant's denied motion that he set aside the new trial order (D.A. III 2155-2160; printed booklet pp. 22-27); of Judge Robson, 252 F. Supp. 924 (April 5, 1966) (P.A. 734), in which he states his legal conclusion on the issue of validity "is not as clear-cut as might be desired" (printed booklet, p. 54) (issues of GM employee being prior inventor and infringement

were left open); and of the Court of Appeals for the Seventh Circuit, 401 F. 2d 473 (July 15, 1968), in which it stated "the analytical steps prescribed in *Graham* for the resolution of the obviousness issue were not as meticulously set forth as is desirable" (printed booklet, p. 59). The very brief opinion of the same Court denying the defendant's petition for mandamus to compel Judge Perry to set aside his order for a new trial, appears in 303 F. 2d 545 (April 23, 1962), but is not reprinted in the booklet. Substantially the same "prior art" was before the above four trial judges, in hearings lasting in the aggregate about four months.

JURISDICTION

The judgment of the Court of Appeals was entered on July 15, 1968. A timely petition for rehearing was denied on October 16, 1968. The judgment order was modified as to costs on November 13, 1968. By order, dated December 30, 1968, Mr. Justice Thurgood Marshall extended the time to petition for certiorari to, and including, February 3, 1969. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1). Request is made that the certified copies of the Court of Appeals' judgment orders of July 15, 1968, October 16, 1968, and November 13, 1968, and of its opinion of July 15, 1968, attached to the application to enlarge time, be transferred to the Record.

QUESTIONS PRESENTED

Petitioner secured letters patent directed to

> "a gooseneck hinge of the *pintle* or hinge pin type for swingingly supporting a door of an automobile from a curved body wall (that is, one with 'tumble in') with a double inclination of the hinge axis to compensate for the tumble-in angle of the body so that the door can swing in a substantially horizontal arc. All of the claims in the Howe patent are limited to a *concealed* hinge for supporting a door on a curved or inclined wall with the axis of the hinge having a double inclination so that the door in opening and closing swings through a substantially horizontal arc." (Judge La Buy's Finding No. 4, p. 11 of booklet of opinions, and P.A. 52)

The difference between petitioner's hinges and those made before his invention is that, whereas earlier hinges were relatively simple structures because they were adapted to support merely 10 or 15 lb. wood or composite doors in carriages or roadsters without tops, or pull down tops, and with their unmouldable, inflexible frames made of wood, or of wood with sheet steel nailed over them, petitioner's inclined hinges with inclined pintles supported the all-steel, modern, mouldable, curved, streamlined doors on all-steel, modern, mouldable, curved and streamlined automobile bodies, which door, with glass window sliding in it, weighed 100 or more lbs. His hinges, moreover, were so constructed and attached as to be *completely* and absolutely concealed from any inside or outside view when the door is closed, so as to eliminate and replace the unsightly, dust, dirt, grime collecting and wind resistant and noise generating, pro-

truding, and exposed hinges and to make it possible, at the same time, to align properly the swinging curved door into the curved body opening, a feat which now, in hindsight, seems simple and obvious but which baffled for almost a decade the leading hinge manufacturers, and auto makers, and which their extraordinarily skilled engineers stated could not be done without having at least one hinge on the door protruding and exposed to an outside view when the door was closed in closed bodies.

The question presented is whether the ruling of the court below, holding the patent issued to petitioner invalid for obviousness, departs seriously from the constitutional and statutory standard of invention, and the accepted and usual course of judicial proceedings.

STATUTES INVOLVED

The separately printed booklet, "Opinions and Statutes Accompanying Petition for Writ of Certiorari", contains verbatim Title 5 U.S.C. secs. 1; 597; 1091; 1009; and Title 35 U.S.C. secs. 101; 102; 103; 141; 145; 282.

STATEMENT

The Court of Appeals Record consists of four, very thick volumes. The buff-covered one, "Appendix to Brief for Plaintiff-Appellant" will be referred to herein as P.A. The others, blue-covered, "Appendix to Brief for Defendant-Appellee", will be referred to as D.A., with the number of the volume suffixed as I, II, and III. "Invention" means patentable invention, unless indicated otherwise. "Specification" means the totality of its three parts which will be referred to each, for greater clarity, as drawing, description, and claims.

This suit was brought against General Motors, under 35 U.S. secs. 281 and 284, to recover for infringement of an invention covered by United States Letters Patent No. 2,201,490, issued May 21, 1940, to petitioner, Earl E. Howe. The invention is a concealed type hinge structure whose axis, as well as the axis of its pintle, is inclined, both being completely and absolutely concealed from any inside and outside view when the door is closed. Simply stated, the Howe completely concealed and inclined hinge has, since its commercial adoption in 1940 by the leading automobile manufacturers to this very day, almost 30 years, replaced the conventional, exposed and protruding hinge, which was most unsightly, collected dirt, dust, grime, making lubrication difficult, and which resisted the wind and generated disturbing noises, and so affected the auto's progressive forward movement, at the same time that it made possible the easy alignment of a heavy all-steel, swinging curved door, carrying a heavy glass window, into the all-steel, curved automobile body opening to avoid excessive "tumble-in"

(i.e., too rapid closing of the door which would otherwise strike the foot and ankle, injuring and possibly maiming them, of a person entering or leaving the auto) and to permit the door to swing substantially parallel to the ground so it would fit into the curved all-steel closed body and close securely.

Earl E. Howe, now 75, became identified with the automobile industry at its infancy, in 1912 (D.A. I, 3, 613). Then just out of high school and a year of a collegiate level technological school, he became associated with the inventor of the demountable wheel and rim (under whose patents, GM was a licensee for over 20 years), as an assistant in development work in the Detroit area. Over the years, he has participated in, or made developments relating to the automobile. He had thus become acquainted, and was on friendly terms, with various engineering and other executives of General Motors. With many, he stood in a confidential relationship (D.A. I, 49, 311; D.A. II 1222-41; 1648-1653). When the mouldable, streamlined De Soto curved, all-steel automobile body replaced the square, inflexible, wood or composite frame bodies of automobiles (in 1930), how to hinge the heavy, curved, all-steel doors on the all-steel curved bodies to keep their front and rear doors from "tumbling-in" (making it hard to open the doors) became a very serious and vexing production and sales problem that never existed when conventional hinges were used on 5 to 10 lb. doors, as can be envisioned readily. Since the conventional hinges, moreover, were often not in alignment, pinch bars had to be used to "persuade" or "jimmy" the door and thus often bend the hinges to align the door with the body opening (Picard, J. opinion, separately printed booklet, p. 5).

The Howe hinges, being in alignment as the novel and unexpected result of his invention, overcame the difficulties theretofore due to misalignment.

Since everybody in the industry was aware of these problems, Howe naturally became aware of them also. He began to study and to experiment, in 1935, how to provide concealed hinging on "tumble-in" bodies without excessive lift in opening modern auto doors. He finally solved the problems, in early 1938, by a novel hinge construction based on principles that the prior art never taught manufacturers of hinges for the modern, curved and streamlined automobiles, nor the thousands of automobile stylists, design engineers, and various echelon experts employed by Ford, Packard, Studebaker, Nash, Chrysler, General Motors, who used hinges in auto assembly, nor other independent inventors, such as Howe, identified with the industry.

He disclosed his invention, soon after he filed his United States patent application, on January 9, 1939, and its novel, ingenious and unexpected mode of operation to his engineer and executive officer friends at General Motors in confidence, with the expectation of compensation, which they well understood, if they accepted his hinge as was very likely, since GM knew its well known competitors were about to. They recognized its novelty then ((D.A. I, 31-32), after they investigated his invention's patentability (D.A. I, 31; 33; 47-48; 51), and wanted to know if it could get a license (D.A. I, 32) for its Ternstedt Manufacturing Division which made its conventional hinge. Howe had made and demonstrated to its top executives and engineers a number of models and drawings, and even prepared and submitted full-size models for automobile installations (Judge La Buy's

opinion in separately printed booklet, p. 15, P.A. 56, Finding No. 17). Without taking a license, or compensating him (D.A. I, 30; 33; 51; 59; 749), GM began to use the Howe hinge structure on their "tumble-in" automobile bodies to keep abreast of its competitors, Packard, Chrysler, Studebaker, Nash, who were being supplied with the Howe hinge by Howe's sublicensee, Atwood Vacuum Machine Co. On June 21, 1940, soon after his patent issued, on May 21, 1940, Howe charged GM with infringement (Judge La Buy's opinion, separately printed booklet, p. 16, P.A. 57, Finding No. 21). He was given the "run-around" (D.A. I 40). At first, he was advised that his patent would be investigated, then that it was anticipated by prior patented and unpatented art (D.A. I, 29; 35-36; 54), and then, finally, that a General Motors employee was the prior inventor (D.I. 77; Judge La Buy's opinion, p. 16 in separately printed booklet; P.A. 57, Finding No. 17).

After prolonged and fruitless efforts to get recognition, Howe advised General Motors that he must look to the courts for protection (D.A. III, 1846-47).

In addition to Judge Picard's opinion (D.A. III, pp. 2141-62; separately printed booklet 1-9), the Record contains also Plaintiff's Exhibit No. 37 (D.A. III, pp. 1761-1772) which is a narrative of proceedings in the trial of *Howe* v. *Atwood* before him, in 1942. Judge Perry's opinion (D.A. III, pp. 2155-60; separate printed booklet, pp. 22-27) stated at pp. 25-27, having tried several score patent cases (D.A. II, 458):

> ". . . had it been a non-jury case, I would have found the patent good and would have found infringement, and that is really the heart of why I granted a new trial, because I think it is my duty

> to give my best opinion as to what justice should ultimately be and I thought it was a valid patent and I thought it was infringed. . . I spent over a month in trying that case. I spent hours and hours on the briefs in this matter. . . If ever I saw a good patent, that was it. . . It was my best judgment, and I told you my opinion as to the law and as to the facts is that there was a good patent, and that it was infringed . . . after spending five weeks in trial on it and then weeks going over the briefs, and so on, hours and hours."

The point will be developed further, under the section why the petition should be granted, that the decision as to the validity of the Howe patent, hereinafter referred to as '490, was for Judge Perry, and not for the jury, and that, consequently, his denials of the defendant's motions for a directed verdict and to set aside the order for a new trial were really a withdrawal of the issue of validity from the jury and a holding which became *res judicata* and foreclosed and precluded further trial before Judge Robson, unless and until the reviewing court reversed Judge Perry and remanded for a new trial.

GROUNDS FOR GRANTING THE WRIT

Graham, 383 U.S. 1, quoted the Reports in Congress that § 103 (separately printed booklet, p. 70) would have a stabilizing effect and minimize great departures which have appeared in the cases, and stated that it was added for uniformity and definiteness (383 U.S. at pp. 15, 18). It stated also that this section was cast in relatively unambiguous terms (at p. 14), implying it should be easy for the courts to follow. In the preparation of this Petition, Counsel has studied, with some care, about 125 decisions of reviewing courts in every Circuit, about 75 of which are post-*Graham,* to form some judgment as to trends. The impression is distinct that some courts continue to deliberately disregard this Court's guidelines in *Graham* and *U. S.* v. *Adams,* 383 U.S. 39,[1] while others, though giving lip service, nevertheless, disregard them in many instances. Most of them, however, are still confused and perplexed by such questions as whether prior art in Title 35 U.S.C. § 102 is pertinent on the issue of novelty under § 103, when a study of the history of the legislation indicates that § 102 references can go only to anticipation, or lack of novelty, and § 103 was made separately to go to lack of invention or obviousness only; whether the differences into which the court may inquire are solely structural or whether the purposes of the prior inventions and their results may be taken into consideration also under § 103; the differences in function between the courts and jury trials in patent infringement suits are being confused; what is meant by taking the subject matter of the claimed invention *as a whole*; the boundaries or pertinency of permissible

[1] See C.A. 7 instance, p. 28 of this Petition.

"prior art"; whether, in considering prior art which is non-anticipatory, it may consider disclosures in such prior art, nevertheless, on the issue of lack of invention or obviousness,[1] even though they may be speculative, vague or their elements render the structure inoperative; whether a non-file wrapper reference *per se* weakens or destroys completely the presumption of validity under § 282, or whether its relevancy and the presumption that the Patent Office did not overlook it must be considered first, the burden of proof to the contrary under § 282 being on him who asserts the destruction or weakening of the validity presumption, or whether the sounder rule should prevail that inquiry must first be made whether the file wrapper references are equally or more pertinent than an omitted reference; the distinction between the trial court's erroneous conclusions as to the ultimate question of patentability or its erroneous conclusions as to facts on which a conclusion rests; whether foreign patents and publications cited as anticipatory must meet the same tests as domestic ones under § 112; may a trial court disregard the "sub-tests" even though it may express doubt or reservation as to its legal conclusion on the validity issue.

The space allotted for a Petition, and much less that allotted to the section of the Petition for stating the grounds why it should be granted, will not permit a superficial treatment even of all these questions, nor even full treatment of some of the major ones only. If this Petition should be granted, they will be treated in depth in Petitioner's brief. Suffice it that, in Counsel's study of about 25 articles, notes and comments in sundry law reviews relating to these questions, he noted

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[1] *Toro* v. *Jacobsen*, 357 F. 2d 901, 902-903 (C.A. 7, March 4, 1966)

considerable agitation over the failure of a number of lower courts to resolve these problems satisfactorily; several have suggested, therefore, that this Court grant a few more writs to straighten out the kinks before they become too set in various circuits precedentially.[1]

As a result of this agitation, there is now pending in Committee S. 1042 for a drastic revision of Title 35, on which considerable hearings have been held. It will be reintroduced at this coming session of the Congress.

The case at bar, moreover, contains a fact pattern that takes it beyond *U. S.* v. *Adams* on which this Court does not seem heretofore to have established guidelines, in which case it may wish to set them forth for the guidance of the Bench and Bar in similar future situations. Herein will be considered also the presumption of the correctness of the decision of the Patent Office, until Title 5, §§ 1,597, 1001, 1009, and Title 35, §§ 141 and 142 (printed booklet, pp. 69 and 70) creating a double presumption in a patentee's favor. More space is prayed.

In the case at bar, Judge Robson's Decision on the Merits (P.A. 708-737, printed booklet, pp. 28-57) falls within that group of decisions that honor this Court's guidelines more by their breach than by their observance. It is needlessly prolix; though the trial ended before him on March 9, 1965, Judge Robson's decision was not announced until April 5, 1966. Seemingly, it was held up

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[1] The following articles seem to point in that direction: The 1966 Patent Cases, 54 Georgetown L.R. 1320 (Summer, 1966); Discussion of the *Graham, Calmar* and *U.S.* v. *Adams* cases, 34 Geo. Wash. L.R. 802 (1966); Insufficient Disclosure, Obviousness and the Reasonable Man, 49 J.P.O.S. 387 (June, 1967); Utility Requirement in § 101, 49 J.P.O.S. 533 (July, 1967); Impact of S. Ct. § 103 cases on Standard of Pat., 35 Geo. Wash. L.R. 818 (1967).

until this Court decided *Graham* and *U. S.* v. *Adams,* on February 21, 1966. *Graham* is referred to inadequately and in the *Conclusion* only (P.A. 734-736, printed booklet, pp. 54-56), as an appendage to what had been prepared before *Graham,* and as affording a seeming analogy of obviousness. *U. S.* v. *Adams,* whose factual pattern, as will be seen, the case at bar resembles very closely, it ignored entirely. The decision contains downright inaccuracies. It ignored the vital, critical facts needed to a correct determination that, as a matter of law, Howe's patent was anticipated and his claimed inventions were obvious to a skilled worker in the field. He merely compared the parties' respective views on each "prior art" reference without attempting even a definition of the "prior art" to which the patent's subject matter pertains, and without a critical, independent interpretation or evaluation, indulging in much generality, nor did he point out the disclosures specifically from which a legal conclusion could be drawn that Howe's claimed inventions *as a whole* would be obvious to someone whose level or skill he did not attempt to define either. There was no "substantial" compliance even with the steps that must be followed *strictly* to insure the objectivity, certainty and definiteness sought by § 103. The Record does not support Judge Robson's conclusions which seem to be more of the sought-to-be outmoded "judicial hunch" than a carefully prepared and reasoned judgment.

The threshold question is: Was Judge Perry's unequivocal and repetitive legal conclusion (pp. 9-10 of this Petition; P.A. 710, printed booklet, p. 30; D.A. III 2158-59, printed booklet, pp. 25-26) that the patent in suit was valid and infringed, upon denial of defendant's motions for directed verdict (P.A. 87-95, 103, 104; D.A. III 2161-62), and to set aside his order for a new trial

(D.A. III 2153, 2155-60) tantamount, in principle and in the "accepted and usual course of judicial proceedings", a withdrawal from the jury of that determination, since it was beyond the jury's province to decide the patent's invalidity, so that it was error for District Judge Robson to proceed to again give judgment on the validity issue, sitting virtually in review of District Judge Perry's determination, and it was error for the Court of Appeals to sanction Judge Robson's departure? It denied, however, on April 23, 1962, the defendant's petition for mandamus against Judge Perry.

It is to be noted, parenthetically, that the proceedings before Judge La Buy comprise the entire 850 pages of D.A. I, and he, likewise (after hearing virtually all that Judge Perry later heard, both having heard more than Judge Robson heard later still) denied two motions of defendant for directed verdict (during the jury trial, P.A. 9, on May 27, 1960; after the close of all the evidence on validity and infringement before the jury, P.A. 10 and 11, on September 27, 1960).

In *Swofford* v. *B & W,* 395 F. 2d 362 (C.A. 5, 1968), the trial judge, in a patent infringement suit heard before a jury, withdrew from the jury the determination of the validity issue and was upheld in an exhaustive and scholarly review of the law on the subject since *Keyes* v. *Grant,* 118 U.S. 25, 37 (1886) to date, stating this is the law in the Seventh, as well as in other, Circuits, citing *Armour* v. *Wilson,* 274 F. 2d 143, 147 (1960), which was before Judge Perry and a jury heard the case, and concluding so recently: "We find no recent decision holding otherwise."

At almost the very outset of his decision, Judge Robson states the Record incorrectly in at least three respects,

indicating that it was not prepared with the degree of thoroughness that the case warranted, after three equally able judges had preceded him in longer trials. For example, P.A. 711, printed booklet, p. 31, states that notice of infringement was given on "July 10, 1942." The Record shows it was given on June 21, 1940, about two years earlier and one month after 490 issued on May 21 1940 (P.A. 57, booklet 16, Judge La Buy's Finding No. 21). Immediately following, the decision purports to state the charge in the Complaint (filed December 17, 1954) (P.A. 28) and Supplemental Complaint (filed November 6, 1958) (P.A. 64), creating the impression that "front" door hinges only were charged to infringe. Par. 4 of the Complaint does not so limit the charge. His decision then set out the charge specifically (P.A. 712, booklet, p. 32, footnote 1). Item Nos. 12, 14, 18, 26, and 36, which appeared in par. 4 of the response, on April 1, 1955, for a more definite statement (P.A. 43) are all for rear doors (the items are listed and described in P.A. 38-42).

Again, the statement further down on the same page (P.A. 711, booklet, p. 31) quotes the first par. of 490 and proceeds to construe it so as to lay the foundation for an agreement with defendant's urged construction that Howe sought broad claims to cover a *concealed* hinge which embraced partially concealed hinges or hinges concealed in a manner other than shown by the '490 specification, in any *milieu* and for any purpose, directly contrary to the teachings of Howe's claims, construed properly in the light of his description and drawings (P.A. 720, booklet, p. 40, last par.). On the basis of this erroneous construction, it was inevitable Howe's claims would read on the art adduced by the defend-

ant, and so would be invalidated for anticipation (Judge Robson decision, P.A. 710, booklet, p. 30).

The reviewing court stated, however, that "Defendant did not prove, as prior art, any similar combination in tumble-in bodies" (P. 66, bottom of printed booklet), but, considering the tumble-out prior art on the issue of obviousness, "It is *perhaps possible* to say that the Howe patent claims were *anticipated* by the tumble-out prior art." Here is an example of confusion between §§ 102 and 103 and lack of definiteness and certainty. Judge Robson's opinion seems to have dropped the conclusion of anticipation with which the decision began (P.A. 710, booklet, p. 30) when he reached the *Conclusion* which was devoted exclusively to analogizing *Graham* on the issue of obviousness. Judge Robson then passed the issue of infringement (P.A. 736, booklet 56). The decision thus really turns on whether what Howe did would have been obvious to engineers of substantial training, and specialized skill, the level of skill "in the pertinent art" which the reviewing court found to fill the gap in Judge Robson's decision (Booklet, p. 67, top). Neither Judge Robson, nor the reviewing court, referred to *U. S.* v. *Adams.*

The Record does not support in the slightest Judge Robson's conclusion that the defendant's cited prior art taught Howe his invention or that it was miniscule. To understand what Howe did, it is well to study Howe's full testimony of the meaning of his specification and how GM copied it (P.A. 625-680). In reviewing '490, (D.A. III 2148-2151, booklet 5-8), Judge Picard summed up the 1939 B.O.P. and Smith's 1936 patent defenses in a nut shell:

> "There is also some evidence that the double inclination principle was in the 1937 Chevrolet car, the first showing of which was made in 1935. In fact, defendants claim that thousands of cars embodying the Howe patent were on the streets in 1937 except that the body tumbled out instead of in. But another distinction was that the hinges were exposed. Here the hinges are concealed and of the gooseneck type, *undoubtedly patentable in itself*. We believe it is fair to assume that if this idea was so prevalent in 1938 defendants should have known about it. Atwood Vacuum was in the hinge business and we cannot understand their interest in plaintiff's hinge in 1939-40, particularly their desire to insure the proper scope of the claims, if such a hinge was already on the market."

In his deposition, Ward, of Fisher Body's Patent and New Devices Section, swore (D.A. I, 143), referring to Howe's drawing (P.A. 691) of his invention, dated August 23, 1937 (within the 2 year statutory period of filing his application on January 9, 1939), that "if proved, would antedate our first product showing a compensating hinge arrangement in which at least one of the hinge units is concealed." Judge Picard's opinion states the Howe drawing antedated GM's of November, 1937 (D.A. III 2150, booklet 7). Howe testified he made his first drawing in March, 1937.

The Record supports the conclusion that what Howe did was novel, ingenious, inventive and produced unexpected results. P.A. 123-24 and 134-40 recited in considerable detail Fisher Body's activities, and that of the Ternstedt Division which made the hinges for Fisher Body, during the 1935-1938 period, to support their defense they solved the hinge problem then. Yet P.A. 212-214 shows that when Howe met one of the Fisher Bros.,

in early 1939, after his patent application was on file, in the office of P. J. Mauck, the Fisher Body Chief Engineer, Mr. Fisher asked Howe for his solution to the exposed hinge problem and then instructed Mr. Mauck to let him prove it by working close to them, and to provide him with a set of prints. If Mouche, Richard, Feldwabel, Smith and Carr had taught them the answers, which does not square with the claim that its own employee made the invention, without their disclosures making it obvious, why all the interest and required work? Judge La Buy asked that question (P.A. 56-57, booklet 15-16, Findings 17-20 inclusive) as did Judge Picard.

D.A. I 31-32 shows that GM considered the Howe invention "novel". P. 702 shows GM's advertising Howe's invention as its own, calling it "ingenious".

GM's expert, Lutz, after considerable effort before Judge Perry trying to read Howe's claims on the prior art, had to admit the novelty of Howe's invention and that it produced unexpected results (D.A. II 1599-1600).

Judge Robson leaned very heavily throughout his decision on the construction Hedeen, of GM, posing as an expert, placed purportedly upon the '490 claims. Yet, Hedeen had to disqualify himself also, falteringly (D.A. II 1427):

> Q. "But you didn't read them out of the claims?
> A. Oh, I have nothing to do with the claims. I can read them, but I am not trying to interpret the claims. I mean I am no expert on interpreting claims, Mr. Horton."

Amusingly, Hedeen swore that he never before had heard the word "pintle." Had Judge Robson been aware, before Hedeen was sworn to testify as an expert, he

should not have permitted this. The established law is that one who cannot interpret patent claims can be no expert in a patent infringement suit. What is unexplainable is that, despite the self-disqualification, Judge Robson rested his conclusions virtually on his testimony, except lack of sufficient experience in the trial of patent suits.

The defense under § 102(g) that GM developed the Howe hinge before he did is highly suspect from the Record, and seems to have escaped Judge Robson. The Stipulation between the parties and the defendant's depositions and testimony indicates at least over a dozen instances of original drawings, documents and the like being destroyed prior to 1954, when the suit at bar was filed, or as having been changed in material respects (P.A. 125, 129, 133, 135, 136, 139, 141; D.A. I 356; D.A. II 908, 910, 911-12, 961, 995, 1043, 1045, 1108). How can this evidence be reconciled with Judge La Buy's findings (P.A. 57-58, booklet 16-17, Findings 21-24, incl.) that Howe kept notifying GM of infringement from June 21, 1940, in 1947, 1949, 1951, 1952? One would suppose every precaution would have been taken, under the circumstances, to preserve original and corroborative evidence.

It may be asked further, the discrediting evidence of changes in the drawings aside, as did District Judge Sprague of Massachusetts, when the defense was prior invention by Walter Hunt of the Elias Howe sewing machine:

> "Why did not Walter Hunt and Mr. Arrowsmith take out a patent? Is there any suggestion that they were not able ((financially)) . . . why did they not take out a patent?" (12 Fed. Cas. No. 6775 (1854), *Howe* v. *Underwood*, p. 686)

It is well known that GM tries to get patents on every shadow of a shade as a matter of insurance against infringement suits. Yet it sought neither to get a patent on the Howe hinge nor to have an interference declared. But it did seek and obtained a patent on a minor improvement, called an "assist", by one of its employees of which it bragged in the Record.

Incidentally, the steps in § 103 and this Court's guidelines in *Graham* are traceable to the format (*Howe* v. *Morton,* 12 Fed. Cas. No. 6769 (1860)) which Judge Sprague adopted in the Elias Howe patent infringement suits to implement the contemporaneous *Hotchkiss* v. *Greenwood.* Judge Clifford's opinion in *Howe* v. *Williams,* 12 Fed. Cas. No. 6778 (Mass., 1863) followed, even to laying down the rule that the patent in suit must be interpreted "as a whole" (at pp. 692, col. 1, and 693, col. 2). At page 696, col. 1 is laid down the rule that disclosures in inoperable devices cannot be cited as anticipatory reference under the present § 102 on the issue of novelty, nor, it seems, from Judge Sprague's opinion in *Morton,* at p. 666, col. 1, on the issue of obviousness (lack of invention) under the present § 103.

Nor did Judge Robson evaluate properly the Smith 1936 patent cited as a non-file wrapper reference, despite the evidence of the expert Hedeen that General Motors found it impracticable. Smith was an acknowledged auto body engineer in the very top rank of "engineers of substantial training and specialized skill". Atwood had bought the Smith patent (D.A. III 2149, booklet 6) but it proved so unsatisfactory that, fearful of losing its customers, it sought out Howe to get a license. Smith sought to effect an alignment of the door and the closed body of a streamlined auto by a ball and socket

hinge because (P.A. 751-757) no alignment could be had with pintle hinges unless at least one was exposed and protruding. At P.A. 754, col. 2, top, lines 2-14, he states in unmistakable *haec verba*:

> "In mounting doors on curvilinear or irregular surfaces, as automobile bodies and the like, great difficulty has been experienced in so mounting the hinges that they will not bind and prevent the doors from opening properly. It is common practice to use hinges of the pintle type in mounting the doors on vehicle bodies, *but such hinges require the pintles to be in alignment, and on the modern vehicle bodies that usually means one or more of the hinges must extend laterally outward beyond the surface of the body to such an extent as to afford considerable air resistance to the rapid transit of the vehicle.*"

What the prodigious amount of effort GM could not do with the teaching of its own cited art, and what Atwood Vacuum, one of the largest hinge manufacturers, if not the largest, could not do, and what the leading auto manufacturers could not do, and what Smith stated expressly was impossible, Howe did. Yet Judge Robson shrugged all this off as secondary (P.A. 736, booklet 56) (GM had 700 engineers in 1935, 1000 in 1938 (D.A. II 879-80)) because he equated Graham's changing the wear spot to what Howe did. He disregarded the unexpected result Howe accomplished, after some years trial and tribulation, and did not apply this Court's teaching in *U. S.* v. *Adams,* which followed *Graham* in 383 U.S. 39, if, indeed, he even studied it carefully.

GM could not eliminate the exposed hinge without which it could not support the heavy all-steel door by the concealed hinge alone and it discarded Smith's ball

and socket hinge as not feasible (P.A. 987, booklet 6, entire right hand column, D.A. II 1519).

What was the response of GM's counsel when faced with its own evidence (D.A. II 881-82) in Smith's patent of the impossibility of aligning the door and closed body? His impalpable and tawdry excuse was that Smith was unknown to them (D.A. II 1518).

Judge Robson fell into the error of equating Howe's invention, which was primary or pioneer in the art of hinging tumble-in doors on *closed* all-steel auto bodies, with *Supermarket* (an incompleted, three sides of a wood box), and with Graham's alleged "improvement" of changing the wear spot on his earlier, concededly primary and pioneer invention in the art of chisel plows, for a number of reasons. The nomenclature itself "tumble-in" and "tumble-out" may connote a reversal of something, which to Judge Robson is *per se* non-invention (what of Elias Howe's reversing the position of the eye from the top of the needle to its end which solved the problem of having the thread on the shuttle interlock with the thread through the eye of the needle, and, through such startling result, the interlocking stitch, emancipating housewives forevermore from the drudgery of hand sewing? This was the seventh claim in his patent (*Howe* v. *Williams*, 12 Fed. Cas. No. 6778, p. 689) which unrealistic and a' priori judges would now hold unpatentable under the already shop-worn cliche "invalid for obviousness", and which has stricken down 95% of the patents in the 75 post-*Graham* cases reviewed by Counsel—a national scandal almost, that may produce a drastic revision of our patent laws at this coming ses-

sion of Congress, unless this Court will try to clarify most, if not all, the twilight areas indicated at pp. 11-12 of this Pet.).

The second cause of error was that he confused the non-analogous art antedating the De Soto (1930) all-steel auto, such as Richard (1919), the open car type disclosed in Feldwabel (1920) and Mouche (1922) with the analogous art post-dating De Soto, such as Smith (1936) and Carr (1938) (See Appendix A, this Pet.). Judge Picard saw the distinction clearly and the impertinence of the "tumble-out" art (p. 18, this Pet.; D.A. III, 2148, booklet 5). To reach his determinations, after listening for weeks to discussions of the two arts, Judge Perry was likewise not impressed with the pertinency of the "tumble-out" art (See his long all day charge to the jury, D.A. II 1706-1749).

Is it not remarkable that the men most conversant with the two arts and with Howe's disclosures in confidence to top men in GM and with whom he worked to make full-scale models (P.A. 56, booklet 15, Judge La Buy's Finding No. 17), among them, Barnes, GM's chief patent counsel, Haskins, head of GM's Patent Dept., Mauck, Fisher Body's Chief Engineer, were never called to testify in any of the four trials before Judges Picard, La Buy, Perry, and Robson? They feared to be subjected to cross examination on the arts and Howe's invention, it must be concluded.

The parties entered into a 44 printed page Stipulation (P.A. 107-150) on the work of GM's several Divisions from 1935-38 in the invention of the hinge they claim was the concept of an employee. Judge Robson admitted, notwithstanding, in evidence 80 needless depo-

sitions en masse, subject to a blanket objection. What influence they had on him is unknown. Not one word appeared in the stipulation or depositions that this hinge was like the hinges GM had used on its tumble-out cars. If the reversal, alleged by Judge Robson to have been obvious, was so well known to GM and the auto industry, why was it necessary for GM to spend three years of elephantine labor and so much money, and take so many highly-paid and skilled workers from more productive work, only to end the quest in failure? Smith's 1935 patent application (p. 22 this Pet.) should have taught them they would end in failure trying to align concealed hinges, but they set out to prove him wrong, to end only in confirming what long training, experience, and highest professional skill led Smith to forewarn the industry.

To summarize and to reemphasize: "Tumble-out" bodies were *all* composite-wood frame with sheet steel nailed to the frame. Butt hinges, all exposed outside the body, supported the doors on cars of American manufacture. The doors of the strictly wood-frame, on carriages and roadsters preceding them, were small and of light weight. That was true substantially of the "tumble-out" composite bodies, even those shown in the two foreign patents, Mouche (French) and Feldwabel (German), the only cited references showing gooseneck hinges, completely concealed in the former but partially concealed in one type of the latter, both having arms of unequal length. Neither, however, presented any problem of alignment because, the doors being half length or gates, hinging them caused no excessive lift of the door. When De Soto, however, brought out, in 1930, the first all-steel closed body con-

struction, the excessive lift did not at first become too serious a problem. Butt hinges (which are pintle-type) supported the De Soto doors. But as soon thereafter the all-steel bodies became more streamlined and curved, the lift became more excessive. Their butt hinges varied in length, then becoming longer and longer, depending upon the steel body's curvature and the door swing, but all these butt hinges were exposed outside the body.

GM's 1939 B.O.P. model was the first all-steel body whose front door's upper hinge was concealed, but its lower hinge was exposed outside the body. Its 1940 Chevrolet model's rear door's upper hinge was exposed, however, and its front door's lower hinge, as in the 1939 B.O.P. model, was also exposed outside the body. Howe, working with Fisher, Mauck, et al., as recited above (p. 8, this Pet.), taught them how to eliminate these exposed hinges per his teachings in '490.

To make clearer to the Court Howe's radical departure from the art antedating De Soto, which is really not pertinent, as well as from Smith and Carr which are pertinent to the art of hinging all-steel doors on all-steel curved bodies, reference will be made to important passages in his description and claims. Carr is not pertinent because of its impracticality, never having been manufactured due to apparent defects, and its hinges are not concealed as that term is understood in the industry.

Replying to Smith's challenge to produce hinges that would not extend "laterally beyond the surface of the body," Howe's description states (P.A. 748, p. 1, col. 2, ll. 9-17):

> "The purpose of the hinge in this respect is to avoid the necessity of comparatively long, outwardly

> projecting hinge elements, such as are ordinarily used in connection with curved doors. This is made possible by use of a single hinge disposed within the plane of the body wall, and whose axis of pivotal movement, if prolonged, passes the top and bottom of the door frame externally thereof."

Beatty, of GM, testified (D.A. I 416-17) that thicker and heavier doors created hinging problems; and that, in any curved body, even bathtub shape, *the mounted hinges follow the door's inclination* (D.A. II 870). Expert Hedeen, of GM, on whom Judge Robson relied so heavily, finally conceded that the weight of the all-steel door affected the inclination from the vertical and, hence, the type of hinge to correct (D.A. II 1414; 1474-75, top).

The Howe description (P.A. 749, p. 2, col. 1, first par.) states, in the most unambiguous language, that his hinge "is not visible either from the interior or from the exterior of the vehicle when the door is closed."

That his hinge is to be mounted on tumble-in bodies is expressed clearly in his description (P.A. 748, p. 1, col. 1, pars. 1, 3, line 34 referring to "later automobile designs"; col. 2, 1st par., next to the last par., and next to the last line) and in his claims (claims 1 and 2 refer to "inclined walls"; claim 3 to "curved door"; claim 4 to "automobile curved body.") There is no semantic or other basis for the attempted construction that, read in conjunction with the description and drawings, "concealed hinge" in the claims embraces a partially concealed hinge, and that the word "body" in the claims embraces a composite wood frame body, so that they read on the partially concealed hinges in Richard, Feldwabel and Mouche (Appendix A, this Pet.) to support their wood frame doors on box-like, or bathtub, types of

bodies, constructed flimsily with a gate, half door or even full door.

So that the Court may see at a glance that the foregoing patents relied on principally by GM do not contain *all* elements in any one of them, and so the patents are not anticipatory of '490, an almost self explanatory chart has been prepared (Appendix A, this Pet.).

Why did not Judge Robson refer to *U. S.* v. *Adams* of whose existence he must at least have known? Notwithstanding the holding therein that an unexpected result negates obviousness, a dispute exists whether the court is bound to inquire only into structural similarities and dissimilarities, or whether it must, to consider the patent in suit "as a whole", also inquire into the inventor's purposes in making the invention and into whether the results are more than merely the production of a cheaper and/or more efficient article (*Commissioner of Patents* v. *Deutsche,* 397 F. 2d 656 (C.A.D.C., 1968)).

The explanation may be that Judge Robson felt bound by the policy of the Court of Appeals for the Seventh Circuit which one reads in disbelief and shock at the *deliberate* disregard of this Court's ruling in *U. S.* v. *Adams.* In *Walt Disney Productions* v. *Niles Communications,* 369 F. 2d 230, (*Nov. 9, 1966*), about 7 months after *U. S.* v. *Adams* held to the contrary, that court said:

> "We note that the District Court, in holding claim 8 to be obvious, emphasized 'In short, plaintiff's combination of known elements produces no unusual or surprising result and is therefore not entitled to a patent.' We think this was an incorrect test, for the 'unusual and surprising result' as a controlling factor has gone with the 'flash of creative genius.'"

While in many cases, the trial court's emphatic, unequivocal conclusion that the patent in suit involved absolutely no invention, relieved it from the need or burden to test patentability by the subtests of proof of commercial acceptance, long-felt want, replacement and the like, may a trial judge also ignore such factors when it states expressly doubt as to its own conclusion, as a matter of law, about the patent's invalidity? That is one of the questions presented in the case at bar, on which clarification by this Court would be appropriate. After presenting the pros and cons, he concluded: "The determination of the issue of validity is not as clear-cut as may be desired." Then why did he not examine into the evidence of the widespread adoption of the Howe hinge, and its replacement of the hinge antedating De Soto and the exposed butt hinges following De Soto, and the impractical Smith fully concealed ball and socket hinge, in accordance with this Court's instruction in *Graham*? No more ingenious hinge for corrective alignment use on doors of all-steel and glass in the streamlined modern automobiles has yet been devised since 1938 to replace Howe's invention.

Ordinarily, a defendant must prove by a clear and convincing preponderance of the evidence his defenses. An exception is made as to the defense of prior knowledge and public use. The burden is cast on him, as in a criminal case, to prove this beyond all reasonable doubt. On principle, why should the burden be less on the defendant, where, as in the instant case, its Answer set up the defense that its employee was the inventor and the plaintiff joined issue by showing he had disclosed his invention, before it was in the public domain or ran afoul of the statutory time limit bars, in confidence in the expectation of

compensation therefor, and that his invention was misappropriated? This case on this fatual pattern goes beyond *U.S. v. Adams* where the Court found that Adams had made no contract with the U.S., much less in a confidential relationship. Should not this Court indicate its guidelines as to burden of proof in a patent infringement suit involving the issue of a confidential disclosure? Two of the cases involving patent infringement and the issue of confidential disclosure, among those in Appendix B, this Petition, have indicated that the defendant must prove invalidity beyond a reasonable doubt. The slightly oversized Petition will not permit further discussion, other than, despite the admittedly scanty precedents on the point, on principle it would be sound to cast such burden, and that the representative cases (by no means a complete list) show such issues have arisen with enough frequency and in all the Circuits, to warrant this Court's attention to such a guideline.

There remains only the question of the presumption of validity on the issue of obviousness. It is a bit unsettled in the various Circuits, some holding that mere omission of the cited reference weakens or destroys the presumption, but the great weight of authority is that there is no presumption that the Patent Office overlooked that citation, that the defendant has the burden of showing lack of consideration, and that where the Record shows the consideration of art equally or more pertinent was considered, the omitted reference is merely cumulative. The Seventh Circuit was in accord with the weight of authority until the case at bar indicates it now holds with the minority.

The defendant's pleadings cited as well the references cited in the file wrapper (P.A. 698; D.A. III 1861-1928).

They show the same disclosures cited by the defendant as non-wrapper file references, all relating to the ante-De Soto wood or composite door and body of old touring cars, roadsters or carriages, whose weight was light relatively and presented no problems of excessive lift and alignment. None of such hinges were suitable or practical for use on heavy, all-steel doors with glass on the modern, closed tumble-in all-steel body automobiles.

In *Artmoore* v. *Dayless*, 208 F. 21, one of the cases listed in Appendix B, this Petition, the Seventh Circuit, at pp. 3-4, in affirming Judge Perry, stated the presumption of validity is not an idle gesture, citing *R.C.A.* v. *Radio Eng.*, 293 U.S. 1, 8 and *Mumm* v. *Decker*, 301 U.S. 168, 171, and that prior C.A. 7 cases cited on p. 4 of this opinion, established that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside, and that "While those of the prior art are disclosed without result, Rogers reduced to practice and with success." (See Judge Perry's charge to the jury to the same effect (D.A. II 1711-12)).

The presumption of validity is strengthened, on the contrary, where relevant prior art has been cited by the Examiner and overcome. Howe testified about the Examiner's citation (D.A. III 1913-1915) of British Patent 17,728 (1913) to Frankfurter Carroserri (D.A. II 1655) and its being overcome, because hinging problems on woodframe carriage and pleasure auto car doors, weighing 5 to 10 pounds, and on all-steel tumble-in bodies, weighing upwards of 100 pounds, were non-analogous, and their solution non-obvious to an ordinarily skilled modern auto body engineer; Raisch cross examined him at great length thereon (D.A. II 1691-1702). The relevancy of this British Patent was asserted by Raisch's law firm soon almost '490 was

granted on May 21, 1940 (D.A. III 1955).[1] The defendant did not cite this reference to this Court because it was overcome in the Patent Office, and because such citation would have deprived it of the contention that the failure of the Patent Office to reveal relevant prior art overcame the presumption of validity.

Defendant did not disprove that the Examiner, consistently with British Patent 17,728 to Frankfurter, regarded its citation of prior patents as cumulative and unworthy of recordation. The plaintiff, on the contrary, introduced into evidence the Examiner's search sheets (P.A. 698-699). The issue of the consideration of the defendant's cited prior patents by the Patent Office must, therefore, be resolved in favor of the plaintiff. Defendant has not sustained the burden of proof. The presumption of validity has not been assailed successfully on the ground that the Examiner had not considered the most pertinent prior patents.

Attorney General Tom C. Clark, later the Associate Justice of this Court who spoke for it in *Graham* and *U.S.* v. *Adams*, stated in his Manual on the Administrative Procedure Act (1948) that Congress intended that § 1009 of Title 5 and §§ 141-45 of Title 35 be applied together since they are not inconsistent (Appendix A, this Petition).

In *Magnaflux* v. *Coe*, 139 F. 2d 531, 532 (C.A. D.C.) it was stated that the presumption of the correctness of the Patent Office decisions runs in favor of the issued patent

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(1) It wrote Haskins of the Fisher Body Patent Division on the 26, 1940 about '490: "I believe that the claims of this patent are palpably void. The idea of having the hinges tilted in both directions is shown in the British Patent to Frankfurter 17,728 of 1913."

in infringement suits. Howe was thus favored with two presumptions in his favor, the presumptions of validity and of correctness.

The reviewing court's comment (booklet, p. 6) that "The patent contains no citations of prior art patents" from which is to be inferred that such failure also weakened the presumption of validity, indicates either lack of knowledge that at the time, in 1940, when '490 issued, it was not the practice to print the patent references at the end of the patent or that it was grasping at any straws to defeat Howe.

There is no evidentiary support in the Record for the legal conclusion that Howe's patent was invalid for obviousness, because many vital and critical facts and issues were overlooked, or not considered, or misconstrued by Judge Robson.

CONCLUSION

It is respectfully submitted that this petition for a writ of certiorari should be granted.

Respectfully submitted,

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Of Counsel.

APPENDIX A

x indicates the following elements in Howe Pat. No. 2,201,490 *not* present in prior patents and publication Howe Pat. No. 2,201,490	Richard No. 1325109 (1919)	Smith No. 2050469 (1936)	Carr No. 2114836 (1938)	Mouche-French No. 537011 (1922)	Feldwabel Publication (German) (1920)
1. Heavy all-steel *full* doors	x			x	x
2. Tumble-in steel body on modern auto	x		x	x	x
3. Doors with glass	x			x	x
4. Pintle-type hinge		x			
5. Problem disclosed	x		x	x	x
6. Hinging means all fully concealed	x	x	x		x
7. Hinge axis inclined inwardly	x		x	x	x
8. Hinge axis inclined forwardly	x		x	x	x
9. Pintle axis inclined	x	x	x		
10. Hinge axis for bias closing of door	x	x	x	x	x
11. Hinge varying in curvature	x	x	x		
12. Hinge arms of different reach	x		x		
13. Operative—and useful		x	x	x	
14. Long felt need recognized	x		x	x	x
15. Commercially successful	x	x	x	x	x

APPENDIX B

Representative List of Confidential Disclosure Cases Arranged by Circuits Chronologically

District of Columbia

Aktiebolaget v. *U. S.*, 93 F. Supp. 131 (D.C., 1950)
Belt v. *Hamilton Nat. Bk.*, 210 F. 2d 706 (C.A.D.C., 1953)

First Circuit

Tepper v. *Ross*, 25 F. Supp. 92 (Mass., 1938)
Atlantic Wool v. *Norfolk*, 357 F. 2d 866 (C.A. 1, 1965)

Second Circuit

Becher v. *Contoure*, 29 F. 2d 31 (C.A. 2, 1928), 279 U.S. 88
Picard v. *United Aircraft*, 128 F. 2d 632 (C.A. 2, 1942)
Gilbert v. *General Motors*, 133 F. 2d 997 (C.A. 2, 1943)
Matarese v. *Moore Mac Cormack*, 158 F. 2d 632 (C.A. 2)
Berry v. *Glidden*, 92 F. Supp. 909 (S.D., N.Y., 1950)
Kleinman v. *Betty Dain*, 189 F. 2d 921 (C.A. 2, 1951)
Schreyer v. *Casco Products*, 190 F. 2d 921 (C.A. 2, 1951)
Anderson v. *Trico*, 162 F. Supp. 224 (W.D.N.Y., 1953)
Franke v. *Wiltscheck*, 209 F. 2d 493 (C.A. 2, 1953)
Titcomb v. *Norton Co.*, 208 F. Supp. 9 (Conn., 1959)
Sperry Rand v. *Rothlein*, 241 F. Supp. 549 (Conn., 1964)
Lemelson v. *Kellogg*, 259 F.S. 904 (S.D.N.Y., 1966)

Third Circuit

Lorenz v. *Colgate-Palmolive*, 122 F. 2d 876 (C.A. 3, 1941)
Meier v. *Anchor Hocking*, 95 F. S. 265 (W.D.Pa., 1951)
Kirschner v. *West*, 300 F. 2d 133 (C.A. 3, 1962)

Fourth Circuit

Amer. Orn. v. *Orange Crush,* 76 F. 2d 969 (C.A. 4, 1935)
Ches. & Ohio v. *Kaltenbach,* 95 F. 2d 801 (C.A. 4, 1938)
Saco-Lowell v. *Reynolds,* 141 F. 2d 587 (C.A. 4, 1944)
Ackerman v. *Gen. Motors,* 202 F. 2d 642 (C.A. 4, 1953)
Carter Products v. *Colgate,* 230 F. 2d 855 (C.A. 4, 1956)
Servo v. *General Electric,* 337 F. 2d 716 (C.A. 4, 1964)

Fifth Circuit

Samuels v. *Beth. Steel,* 323 F. 2d 944 (1963)

Sixth Circuit

A. O. Smith v. *Petroleum,* 73 F. 2d 531 (C.A. 6, 1934)
Liquid Carb. v. *Goodyear,* 38 F. Supp. 520 (N.D.Oh., 1940)
McEuen v. *Kelley-Mott,* 130 F. 2d 488 (C.A. 6, 1942)
Eaton v. *Ford Motor,* 60 F. S. 801 (E.D.Mich., 1945)
Bradley v. *Great A&P,* 179 F. 2d 636 (C.A. 6, 1950)
Royal Pat. v. *Monarch Tool,* 203 F. 2d 299 (C.A. 6, 1953)
White v. *Owens-Ill. Glass,* 203 F. 2d 694 (C.A. 6, 1953)
Gen. Motors v. *Estate Stove,* 203 F. 2d 912 (C.A. 6, 1953)
Stevens v. *Continental Can,* 308 F. 2d 100 (C.A. 6, 1962)
Pennington v. *Houde,* 136 F. 2d 59 (C.A. 6, 1967)

Seventh Circuit

Booth v. *Stutz Motor,* 24 F. 2d 415 (C.A. 7, 1928)
Shellmar v. *Allen-Qualley,* 36 F. 2d 623 (C.A. 7, 1929)
Lockerbie v. *Fruhling,* 207 F. S. 649 (E.D.Wis., 1932)
Hunady v. *General Motors,* 84 F. 2d 61 (C.A. 7, 1936)
Flanigan v. *Ditto,* 84 F. 2d 490 (C.A. 7, 1936)
Doherty v. *Universal,* 107 F. 2d 548 (C.A. 7, 1939)
Friedman v. *Washburn,* 145 F. 2d 715 (C.A. 7, 1944)
Lewyt v. *Healthmor,* 84 F. S. 189 (N.D., Ill., 1950)
Wilson v. *Seng,* 194 F. 2d 399 (C.A. 7, 1952)
A. O. Smith v. *Dravo,* 203 F. 2d 369 (C.A. 7, 1952)
Northup v. *Reisch,* 200 F. 2d 924 (C.A. 7, 1953)

Artmoore v. *Dayless,* 208 F. 2d 1 (C.A. 7, 1953)
Blaw-Knox v. *Lain,* 230 F. 2d 373 (C.A. 7, 1956)
Pleatmaster v. *Golding,* 240 F. 2d 894 (C.A. 7, 1957)
Borkland v. *Param. Plastics,* 244 F. 2d 501 (C.A. 7, 1957)
Anderson v. *Sears Roebuck,* 265 F. 2d 755 (C.A. 7, 1959)
Continental Can v. *Hocking,* 362 F. 2d 123 (C.A. 7, 1966)

Eighth Circuit

Sandlin v. *Johnson,* 152 F. 2d 8 (C.A. 8, 1945)

Ninth Circuit

Angle v. *Richardson,* 97 F. 2d 736 (C.A. 9, 1938)
Oxnard Conners v. *Bradley,* 194 F. 2d 655 (C.A. 9, 1952)
Pacific Lens v. *Solex,* 209 F. 2d 529 (C.A. 9, 1952)
Filex v. *Antiyent,* 216 F. 2d 443 (C.A. 9, 1954)
Panaview v. *Van Ness,* 135 F. 2d 253 (S.D., Cal., 1955)
Trenton v. *Peterson,* 165 F. S. 523 (S.D., Cal., 1958)
Walker v. *General Motors,* 362 F. 2d 58 (C.A. 9, 1966)

Tenth Circuit

Baker Oil v. *Burch,* 71 F. 2d 31 (C.A. 10, 1934)
Sears Roebuck v. *Jones,* 308 F. 2d 705 (C.A. 10, 1962)

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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1968

NO. 1005

EARL E. HOWE,

Petitioner,

vs.

GENERAL MOTORS CORPORATION,

Respondent.

OPINIONS OF COURTS BELOW AND STATUTES ACCOMPANYING PETITION FOR WRIT OF CERTIORARI

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UNITED STATES CODE	
Title 5. Administrative Procedure Act, secs. 1;597;1001; 1009.	69
Title 35. Patent Act of 1952, secs. 101;102;103;141;145; 282.	69 - 70

Action for royalties by Earl E. Howe against Seth B. Atwood, Helen Atwood, his wife, James T. Atwood and Myra C. Atwood, his wife, individually and doing business as the Atwood Vacuum Machine Company, not registered, who filed a counterclaim for damages caused by garnishment proceedings, and wrongful termination of license contract.

Order in accordance with opinion.

Alex J. Groesbeck and Lawrence Rothenberg, both of Detroit, Mich. (Clarence B. Zewadski, of Detroit, Mich., of counsel), for plaintiff.

Beaumont, Smith & Harris, and Albert E. Meder and Richard W. Larwin, all of Detroit, Mich. (Andrew F. Wintercorn, of Rockford, Ill., of counsel), for defendants.

PICARD, District Judge.

The chronological history becomes important.

March 15th, 1937, plaintiff filed application for United States letters patent, No. 130977, entitled "Hinge Mechanism" and covering a practical concealed hinge for supporting a curved door to a curved automobile body. During that year he submitted his ideas to the several companies making hinges for Ford, Chrysler, General Motors and for other independent automobile concerns. He showed defendant Seth B. Atwood, manager of defendant the Atwood Vacuum Machine Company, his application including requested claims, but defendants were not interested. Later application No. 130977 was abandoned because of the death of plaintiff's patent attorney but the identical application was refiled January 14th, 1938, for which plaintiff on June 20th, 1939, received letters patent No. 2163323 (hereinafter referred to as 323 or Patent No. 1).

March 16th, 1938, plaintiff entered into an option agreement with Metal Specialty Company of Cincinnati, Ohio, by the terms of which Metal Specialty had the right to become licensed under Howe's ideas covered by the terms of a proposed license agreement which was attached to the option. This option was exercised and the license agreement executed May 24th, 1939, by which plaintiff granted Metal Specialty exclusive license to manufacture, sell and use the inventions evidenced by then numbered application 130977, all continuations and substitutions therefor, all divisions thereof, and under any and all patents and reissues thereof which licensor might apply for and obtain or otherwise acquire in concealed hinges and body arrangements, during the life of the agreement. Patent No. 2 herein later mentioned was applied for during the option period and became a part of the license. Licensee agreed to pay plaintiff 5 percent of the sales price received by it for hinges sold pursuant to the contract and licensee had the right to grant sub-licenses, a royalty of 5 percent of the sale price received from such sub-licensees to be collected by licensee and paid to licensor.

Plaintiff and Metal Specialty sought to interest many automobile and body building companies in patent 323. During 1938 they showed plaintiff's hinge to Studebaker, General Motors, Ford, Chrysler, Nash, Budd, Packard, Fisher Body and gave evidence that at the same time they showed a compensating angle or inclined pin hinge construction which Howe stated he had conceived and put on a blue print as far back as August 23rd, 1937. He produced this blue print.

In May, 1938, Howe prepared a model showing the inclined pin hinge which he also demonstrated during the same year to several automobile and body companies.

May 10th, 1938, Howe was given a hinge layout by a Mr. Sullivan, engineer for Studebaker, and on the 19th gave that engineer a drawing showing the inclined pin.

On January 9th, 1939, plaintiff filed his application for his second hinge with the inclined pin, and on May 21st, 1940, received letters patent No. 2,201,490 (hereinafter referred to as 490 or Patent No. 2).

Of all companies approached, Packard seemed to be the most interested in the Howe hinge and Packard was one of defendant company's customers. While patents were pending conferences were held between Metal Specialty Company, plaintiff and defendant company during which the subject matter contained in the applications and possible coverage to be obtained were discussed.

April 19th, 1939, less than four months after plaintiff had made application for his inclined pin hinge, a contract was entered into between Metal Specialty and Atwood Vacuum by which they were both to make hinges covered by the patents applied for (323 and 490) and to divide "the production and profit" "equally between them". Atwood Vacuum was to pay Metal Special-

$1,000.00 upon signing the contract and an additional $1,000.00 after satisfactory claims had been allowed. Atwood Vacuum was also to pay Metal Specialty 5 percent of the sales price on hinges until an additional sum of $4,000.00 was paid. This was to equalize development expenses. It was further provided that payment of the 5 percent royalty on hinges sold and manufactured by Atwood Vacuum be paid direct to plaintiff and this was a different arrangement than plaintiff had with Metal Specialty. Plaintiff approved and consented to this agreement in writing. In other words, plaintiff agreed to look to Atwood Vacuum for royalties on his hinges sold by defendant company and in that contract Atwood Vacuum agreed not to contest "directly or indirectly or in any way encourage or lend assistance to anyone intending or attempting to contest the validity of the patents licensed thereunder."

Atwood Vacuum agreed to aid in securing the claims and did make one or two helpful suggestions.

Atwood Vacuum then paid $2,000.00 to Metal Specialty Company "in equalization of the development expenses up to date".

Shortly thereafter Metal Specialty complained that certain hinges which it felt came within the scope of the above agreement on both patents were being made by Atwood Vacuum for Studebaker and asked Atwood Vacuum to account for royalties and excess profits. In reply defendant company claimed the hinge it had sold Studebaker did not infringe the Howe patents and several letters were exchanged between the parties, defendants warning Metal Specialty that the validity of their joint patents might be challenged by the big automobile companies if it insisted upon pushing the matter. Later, May 24th, 1940, Metal Specialty Company notified defendant company that it was terminating the April, 1939, contract at the end of 30 days but Atwood Vacuum prevailed upon it to reconsider and talks were had without any further action on the termination. However, upon continued refusal of defendant company to pay royalties to Howe and to divide the production and profits, Metal Specialty Company, September 24th, 1940, assigned all its rights, title and interest in and to said April 19th, 1939, agreement to plaintiff and was released by plaintiff from further obligation, Metal Specialty notifying defendant company of its action October 1st, 1940.

October 3rd, 1940, defendant company acknowledged receipt of that assignment asking in reply whether "any further work that we may have to do would then be done with Howe?"

October 8th, 1940, Metal Specialty wrote defendants "so any further work that you have to do should be done with Earl Howe".

January 9th, 1941, three months later, defendants notified Metal Specialty Company that they considered Metal Specialty's action in assigning their contract to plaintiff, a breach of the April 19th, 1939, agreement, absolutely of no force or effect, and demanding return of the $2,000.00 they had paid.

On March 5th, 1941, Howe started suit against defendants in the Wayne County Circuit Court under the license agreement for royalties and as assignee of Metal Specialty for the agreed sum of $4,000.00 and excess profits, and service was made on defendants March 18th, 1941.

March 21st, 1941, after suit and service, more than five months after first being notified of the assignment to Howe and more than two months after repudiating that assignment, defendant company wrote Earl E. Howe "We do not consider ourselves a licensee and that so far as we were concerned we had no interest whatever in the patents which you controlled. This letter will serve legal notice that we are not a licensee under Howe patents on hinges as covered on the original contract between yourselves and Metal Specialty Company."

Defendants immediately removed the cause to this court, whereupon plaintiff filed an amended bill adding prayers to hold defendants as infringers; to enjoin defendants from manufacturing further hinges covered by plaintiff's patents 323 and 490, and asking that defendants be directed to account and pay plaintiff all sums found due him on account of breach of the contract of April 19th, 1939.

The Issues Involved.

Several questions are presented:

First Question.

The first for this court to decide is whether plaintiff may maintain an action on the April 19th, 1939, contract, for royalties.

Metal Specialty Company admittedly was not then manufacturing hinges of any kind

while Atwood Vacuum was well known in this line. Atwood Vacuum, interested in the Howe hinge because one of its clients, Packard, was interested, learned it had to do business with Metal Specialty. It was not necessary under the license granted Metal Specialty for Howe to become party to any contract of sub-license but evidently as a precaution for all parties, the arrangement between Metal Specialty and Howe was modified to the extent that Atwood Vacuum was to make payments direct to Howe. Thus the contract became a three party agreement and it is the opinion of this court that this arrangement not only served Howe's purpose well but it was also of value to Atwood Vacuum in the event that some difficulties arose later between itself and Metal Specialty. This contract being participated in by Howe gave the Atwood company a hold upon Howe it otherwise would not have had.

It will also be noted that when Metal Specialty informed defendant in October of its assignment to Howe, defendants then replied that they understood they must henceforth do business with Howe. It took defendants three months before notifying Metal Specialty that they questioned Metal's right to make any such assignment and five months to apprise Howe of their claimed status of non-licensee. And then only after plaintiff had brought suit and defendants had been served.

[1-3] Approaching this from the opposite angle we believe that if plaintiff had refused to go on with this contract while defendants had lived up to their obligations, defendants certainly could have resorted to action on this agreement and gotten favorable results. But for reasons best known to themselves, in March, 1941, they chose to strike the shackles by which their company was encumbered under the terms of that agreement. This contract was plain and unambiguous and leaves no reason for strained construction. Defendants should not therefore be permitted to show an intent contrary to its express provisions. As stated in Golden Gate Bridge & Highway District v. United States, 9 Cir., 125 F.2d 872, 876, "the cardinal rule of construction is to ascertain and give effect to the intention expressed in the instrument which is being construed" citing 12 Am.Jur., Contracts, § 227. See, also, Harrington v. Interstate Business Men's Association, 210 Mich. 327, 178 N.W. 19. To this court it appears that all three were parties to that agreement and that plaintiff may now maintain this action for royalties.

The date of "cancellation" of that contract, however—if cancelled—will be discussed later.

Second Question.

We come now to the second issue, to-wit:

May defendants question the validity of these patents in a suit for royalties?

[4] It is admitted that the Federal Court has exclusive jurisdiction of infringement of patents, 28 U.S.C.A. § 371, Fifth, and that this was originally a suit for royalties and not for infringement. Does removal to the Federal Court enlarge the scope of the justiciable issues so that validity of the patents may now be attacked? We think this is answered in a very recent decision, Noma Electric Corporation v. Polaroid Corporation from the Southern District of New York, 2 F.R.D. 454, decided May 22, 1942, where the court stated: "If the state courts lacked jurisdiction over the subject matter of the action, the federal courts cannot acquire jurisdiction as the result of the removal, although it might have had jurisdiction if the action had originally been commenced in the federal court".

In State of Minnesota v. United States, 305 U.S. 382, 59 S.Ct. 292, 295, 83 L.Ed. 235, Mr. Justice Brandeis says: "If Congress did not grant permission to bring this condemnation proceeding in a state court, the federal court was without jurisdiction upon its removal. For jurisdiction of the federal court on removal is, in a limited sense, a derivative jurisdiction. Where the state court lacks jurisdiction of the subject matter or of the parties, the federal court acquires none, although in a like suit originally brought in a federal court it would have had jurisdiction."

[5] Here, however, plaintiff amended his own bill of complaint asking injunction against further infringement. May he not then voluntarily enlarge the scope of the jurisdiction? The answer we believe is correctly given above and in De Lima v. Bidwell, 182 U.S. 1, 174, 21 S.Ct. 743, 744, 45 L.Ed. 1041, where the court states: "Defendant neither gains nor loses by the removal, and the case proceeds as if no such removal had taken place."

Both State of Minnesota v. United States and Noma Electric Corporation v. Polaroid Corporation, supra, were decided subsequent to adoption of the new civil rules, so it is apparent that those rules neither extended nor limited jurisdiction of the district court. In fact, they so provide, Rule 82, 28 U.S.C.A. following section 723c.

[6] Therefore, insofar as these defendants are concerned, the question is not "Are plaintiff's patents good" but, first, just what is the proper construction of the patent issued plaintiff, and second, has defendant company made and sold a hinge that bears more closely upon the patented article than it does upon the prior art? Baldwin Rubber Co. v. Paine & Williams Co., 6 Cir., 99 F.2d 1; Casco Products Corp. v. Sinko Tool & Mfg. Co., 7 Cir., 116 F.2d 119, 121.

[7] In short, if defendant company is manufacturing substantially the hinge covered by plaintiff's patent which in turn is not covered by the prior art, then regardless of the validity of plaintiff's patent, defendants must pay royalties and as licensees are estopped from questioning the validity of patents under which they have licensed while this contract remained in full force and effect. Not only do defendants so specifically agree in their contract but the weight of authority is overwhelming. Baldwin Rubber Co. v. Paine & Williams Co., 6 Cir., 99 F.2d 1; Motor Wheel Corp. v. Rubsam Corp., 6 Cir., 92 F.2d 129.

[8] And it has been held that even though the claims are given the narrowest construction possible and even though the devices are changed to some extent, if they remain the equivalent of the invention, that is if they perform substantially the same function in substantially the same way to obtain the same results, there is infringement. Baldwin Rubber Co. v. Paine & Williams Co., supra; Motor Wheel Corp. v. Rubsam Corp., supra; General Tire & Rubber Co. v. Fisk Rubber Corp., 6 Cir., 104 F.2d 740.

Third Question.

The third question—Is plaintiff entitled to recover under his patent 323 for hinges manufactured and sold by defendants to the Studebaker Company which defendants claim are covered entirely by the prior art?

The evidence shows that when application was made for patent 323 petitioner, plaintiff here, had to elect whether he was asking a patent on a hinge per se or whether it was a type of hinge in combination with the door of an automobile.

Plaintiff's patent mechanism is known as a concealed hinge, that is it cannot be seen from outside the car. It was designed to be placed about halfway the height of the door and was limited in length, the top of the hinge being about the lower most edge of the door window, and the bottom substantially above the lower edge of the door. It had one pintle. It was one hinge. And when petitioner was confronted with a similar hinge covered by Citrain British 8460 but having two pintles, he contended that while his was a "unitary" type hinge with a "single" pintle, the Citrain British device was a "duplex unitary" hinge with "two" pintles. Since both Citrain British and Howe's hinge worked on a fixed axis he differentiated between the two only on the theory that his hinge with a single pintle was superior to the Citrain British hinge because it would not get out of alignment. He insisted that any hinge having two pintles (Citrain 8460) was the complete equivalent of two hinges and would not have the advantage of a single hinge, specifically adding that "any attempt to align the door after hanging (with the Citrain British 8460) will result in throwing the pins out of line and thus a major and essential advantage of applicant's hinge will be lost." Words in parenthesis added.

[9] Thus, he defined to the examiner the advantage of his hinge over the upper half of the Citrain hinge. This is important because by the file wrapper and by what took place before the examiner we can determine on what distinction applicant was asking to receive his patent. Alliance Securities Co. v. De Vilbiss Co., D.C.Ohio, 24 F.2d 530, 532; Jones et al. v. General Fireproofing Co., 6 Cir., 254 F. 97, 101; Grever v. United States Hoffman Co. et al., 6 Cir., 202 F. 923, 926; Banning v. Sears, Roebuck & Co., 6 Cir., 88 F.2d 45, 47; Wiegand v. Bingham Co., 6 Cir., 106 F.2d 546, 548.

There is no denying that plaintiff has claims to what was known as a combination of hinge, door and body in his first patent and he so elected. Then when he revas ped

his application and accompanying claims he was confronted by Citrain French patent 446509, also a duplex unitary hinge. This time applicant differentiated between his mechanism and that of the Citrain French patent and Swallow British patent 462033, cited by the examiner, to explain that his hinge worked on a "fixed axis" —that is the pintle did not move, while in both the Citrain French and Swallow British patent cited, the hinge pin did move as the door was opened and closed.

One cannot read plaintiff's claims and history of his first patent without reaching the conclusion that applicant claimed nothing more than a concealed hinge having a single pin, of limited length, placed at a certain part of a curved automobile door with the top of the hinge about even with the window line. It was strictly a one pintle hinge—the sole distinction advanced by him between it and the Citrain British patent and undoubtedly the only reason the Citrain British hinge was not further considered by the examiner was that Howe when he revamped his application voluntarily limited his claims to a unitary single pintle hinge. This is the more apparent by his resorting to the distinction of a "fixed axis" between his hinge and the Citrain French and Swallow British patents when he reappeared before the examiner with his new claims.

[10] These two patents long antedated the Howe patent. The mechanism made by defendant company on which royalties are now demanded based on patent number one is practically an exact reproduction of the top Citrain British hinge. It has two hinge pins, a fixed axis and is concealed. It never was the intent of the examiner in our opinion to give plaintiff a patent on the duplex unitary hinge nor did plaintiff ever claim it. In view of the above it should not be so construed. Anybody can make that Citrain hinge now without infringement and there was no infringement by defendants in selling Studebaker the hinge known as Exhibit 8. The mechanism was entirely covered by the prior art and so plaintiff is not entitled to royalties on his first patent. Casco Products Corp. v. Sinko Tool & Mfg. Co., supra.

Fourth Question.

The next question relates to the second or "inclined Hinge" patent, which in general details is the same as the location or combination hinge except that patent 490 is a hinge with an inclined axis and an inclined pintle. But here we must approach the issue from two separate angles because plaintiff claims that defendants made and sold a duplex unitary hinge that was practically a duplicate of Howe hinge 490 and then made and sold a second type of hinge which, in effect, was half of its duplex unitary hinge or the Howe hinge cut into two parts and designated by plaintiff as a single type hinge. This smaller or single type hinge was to be placed near the top of the car door and some other type hinge at the bottom—but wherever the accused hinge was used it aimed to give the same results with the same mechanism and in the same manner as the second Howe hinge.

The claims of plaintiff's patent No. 2 define a hinge per se. That is, it is a certain type hinge of itself. True, it's primarily a hinge to be used on a car door and illustrations all relate to automobiles, but it is the understanding of this court that the secret of the claims of the second hinge lies in the fact that the inclination of the axis inwardly from the car door and longitudinally towards the front of the car is accomplished by the use of an inclined pintle built into the hinge, this inclination being compensated for by using a goose-neck hinge member varying the extent of its curvature from top to bottom.

The evidence shows that even in the old style cars before streamline bodies, car doors were never always accurately aligned and fitted but had to be "persuaded" or "jimmied" into place. This was nothing new and was accepted by auto body manufacturers—the "persuasion" often bending the hinge so as to get the door into proper alignment. However, with the advent of the new style streamline bodies "persuasion" alone was out of possibilities. In addition it was desirous of having a door that would open parallel to the ground and at a certain angle would reach a neutral position where it would not fall back quickly striking the person about to enter the car, or fall forward towards the fender. To achieve this result manufacturers began shaping the pillar of the door so that when the common straight vertical pintle hinge was affixed it slanted inwardly and longitudinally—the Cord car of 1936, for example. Results were not entirely satisfactory and some persuasion was still necessary.

Plaintiff contends that he solved the problem. His claim is that he conceived the type of hinge that eliminated the neces-

sity of modifying the pillar which still by "persuasion" had to be twisted so that alignment could be made. Howe's second hinge, he says accomplished this without "persuasion".

It is not denied that defendants also knew the problem that had become exaggerated by the new streamline bodies when they entered into this contract and that they agreed to participate in helping to get the second patent with the claims based upon an inclined pintle and an inclined axis. Defendant company's manager, Atwood, had seen the drawings and what Howe claimed. But Atwood Vacuum, nevertheless, started making an inclined pintle hinge of a duplex unitary type practically exactly like the Howe hinge but having two pintles instead of one. Later it made a single type hinge to go at the top of the door and to be used with some other type hinge near the bottom but with the axis inclined and the pintle in each hinge also inclined.

Let us first discuss the duplex unitary hinge.

[11] Defendants' claim simply is that Howe's patent merely covers a single pintle and that the examiner having had experience with the first Howe hinge knew Howe was claiming on a single hinge. Furthermore defendants allege that the claims of the second patent as written particularly emphasize that it was a single pintle and not two. But each patent is a separate contract with the government and what Howe said in securing his first patent should not be held against him in getting a patent on an entirely different hinge. Deitel v. Unique Specialty Corp., 8 Cir., 54 F.2d 359, 360; Lewis Blind-Stitch Mach. Co. v. Arbetter Felling Mach. Co., D.C., 208 F. 992.

[12] However, what is more important is that the drawing accompanying the second Howe hinge shows how it could be utilized with two pintles as well as one, and incidentally one of the arguments used by defendants in limiting Howe's first patent was that his drawings did not cover a duplex (two pintle) hinge. But Howe's drawing in the second patent did—and the drawings accompanying a patent with its claims are illuminating when the question of prior art and intended coverage is at issue. Wadsworth Electric Mfg. Co., Inc., v. Westinghouse Electric & Mfg. Co., 6 Cir., 71 F.2d 850, 852; Whitin Mach. Works v. Houghton, 1 Cir., 178 F. 444.

Defendants then produced Smith patent No. 2050469 which is also a concealed hinge mechanism for a car door where the axis of the hinge is inclined, there being two separate hinges—one at the top and one at the bottom of the car door, the hinge itself being a ball and socket arrangement. They insist that as owner of the Smith patent they had the first inclined axis theory so that plaintiff cannot claim this feature of his hinge as being new and that since the "pintle" is old in the art this was not sufficiently distinguishable from the ball and socket mechanism to be patentable.

However, using the same theory to acquaint ourselves with the scope of the Smith patent as we did in determining the scope of Howe's No. 1. hinge, we find the following significant wording used as part of the Smith patent: "It is common practice to use hinges of the pintle type in mounting the doors on vehicle bodies, *but such hinges require the pintles to be in alignment, and on the modern vehicle bodies that usually means one or more of the hinges must extend laterally outward beyond the surface of the body to such an extent as to afford considerable air resistence to the rapid transit of the vehicle.*" (Italics ours.)

Thus we find the Smith patent distinguishing its "ball and socket" feature on an inclined axis as accomplishing a result not obtainable by "pintles" and insisting that pintles could not be used on the new doors without at lease one or more of the hinges being exposed and adding that alignment was difficult. In practice, however, defendants found that their own Smith hinge was not feasible because the Smith ball and socket arrangement would not support a heavy car door and discontinued its manufacture.

We do not question that the Smith patent was a pioneer in the inclined axis hinge type but there is more to the Howe hinge than an inclined axis. The pintles themselves are inclined. Even in the drawing accompanying the second hinge in which there are two pintles, both the top and bottom pintles are inclined in complete alignment. The claims are all specifically based on an inclined pintle built into the hinge and Claims 3 and 4 are additionally based on a goose-neck hinge member of substantial curvature varying the extent of curvature from top to bottom to compensate for the inclination of the pintle.

[13] Defendants have failed to show any inclined pintle as part of any hinge for automobile doors in the prior art and even without the drawing showing a duplex unitary hinge (which plaintiff does show in patent No. 2) if, when slight changes or deviations from the patented article have been made, the new device still uses the same mechanism to obtain the same results, the licensor can collect on his contract after the prior art has not disclosed a device of the same type. Baldwin Rubber Co. v. Paine & Williams Co., supra; General Tire & Rubber Co. v. Fisk Rubber Corp., supra.

[14] To this court it is apparent that the duplex unitary hinge with the inclined pintles made and sold by defendants is practically a duplicate of the hinge shown by the duplex unitary hinge drawing appearing in Howe's second patent and the same to all intents and purposes as the unitary hinge with one pintle of that same patent. And this court holds that the examiner and the government intended to give plaintiff a patent covering a hinge having a goose-neck type hinge member with an inclined axis and an inclined pintle. Therefore we find that even if defendants made and sold only half of the duplex hinge or only part of plaintiff's hinge, under the facts of this case plaintiff can recover for such hinges also meet all of the terms in the claims of the second patent. Dowagiac Mfg. Co. v. Superior Drill Co., 6 Cir., 115 F. 886.

[15] There was some evidence that General Motors had a drawing back in November, 1937, showing the inclined axis and evidently the inclined pintle, but Howe countered by presenting a previous drawing of the same year. The testimony of neither party is extremely convincing on this point. But General Motors' hinge was not proven to be more than an experimental drawing and the hinge never was used or known to the public prior to Howe's invention. Furthermore the evidence submitted does not satisfy the rule that prior knowledge or use of an invention must be proved beyond a reasonable doubt, or, by substantially such certainty. Westinghouse Elec. & Mfg. Co. v. Wadsworth Elec. Mfg. Co., 6 Cir., 51 F.2d 447, 449; Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co. (In re Barbed Wire Patent), 143 U.S. 275, 284, 12 S.Ct. 443, 36 L.Ed. 154; Eibel Co. v. Paper Co., 261 U.S. 45, 60, 43 S.Ct. 322, 67 L.Ed. 523.

There is also some evidence that the double inclination principle was in the 1937 Chevrolet car, the first showing of which was made in 1935. In fact, defendants claim that thousands of cars embodying the Howe patent were on the streets in 1937 except that the body tumbled out instead of in. But another distinction was that the hinges were exposed. Here the hinges are concealed and of the gooseneck type, undoubtedly patentable in itself. We believe it is fair to assume that if this idea was so prevalent in 1938 defendants should have known about it. Atwood vacuum was in the hinge business and we cannot understand their interest in plaintiff's hinge in 1939-40, particularly their desire to insure the proper scope of the claims, if such a hinge was already on the market.

[16] But in any event, did General Motors have a like mechanism? This would be a question of validity pure and simple, and does not release defendants from their obligation. Baldwin Rubber Co. v. Paine & Williams Co., 6 Cir., 99 F.2d 1.

For those hinges furnished by defendants, plaintiff may recover.

As to installations where two separate hinges are used, one at the top and one at the bottom, defendants contend that here again the file wrapper should be taken into consideration and that plaintiff stated before the examiner that claim 4, which defendants insist is the only claim under which this double hinge could be read, differed from claim one only because there was a single inclination. This, we believe, to be without merit.

[17] These cases are authority for the liberality of interpreting claim coverage when apparently limited by argumentative statements before the examiner. Kellogg Switchboard & Supply Co. v. Michigan Bell Telephone Co., D.C.Mich., 5 F.Supp. 118; Byers Machine Co. v. Keystone Driller Co., 6 Cir., 44 F.2d 283, 284; Parker Rust Proof Co. v. Ford Motor Co., D.C.Mich., 6 F.2d 649, 657.

Claim four reads as follows: "4. Means adapted to support the door of an automobile body curved in transverse section comprising a concealed hinge, said concealed hinge comprising a hinge plate, a gooseneck type hinge member of substantial curvature connected directly to said hinge plate, the axis of the connection being at an inclination to the vertical as required

by the curvature of the automobile body, said hinge member varying the extent of its curvature from top to bottom thereof in an amount sufficient to substantially compensate the inclination of said axis whereby a door carried by said hinge member swings through a substantially horizontal arc."

[18] In addition, in our opinion the Atwood single type hinge, when used with one or more additional hinges, is readable upon the first three claims of patent 490 and without the claimed limitation of the file wrapper, claim No. 4 specifically covers the accused hinge in such an installation. Since we hold that plaintiff's claims are not limited, plaintiff can recover under Copeman Laboratories v. General Motors Corp., D.C., 36 F.Supp. 755. The rights of the plaintiff should be broadly accepted and in the case at bar where is there any evidence of a hinge or hinges under any other patent or prior art which embodies the Howe inclined pintle and axis hinge type? We find none.

[19] It is our holding that where there were hinges with the pintles inclined and aligned on an inclined axis fitted upon a door or in a depression of the door pillar to obtain results of the Howe patent made and sold by defendant, plaintiff may recover. This we hold whether in a duplex unitary type or in a single type hinge.

We repeat that we are not passing upon the validity of the plaintiff's patents but defendants in our opinion have manufactured and sold these infringing hinges for use on automobiles made by the following companies: Studebaker Corporation, Chrysler Corporation, and Nash-Kelvinator Corporation that they are based fundamentally upon Howe patent No. 2 and for these plaintiff can recover.

Fifth Question.

[20] Defendants claim further that under no circumstances can they be held for royalties when they did not make or sell the hinges for any particular purpose and that if there has been infringement it has been by automobile companies utilizing these hinges.

We believe that this defense is also without merit. Certainly defendants knew for what these hinges were to be used. Atwood Vacuum was making hinges for automobile car doors—not for house doors, and it participated and gave first impetus to whatever infringement there might have been. Canda v. Michigan Malleable Iron Co., 6 Cir., 124 F. 486; General Electric Co. v. Sutter et al., C.C., 186 F. 637; Elevator Appliance Co. v. Brooks, 2 Cir., 101 F.2d 703.

Sixth Question.

The next question presented is to decide the effect of the assignment of September 24th, 1940. Defendants contend that the assignment is void and of no force and effect and cites authorities that a licensee cannot assign a license agreement without the contract expressly providing for assignment. The assignment here is by the licensor rather than the licensee. However, this court has already held that plaintiff may maintain this action as to royalties on the broader grounds, namely, that plaintiff, by consenting to the contract between Metal Specialty and Atwood Vacuum, became bound thereby as licensor and entitled to royalties from defendants as licensor. Therefore whether plaintiff is entitled to maintain an action on the assignment as to monies due Metal Specialty which had accrued to the date of the assignment and whether plaintiff can maintain an action for damages for profits made after the date of the assignment must be determined.

In this connection it might be well to note that Atwood Vacuum upon receiving the assignment of September 24th, 1940, recognized in its letter of October 3rd, 1940, that it must henceforth do business with Howe.

[21] Plaintiff claims that as assignee he is entitled to excess profits as defined in the agreement and 5 percent of the sales price of hinges not to exceed $4,000.00 which accrued to September 24th, 1940, and also damages for breach of contract for failure to divide the production and profits. This court holds first, that plaintiff is entitled to maintain an action on the assignment as to any money which had already become due to Metal Specialty from Atwood Vacuum under the contract up to September 24th, 1940. Rodgers v. Torrent, 111 Mich. 680, 70 N.W. 335; and second, that he is not entitled to maintain an action for damages for profits made after the date of the assignment.

This court having decided that certain of the hinges made by Atwood Vacuum came within the scope of the agreement, defendants' actions in refusing to recognize their obligations to divide the production was an abandonment of the arrange-

ment to divide the hinge production and that the assignment of September 24th, 1940, was in effect an acceptance of the abandonment of the arrangement to divide production, precluding Howe from collecting damages for failure to divide the production accruing after September 24th, 1940.

Seventh Question.

[22, 23] Reverting, in conclusion, to the question of the termination of this contract, we hold that royalties can be collected only up to the day of cancellation. As stated in Eskimo Pie Corp. v. National Ice Cream Co., D. C., 20 F.2d 1003, 1005 "plaintiff is entitled to an accounting, to determine what royalty, if any, had accrued under its license up to the date of its cancellation, and to recover such amount, and as to this claim the defendant is estopped to plead the invalidity of the patent. From the date of the cancellation of the license contract the defendant is to be treated as any other infringer, subject to the same liabilities and entitled to the same defenses as any other infringer, unless it be held that the agreement in the license not to contest the validity of the patent continues in force after the contract has by the conduct of the parties been terminated."

[24] Metal Specialty had the right to cancel the April 19th, 1939, contract in event of default by Atwood Vacuum by giving thirty days' notice. This court has held that the arrangement between Atwood Vacuum and Metal Specialty to divide the hinge business was terminated by the assignment of September 24th, 1940. It was acquiesced in by Howe by the acceptance by him of the assignment. It is the opinion of this court that under the facts in this case Atwood Vacuum would have the right, after September 24th, 1940, to cancel the licensing arrangement upon giving Howe thirty days' notice, under the law of mutuality of contracts. Wilkinson v. Heavenrich, 58 Mich. 574, 26 N.W. 139, 55 Am.Rep. 708.

[25] We therefore believe that plaintiff is entitled to recover for hinges made and sold by defendants up to a point thirty days after defendants' letter of March 21st, 1941. In other words, from then on plaintiff must seek any redress he may claim by infringement and he cannot here recover royalties on the license agreement after that day.

[26] We further believe that plaintiff is entitled to recover excess profits as defined in the April 19th, 1939, contract to September 24th, 1940, and 5 percent of the sales price, but not to exceed $4,000.00 on hinges sold by Atwood Vacuum prior to September 24th, 1940, as assignee of Metal Specialty, but that he cannot recover excess profits after September 24th, 1940.

An accounting between the parties will be made in accordance with this opinion and if unable to reach an agreement on the number and the amount the matter will be referred by this court to a master for the taking of testimony.

[27] Defendants' counterclaims for damages caused by the garnishment proceedings, brought simultaneously at institution of suit and for wrongful termination of the license contract between Metal Specialty Company and Atwood by the assignment of September 24th, 1940, are hereby dismissed—no damages having been shown.

An order in conformity with this opinion may be submitted to the court for its signature.

42 IN THE UNITED STATES DISTRICT COURT.

* * (Caption—54-C-1893) * *

N. D. Ill., E. D. Judge La Buy

167 F. Supp. 330 (1958) P.A. 51-62

FINDINGS OF FACT.

1. This is an action, with a jury demand, by Earl E. Howe, Plaintiff, against General Motors Corporation, Defendant, charging infringement by defendant of U. S. Letters Patent No. 2,201,490 for "Inclined Hinge", which issued May 21, 1940, and expired by its terms during the pendency of this action, which was filed December 17, 1954.

2. In response to a Motion for More Definite Statement, plaintiff specified that the defendant infringed the patent in suit by the use in automobiles of the hinging structure of the following automobile models:

Front doors—1953-54 Chevrolet
Front doors—1953-54 Pontiac
Rear doors—1950-51 Oldsmobile 98
Rear doors—1950 Buick, 40, 50 and 70
Rear doors—1951 Buick 50
Rear doors—1951-51 Cadillac 61
Front doors—1954-55 Oldsmobile

Front doors—1954-55 Buick 40 and 60
Rear doors—1955 Oldsmobile
Rear doors—1955 Buick 40 and 60
Front doors—1951-53 Oldsmobile Super 88
Front doors—1951-53 Buick 40
Front doors—1952-53 Oldsmobile 98
Front doors—1948-49 Oldsmobile 90
Front doors—1948-49 Cadillac 60, 61 and 62
Front doors—1949 Buick 50 and 70
Rear doors—1950-53 Buick 50 and 70
Rear doors—1950-53 Cadillac 60 and 62
Front doors—1954-55 Buick 50 and 70
43 Front doors—1954 Cadillac 60 and 62
Front doors—1955 Cadillar 62
Front doors—1955 Cadillac 60
Front doors—1948-49 Cadillac 75
Rear doors—1950-51 Cadillac 75
Front doors—1954-55 Cadillac 75
1948-1955 Chevrolet trucks
1948-1955 GMC trucks

3. The claims charged to be infringed with respect to each of such models as shown in blueprints filed by defendant are specified in Plaintiff's More Definite Statement.

4. The Howe patent in suit is directed to a gooseneck hinge of the pintle or hinge pin type for swingingly supporting a door of an automobile body from a curved body wall (that is, one with tumble-in), with a double inclination of the hinge axis to compensate for the tumble-in angle of the body so that the door can swing in a substantially horizontal arc. All of the claims of the Howe patent in suit are limited to a concealed hinge for supporting a door on a curved or inclined wall with the axis of the hinge pin having a double inclination so that the door in opening and closing swings through a substantially horizontal arc.

The patent discloses a unitary gooseneck hinge which supports the door, Figure 5 showing a double hinge having dual or separate hinge pins. Claims 3 and 4 are specifically limited to a gooseneck type of hinge. The gooseneck hinge disclosed in the Howe patent supports the door so that when the door is swung open is moves to a swing-out position; that is, in addition to swinging away from the body, it swings forwardly and provides much greater leg room for entrance to and exit from the body.

5. Upon motion of defendant, it was ordered on June 6, 1956 that the equitable defense of laches and estoppel asserted in Paragraph 10 of the Defendant's Answer be tried separately before the Court in advance of the jury trial of legal issues of validity and infringement. The trial of such equitable defense commenced before the Court on January 30, 1958 and was concluded on February 5, 1958. Since that time, both parties have filed briefs and proposed Findings of Fact and Conclusions of Law with the Court.

6. Earl E. Howe is now the owner of the patent in suit and of all rights thereunder, and he was the owner of the patent and such rights at the time this action was filed.

7. Plaintiff, Earl E. Howe, did not own the patent in suit and all of the rights thereunder during portions
44 of its term, including the period from the time of the issuance of the patent until final disposition of the suit between plaintiff and Atwood Vacuum Machine Company which occurred in 1953, and in the period between June 16, 1952 and October 6, 1954 when the patent in suit and all rights thereunder were owned by a joint venture, Howe Associates.

8. On March 16, 1938, Mr. Howe granted an option to The Metal Specialty Company, an Ohio corporation, to obtain an exclusive license under his patent rights, including those resulting in the patent in suit and an ex-

clusive license pursuant to the terms of such option agreement was executed on May 24, 1939, at which time the application for the patent in suit was pending in the United States Patent Office. The option and license to The Metal Specialty Company (Pl. Ex. 71) gave to the licensee the right to grant a sub-license and, on April 19, 1939, with Howe's consent, a license (Pl. Ex. 6) was granted to Atwood Vacuum Machine Company. This agreement in subsance divided the license rights from Howe between The Metal Specialty Company and Atwood Vacuum Machine Company. Subsequently, because of disputes between these two licensees, The Metal Specialty Company, on September 24, 1940 (Pl. Ex. 70) assigned to Mr. Howe all of its rights under the Atwood agreement (Pl. Ex. 6) and The Metal Specialty Company was released by Mr. Howe from its license agreement (Pl. Ex. 71). Atwood Vacuum Machine Company, however, continued as a licensee under the patent in suit, which had then issued, and a dispute arose between the Atwood Company and Mr. Howe relative to payment of royalties under the agreement. An action was filed by Mr. Howe against the Atwood Company for royalties and, after the suit was pending, the Atwood Company, on March 21, 1941, gave notice to Mr Howe that it no longer considered itself a licensee under the license agreement. The Howe v. Atwood action pending in the United States District Court at Detroit, Michigan was decided October 7, 1942 by The Hon. Frank A. Picard, United States District Judge, his Opinion thereon being published in 47 F. Supp. 979. In this Opinion and in the Judgment, it was held that the Atwood license was terminated thirty days after its letter of March 21, 1941, i.e., on April 20, 1941. After Judge Picard's Opinion of October 7, 1942, further steps relative to appeal or final disposition of the Howe v. Atwood case were carried on and the case was finally settled by the parties without an appeal or an accounting by an agreement of settlement.

9. Mr. Howe was not possessed of the entire right, title and interest in, to and under the patent in suit from a time prior to its issuance until some time in February, 1943 when the case of Howe v. Atwood was finally disposed of.

10. In February, 1943 and for some time prior thereto, World War II was in progress and General Motors
45 Corporation was not engaged in the production of passenger motor vehicles because of restrictions imposed by the Government, required by war purposes. While World War II terminated in August, 1945, General Motors Corporation did not resume the general production of automobiles until some time in 1946 because of a long strike of General Motors Corporation employees in the early part of 1946.

11. General Motors Corporation's first production of automobiles after the war did not involve new model automobiles until production commenced on the 1947 models.

12. On June 16, 1952, Mr. Howe entered into an agreement (Def. Ex. 99) with Ray W. Springer and the Detroit law firm of Toy and Toy, organizing a joint venture between them, one of the purposes of which was to obtain compensation for infringements of Howe patents, including the patent in suit. On June 16, 1952, Mr. Howe assigned the patent in suit and all rights of action thereunder to the joint venture (Def. Ex. 100). On October 6, 1954, the assignment to the joint venture was revoked and the joint venture agreement, including a license (Def. Ex. 101) to Howe Hinge Company was terminated by agreement between the parties thereto (Def. Ex. 102).

13. Earl E. Howe was not the owner of the patent in suit and of all the rights thereunder, including the rights to recover for infringement thereof, during the period commencing June 16, 1952 and ending October 6, 1954.

14. After October 6, 1954 when Earl E. Howe reacquired ownership of the patent in suit and of all rights thereunder,

preparations were made for the filing of the present action, which was filed on December 17, 1954.

15. The defense of laches and estoppel as set forth in Paragraph 10 of Defendant's Answer asserts that as a result of plaintiff's silence, acquiescence and lack of diligence during a period of more than fourteen years:

(1) Defendant has been led to believe that plaintiff has abandoned his charge of infringement and did not consider the hinged structures of defendant to violate any of his patent rights;

(2) Defendant has materially changed its position during said period;

(3) Defendant has been placed in a materially disadvantageous and prejudicial position because:

(a) Witnesses having knowledge of facts pertinent to defendant's defenses have died or otherwise become unavailable; and

46 (b) Documents and physical structures in support of said defenses have been destroyed, lost or misplaced.

16. The particular defense referred to in Paragraph 10 of the Answer which defendant contends has been affected by the delay in filing this action is the so-called "B. O. P. Defense" of prior invention by General Motors Corporation of the subject matter of the patent in suit.

17. During 1937 and 1938 and subsequently before the patent in suit issued, Earl E. Howe discussed automobile door hinges and hinging problems with a number of officers and employees of General Motors Corporation, making and demonstrating a number of models and drawings and even preparing and submitting full-size models for automobile door installations. The parties are in dispute as to the precise dates of many of these meetings, but there is no evidence that in these discussions in 1937 and 1938 General

Motors Corporation asserted to Mr. Howe that his developments in door hinging had been previously invented by General Motors Corporation or someone working for the defendant.

18. The application for the patent in suit was filed January 9, 1939 and it discloses door hinging means which are completely concealed from the exterior of the automobile when the doors are closed. All of the claims of the patent call for a concealed hinge "for supporting" or "adapted to support" a door.

19. The hinging means of the so-called "B. O. P. Defense" were first made available to the public by General Motors Corporation in the fall of 1938 upon the so-called 1939 automobile models. In such cars, the front doors were supported by two hinge portions, the lower one of such portions being concealed when the door was closed and the upper portion being exposed and protruding beyond the plane of the car body at that point.

20. On the 1939 B. O. P. automobile bodies, both the concealed hinge portion and the exposed hinge portion are required to support a door and no such 1939 automobiles were sold by defendant without both such hinging portions being used.

21. On June 21, 1940, one month after the patent in suit issued, plaintiff gave notice of infringement of the patent to General Motors Corporation. Subsequent notices of infringement were made on a number of occasions in 1940, 1941 and 1942. General Motors Corporation was fully aware of the Howe v. Atwood litigation. After Gen-
47 eral Motors Corporation resumed production of passenger automobiles following World War II, additional notices of infringement were given to it in 1947, 1949, 1951 and 1952.

22. The plaintiff was not silent in asserting to General Motors Corporation his charge that it was infringing the

patent in suit during the period prior to the filing of this action and there is no substantial evidence that defendant at any time was led to believe that plaintiff had abandoned his charge of infringement or that plaintiff did not consider concealed hinge structures of defendant to violate plaintiff's patent rights.

23. In 1949, General Motors Corporation did not consider that plaintiff had been silent or that he had abandoned his charge of infringement for it was recognized in their own records of September 2, 1949 (Pl. Ex. 88) that "Howe has been persistent" in asserting his claims. An officer of General Motors Corporation on September 20, 1949 wrote to Mr. Howe, again rejecting any settlement, but making no reference whatsoever to any charge of laches, neglect, silence or delay on the part of Mr. Howe (Def. Ex. 49-50).

24. In 1953 and 1954, General Motors Corporation advertised the 1954 Buick automobile, extolling the advantages of concelead swing-out hinges and the matter of the Howe patent was sufficiently in the mind of General Motors Corporation at that time that the Head of its Patent Section, Mr. Willits, had employees of the Patent Department of General Motors Corporation again look into the Howe hinge matter.

25. The fact is sustained by substantial evidence that General Motors Corporation was never lulled into any belief that the plaintiff had either abandoned his charge of infringement against General Motors Corporation or had reached a decision that the hinge structures of defendant did not violate his patent rights.

26. From the time the Howe patent issued in 1940, up to the present time, General Motors Corporation has taken the position that the Howe patent in suit is invalid and it has at all times continued to manufacture a series of changed and altered hinging means designed for each new model automobile which it has produced with a disregard

for the notices of infringement sent to it by Mr. Howe because of its stated belief that the Howe patent is invalid rather than because of any belief by General Motors Corporation that plaintiff either abandoned his charge of infringement or had decided that the hinge structures of defendant did not infringe his patent rights.

48 27. Each year that General Motors Corporation has changed to a new model of an automobile to be offered for sale to the public, the design of hinging means for the doors of such models has been a new and independent undertaking since it is stated by General Motors Corporation that replacement hinges must be made for each model automobile even though the hinge elements may appear to be closely similar.

28. The delay of plaintiff in filing an action charging infringement by a 1949 automobile model is a different and separate delay from a charge of infringement or action for infringement against a subsequent automobile model made by General Motors Corporation, such as a 1953 or 1954 model.

29. Defendant asserts that it has expended large sums of money for tooling, dies and the like for the several hinging means which are charged to infringe and defendant asserts that the expenditures for such tools have resulted in a material change of its position during the period since the first hinging means charged to infringe were made. However, it appears clearly from the record that tooling costs of General Motors Corporation are amortized completely by it during the sale of each specific model automobile and that such costs have been completely amortized at the time the manufacture and sale of automobiles by General Motors Corporation has been diverted to a new model. Since the cost of tooling has been amortized and charged off against income as to every automobile car model charged to infringe in this action, such tooling costs do

not represent a matter of change of position or of prejudice to the defendant resulting in any inequity in maintaining the present action.

30. The defendant contends that by the lapse of time, documents and models have been lost, witnesses have died or become unavailable and witnesses' memories have become dimmed or confused. It has not been shown by the defendant that any dead or unavailable witnesses are necessary or essential and that their absence is materially prejudicial to the defense.

31. The fact that General Motors Corporation did participate in the Howe v. Atwood case establishes that during that litigation it was in no way misled into a belief that Howe was acquiescing in any infringement by General Motors Corporation which occurred prior to the war. There is no evidence to show that anything that Howe ever did or did not do lulled General Motors Corporation into a belief that it had a right to use the inventions described and claimed in the Howe patent in suit without liability therefor.

49 32. Because Howe had already charged and was charging defendant with infringement during the period from 1940-1942, defendant looked into and followed the Howe v. Atwood case brought by Howe in 1941 in Detroit, Michigan, against Atwood for royalties due under an agreement wherein Atwood was licensed under the Howe patent. Only hinges made by Atwood and none of defendant's hinges were covered by the license agreement. Defendant, at the request of Atwood and his attorneys, supplied some information, made suggestions and furnished some evidence, but the decision to use or not to use such information, suggestions and evidence was solely that of Atwood and his attorneys, Meder, Larwin and Wintercorn, who were under no compulsion whatsoever from defendant. Defendant was not a party to the suit or in privity with

Atwood, did not contribute to the defense of the suit, had no financial interest in the outcome of the litigation, had no legal right to defend or appeal from the decree and did not control or participate in the control of the defense of that suit. The decision to settle the case and not to appeal was Atwood's sole decision. Defendant, therefore, is not estopped by the Howe *vs.* Atwood decree of Judge Picard in favor of Howe from relying herein on its 1939 BOP defense of prior invention nor is defendant guilty of any unclean hands or of any misconduct by reason of its assistance to Attood in Howe *vs.* Atwood and its following of that suit.

33. Material in evidence from General Motors' files and records show that General Motors recognized the likelihood of a suit by Howe and of the importance of collecting and preserving evidence; that General Motors had been repeatedly warned by its own counsel of the likelihood of a suit; that General Motors continued its infringement because of its belief that the Howe patent would not be sustained, rather than that Howe had abandoned his claim as now asserted.

34. General Motors has not shown that it has any investment which would be jeopardized by a trial of this case.

50 Conclusions of Law.

1. The facts of record do not establish that defendant has been led to believe that plaintiff has ever abandoned his charge of infringement or that he has not considered the accused hinging means sold by defendant to infringe the patent in suit.

2. The facts of record do not establish that defendant has changed its position in any material manner such as would make it inequitable for plaintiff to prosecute this action for infringement.

3. The facts of record do not establish that delay in filing action has resulted in the loss of any material or necessary evidence, or in the death or unavailability of any necessary or essential witness.

4. The present action is based upon new and different acts of infringement by defendant which have occurred in the six years prior to the filing of this action and not before. There is no evidence which shows that such acts were committed by defendant in reliance upon any silence or acquiescence of the plaintiff and the mere lapse of time which has occurred between the commission of such acts and the filing of this action does not constitute laches.

5. The facts of record do not establish that General Motors Corporation in reliance upon acts or silence by plaintiff upon which General Motors Corporation had a reasonable right to rely was led to change its position in any way such as to create an equitable estoppel which would prevent the plaintiff from prosecuting this action.

6. Mere delay does not establish laches and the burden of sustaining the defense of laches and estoppel rests upon the party asserting such a defense. The defendant has not sustained this burden.

7. This cause shall proceed to trial on the merits of the charge of patent infringement at a date to be fixed by the Court.

Walter J. LaBuy,
United States District Judge.

Dated: October 17, 1958.

UNREPORTED * D. A. III 2156 - 2160

1 IN THE UNITED STATES DISTRICT COURT.

* * (Caption—54-C-1893) * *

TRANSCRIPT OF PROCEEDINGS had in the above entitled case before the Hon. J. Sam Perry, one of the judges of said court, in his courtroom in the United States Court House, Chicago, Illinois, on September 29, 1961.

Present:

Mr. Warren C. Horton, Mr. Marshall Sutker, appeared on behalf of plaintiff;

Mr. George N. Hibben, appeared on behalf of defendant.

By the Clerk: 54 C 1893, Howe *vs.* General Motors. Motion for an order setting aside this court's order of September 20, 1961, granting a new trial, and for further order granting a rehearing on plaintiff's motion for new trial. There is also a motion for judgment in accordance with defendant's motion for directed verdict filed on April 6, 1961.

2

Mr. Hibben: If the court please, I called Mr. Horton during the lunch hour. We just received notice of this order this morning from the clerk's office, the order being entered on the 20th of September, and we have ten days under Rule 50 in our opinion within which to file one of these motions. Consequently we went in before Judge Miner at 2:00 o'clock, to whom this case had been reassigned by the executive committee, and he stated that he was not in a position to rule on these motions and he therefore transferred this back to this court for the purposes of these post-trial motions.

We are asking at this time that this court hear these motions. We would like to file briefs and be heard on the motions.

Mr. Horton: If your Honor please, the motion for directed verdict which is now presented, was of course
3 —there was a motion for directed verdict presented during the course of the trial and at the close of all evidence. Then there was a verdict by the jury which disposed I think of the motion for a directed verdict, since it was in favor of the party making the motion.

Then there was a motion for new trial, and the motion for new trial of course is directed to the discretion of the court and that was granted.

I do not think, as I understand it, that there can be a motion for directed verdict which would stand in the face of the order for a new trial. I think that would be moot, and it therefore seems to me that the only proper motion is whether or not there is to be reconsideration of our motion for new trial.

Mr. Hibben: If the court please, I would like to be heard in brief on that point as to that motion, but I would like to call the attention of the court to a similar situation in a patent case that came up out of New Orleans where there was a jury verdict in favor of the defendant, it went up to the Court of Appeals, the Court of Ap-
4 peals reversed and sent it back down for new trial, but in its opinion the Court of Appeals stated that perhaps the defendant could then bring up its motion for directed verdict, which it did do, and that was under Rule 50, and we have a similar situation here.

We believe that this motion for a judgment in accordance with the motion for directed verdict is perfectly proper.

The Court: Well, offhand it would seem to me that the motion for directed verdict, we would have had a hearing on that had the matter been brought up. However, it seems to me to have become moot. You have that very relief which you asked for. You asked for a directed ver-

dict and the jury gave you that verdict. So the jury superseded any order of mine.

Mr. Hibben: That motion was directed to the attention of the court and not to the jury, and it would be based upon matters of law that would not be for the jury, and that was the purpose of that motion, and it has never been ruled upon, nor was it ruled upon in the case of Thurber *vs.* Fairchild and Ford Motor Company in the eighth circuit, but the district court did hear, and after reversal the defendants in that case did get the verdict.

5

I certainly would like to—

The Court: Your theory was that the plaintiff did not make a case. That was the theory of your motion for a directed verdict, wasn't it?

Mr. Hibben: That would be part of it, that—

The Court: That they did not legally make a case.

Mr. Hibben: Yes, that would be part of it, but we would be entitled as a matter of law—

The Court: That is the substantial—

Mr. Hibben: Well, it is more than that.

The Court: That is what I mean, as a matter of law, that is the heart of your—

Mr. Hibben: As a matter of law, aside from the facts. I would like to brief this point, if the court please, and show the court decisions on that point. I believe that Thurber *vs.* Fairchild—

The Court: Well, I spent a lot of time on it. It would seem to me that everything should have been covered in the briefs on the motions that were made to set aside the jury verdict. I can't change the law, but I will say this, that the complicated issues of that case and similar cases, going to a jury, I cannot understand that as being a case for a jury. The jury was so completely confused in that matter, even the foreman of the jury wrote me and said, "We just didn't know what it was all about."

6

Mr. Hibben: Well, if the court please, patent cases are primarily for a judge—

The Court: That is right.

Mr. Hibben: And we had no—

The Court: Of course, that case was not for a jury.

Mr. Hibben: We had no choice in this case. Plaintiff asked for the jury—

The Court: I know it, I know it.

Mr. Hibben: —and we did the best we could.

The Court: I know plaintiff asked for the jury, but it is no case for—

Well, I will be perfectly frank with you, had it been a non-jury case I would have found the patent good and would have found infringement, and that is really the heart of why I granted a new trial, because I think it is my
7 duty to give my best opinion as to what justice should ultimately be, and I thought that it was a valid patent and I thought it was infringed, and I also thought that the tremendous amount, tremendous amount, of demonstrative evidence that was presented by the defendant, the innumerable doors that were brought in, the excessive amount of evidence, did unduly influence the jury in the matter.

I do not think I wish to go into it any further, gentlemen. I believe that the order should stand as it is. If I am wrong in refusing to consider a motion to direct a verdict after a jury has rendered a verdict, there is an adequate appeal from that. But I spent over a month in trying that case, I spent hours and hours on the briefs in this matter, and I think I shall deny the motions and leave the record as it is. That is my honest opinion about it.

Mr. Hibben: May I ask the court, the remarks of the court then that have been given today are the grounds for the granting of the motion for a new trial?

The Court: Those are not full and in detail, but
8 you are perfectly at liberty to have my statement written up as some of the things I had in mind when I considered this case. If I ever saw a good patent that was it. That was my honest opinion of the matter. If there had been too much of a serious doubt I would not have granted a new trial by a jury. That is also the reason why I sent it to another judge, that I felt I already had my mind made up and if it should be tried that a judge who had not already formulated an opinion should hear it. I thought I owed that to you and your client to let a judge who had not made up his mind on it handle it, and I studied this record and I made notes on the matter, and that is my honest opinion.

I don't like to render all the decisions in favor of this gentleman here, but—

Mr. Horton: You haven't all, your Honor.

The Court: —but I had to render two right straight along here—

Mr. Horton: It was nice that they came so close together.

Mr. Hibben: If the court please, we have never really had a ruling on that motion for directed verdict, and
9 on the motion for new trial we did not have an opportunity to go into the merits. I directed my remarks to the matter of certain points in evidence and to the instructions, but we never did review the case before your Honor on the merits as a matter of law and anticipation by the prior art patents.

I would like an opportunity to be heard on that, because it has been way back since last March and April that this was before the jury and this court.

Mr. Horton: If your Honor will recall, there were proposed instructions to the jury which were in the court with the motion for a directed verdict, and which directed verdict motion called for a directed verdict for the defendant. Those were argued.

Mr. Hibben: Though not on the merits.

The Court: I recognize I could set down a hearing for that, and if I still decided as I do that the whole question would be moot, I recognize the possibility that you would have a right of appeal on it, that there is a legal point there maybe, but I am firmly convinced that after hearing all of the facts and all of the law on it, that had it been brought to my attention I would have refused to grant your motion for a directed verdict, and so I don't wish to prejudice your right to appeal that point. Therefore, I do not wish to rule on that point any further. I think the jury's verdict has sufficiently cured it. It may be that I am in error, and if so the court above can tell me, but you know my position on it.

I don't believe that I wish to go into the case any further. It was my best judgment, and I told you my opinion as to the law and as to the facts is that there was a good patent, and that it was infringed.

You can know why my decision would be—unless there is something revolutionary, if I spent more time on it, and after spending five weeks in trial on it and then weeks going over the briefs, and so on, hours and hours, I believe another judge should take a fresh look at it.

Motion denied. I think we will leave it as it is.

265 IN THE UNITED STATES DISTRICT COURT.
* * (Caption—54-C-1893) * *
N. D. Ill., E. D. Judge Robsán
252 F. Supp. 924 (April 5,1966); P.A. 708 - 737

DECISION ON THE MERITS.

History of Litigation.

This suit, filed December 17, 1954, concerning the validity and infringement of the Howe Patent No. 2,201,490, on an "Inclined Hinge," is now before the court for decision on the merits, after trial by the court. A long and tortuous background preceded this decision.

The first adjudication was that of Judge Walter J. La Buy, who in October, 1958, after hearing evidence, overruled the defense of laches and estoppel (*Howe* v. *General Motors Corporation,* 167 F. Supp. 330 (N. D. Ill. 1958). Subsequently, there was a jury trial in June, 1960, before Judge La Buy, which ended in a hung jury. Judge La Buy denied defendant's motion for a directed verdict without stating his reasons for the denial.

266 A second jury trial in April, 1961, before Judge J. Sam Perry, resulted in finding the defendant not guilty. Judge Perry vacated and set aside this finding and ordered a new trial. Following this ruling the Court of Appeals denied a petition for a writ of mandamus, or, in the alternative, for a writ of certiorari, finding no abuse of discretion in the denying of defendant's motion for a directed verdict, which motion had been taken under advisement during the course of the trial (*General Motors Corporation* v. *Perry,* 303 F. 2d 544 (7th Cir. 1962)). There had also been a suit, in another district, upon a license granted by Howe at the time the application for this patent was pending, upon which license litigation ensued with an opinion in favor of patentee (*Howe* v. *Atwood,* 47 F. Supp. 979

(E. D. Mich. 1942)), and which litigation ended in a settlement without appeal.

The observations of the various judges who have had occasion to comment upon the Howe patent are interesting. In the royalty suit between Howe and licensee Atwood (*Howe* v. *Atwood*, 47 F. Supp. 979 (E. D. Mich. 1942)), the court said, at 986:

> "* * * [I]t is the understanding of this court that the secret of the claims of the second hinge [Patent '490] lies in the fact that the inclination of the axis inwardly from the car door and longitudinally towards the front of the car is accomplished by the use of an inclined pintle built into the hinge, this inclination being compensated for by using a gooseneck hinge member varying the extent of its curvature from top to bottom."

267 The Court goes on, at 987:

> "* * * [T]he drawing accompanying the second Howe hinge shows how it could be utilized with two pintles as well as one, and incidentally one of the arguments used by defendants in limiting Howe's first patent was that his drawings did not cover a duplex (two pintle) hinge. But Howe's drawing in the second patent did—and the drawings accompanying a patent with its claims are illuminating when the question of prior art and intended coverage is at issue."

Judge La Buy in *Howe* v. *General Motors Corporation*, 167 F. Supp. 330 (N. D. Ill. 1958), stated, at 331:

> "* * * [The patent] is directed to a gooseneck hinge of the pintle or hinge pin type for swingingly supporting a door of an automobile body from a curved body wall (that is, one with tumble-in), with a double inclination of the hinge axis to compensate for the tumble-in angle of the body so that the door can swing in a substantially horizontal arc. All of the claims of the Howe patent in suit are limited to a concealed hinge for supporting a door on a curved or inclined

wall with the axis of the hinge pin having a double inclination so that the door in opening and closing swings through a substantially horizontal arc. The patent discloses a unitary gooseneck hinge which supports the door. . . . The gooseneck hinge disclosed in the Howe patent supports the door so that when the door is swung open it moves to a swing-out position; that is, in addition to swinging away from the body, it swings forwardly and provides much greater leg room for entrance to and exit from the body."

Judge Perry in a statement made on September 29, 1961, on a motion for an order setting aside the order of September 20, 1961, granting a new trial, said:

"• • • I will be perfectly frank with you, had it been a non-jury case *I would have found the patent good and would have found infringement,* and that is really the heart of why I granted a new trial, because I think it is my duty to give my best opinion as to what justice should ultimately be, and I thought that it was a valid patent and I thought it was infringed, and I also thought that the tremendous amount of demonstrative evidence that was presented by the defendant, the innumerable doors that were brought in, the excessive
268 amount of evidence, did unduly influence the jury in the matter. . . . That is my honest opinion about it. . . . If I ever saw a good patent that was it. If there had been too much of a serious doubt I would not have granted a new trial by a jury. . . . It was my best judgment, and I told you my opinion as to the law and as to the facts is that there was a good patent, and that it was infringed." (Italics added.)

Decision.

This court after a careful examination of the prior proceedings reaches the unescapable conclusion that the patent is invalid because anticipated by the prior art and as one which should have been obvious to a skilled worker in that field in view of that prior art.

Patent and Pleadings.

Patent No. 2,201,490, consisting of four claims, issued May 21, 1940, upon an application filed January 9, 1939, expired May 21, 1957. Written notice of infringement was given defendant on July 10, 1942. Infringement is charged for the period from December 17, 1948, to date of the patent's expiration in 1957.

The complaint and supplement thereto charge infringement by defendant "by making and/or selling automobiles wherein the front doors of the bodies thereof are supported by concealed hinging means of the gooseneck type as covered by said Patent No. 2,201,490," and allege the damages for infringement to exceed a million dollars, and seek treble damages. An amendment to the complaint and supplemental complaint filed July 18, 1963, asked for an accounting of the damages and withdrew the demand for a jury trial.

269 The answer denied infringement and asserted invalidity of the patent on the ground that the invention was disclosed in prior art patents and publications, and the alleged invention had been known and reduced to practice by General Motors more than two years prior to the disclosure in the application for the Howe patent. Further, defendant asserts lack of invention; Howe's disclosure involving mere mechanical skill; the claims of the patent are vague, and they are broader than the scope of the original application and are not supported by supplemental oath of the applicant.

Howe stated in his patent that "[t]his invention relates to a concealed door hinge particularly adapted for swingably supporting a door from a curved wall, as for example, the support of an entrance door of an automobile which is curved in direction normal to swinging movements and further, in conjunction with walls which are inclined as in

the case of an automobile body having upwardly converging side walls."

The highlight of plaintiff's invention would seem to be the fact that the hinge is *completely concealed* within the body of the car thereby maintaining the trimness of body line and protection of the hinge from the elements. This is achieved on a car, the contour of which is *inwardly* inclined by having the axis of the hinge also inclined inwardly, and generally forwardly, with the result that when the door is opened it swings *in a substantially horizontal arc.* This prevents sudden closure of the car door due to force of gravity on a passenger entering or alighting.

270 Stipulated Facts.

The stipulation of facts filed December 30, 1963, presents these facts: Plaintiff, Earl E. Howe, is the owner of all rights under the patent in suit. An exclusive licensee, The Metal Specialty Company of Ohio, had granted a sublicense to the Atwood Vacuum Machine Company but the Metal Specialty Company assigned its rights back to Howe, who, when a dispute arose, sued the Atwood Vacuum Machine Company and had an opinion in his favor. Defendant was not a party to the Atwood litigation, but followed it. It had no control over it although it furnished some evidence therefor.

Each of defendant's hinges charged to infringe includes an upper hinge element and a lower hinge element. The claims which they allegedly infringe are stated.[1]

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1. Nos. 12 (12-U & 12-L), 14 (14-U & 12-L), 18 (18-U & 18-L), 26 (12-U & 12-L), and 36 (12-U & 12-L), charged to infringe Claims 1 and 2.

Nos. 19 (19-U & 19-L), 33 (33-U & 33-L), 29 (27-U & 31-L), 31 (27-U & 31-L), 40 (40-U & 41-L), and 42 (42-U & 42-L), charged to infringe Claims 1, 2, 3 and 4.

Nos. 27 (27-U & 27-L), 37 (27-U & 27-L), B (302-U & 302-L), G (307-U & 302-L), I (309-U & 302-L), and L (312-U & 312-L), are all charged to infringe Claim 4.

The stipulation of facts also sets forth the precise automobile, year, make and series, which infringes each of the claims, and further gives the exact inclination of the hinge axis, all of which are inclined inwardly, and some of them are specified to be also inclined forwardly or rear-
271 wardly. It is also stated whether the hinge occurs on the front or rear doors. The exact angle of inclination is given in each instance.

The prior art patents on which defendant relies are:

Richard, No. 1,325,109 issued December 16, 1919 (concealed hinge but pin vertical).

Smith, No. 2,050,469 issued August 11, 1936 (not concealed but no pins).

Carr, No. 2,114,830 issued April 19, 1938 (means not concealed on inside).

Soss, No. 1,363,370 issued December 28, 1920 (not limited to autos and inclined walls).

French patent (Mouche), No. 537,011 issued in 1922.

A publication by von J. Feldwabel, published in Germany in 1920, and other publications are also relied on as prior art.

Discussion of Prior Art and Contentions in Respect Thereto.

I. Mouche Patent.

As to the prior art, the French Mouche Patent No. 537,011 was applied for June 4, 1921, and granted February 23, 1922. Mouche states (as revealed by the translation):

> "The present invention has for object a hinge device applicable especially to doors, the profile of which vertically affects a more or less pronounced curvature which corresponds exactly to the profile of the wall having the door, such as, for example, the doors or carriage doors of automobiles, horse-drawn vehicles, cars, etc.

> "By its disposition this system compels the door on which it is mounted to expand during the opening and closing while preserving a constantly vertical position. Furthermore, this hinge takes up no external space being lodged in the thickness of the panels of the partition and of the door on which it is mounted."

272 Plaintiff reads this foreign patent in the light of the legal principle that "[t]he law is very well established that 'a foreign patent is to be measured as anticipatory, not by what might have been made out of it, but by what is clearly and definitely expressed in it.' *Borg-Warner Corp. v. Mall Tool Co.*, 220 F. 2d 803, 805."

Plaintiff points out that the Mouche patent called for an *outward and rearward* inclination of the axis, and pertained to a *tumble-out* body. The upper hinge is smaller in curvature than the lower hinge. Mouche showed a wooden door and described pintles out of alignment, and stressed the vertical position of the axis. There was no glass in the Mouche door. Carl E. Hedeen, General Director of Engineering of the Fisher Body Division of General Motors Corporation, testified that the Mouche drawing shows a compound angularity of the hinge is required. No vehicle was built with the Mouche hinge. Plaintiff asserts that the Mouche patent discloses an inoperative structure, and Mouche did not recognize or solve the problem covered by the Howe patent.

On the other hand, defendant argues that the Mouche patent discloses "all of the features of the Howe patent," being similar in structure, mode of operation and result, with the same problem and the same result. Further, if Mouche is to be held inoperative because the door does not open to a full 90° so must Howe be held inoperative. The Mouche patent, although a foreign patent, is applicable because its disclosure is clearly expressed to a man skilled in the art.

273 **II. The Carr Patent.**

The Carr Patent No. 2,114,830, applied for January 15, 1935, and issued April 19, 1938, pertained to "an improved vehicle body of the convertible type which is streamlined both when the top and windows are raised and when both the top and windows are lowered. . . ." Plaintiff differentiates the Carr patent in that Carr's hinging means are "concealed" but only in the sense that they are covered or screened from view by *additional structure.* They are not *within* the contour of the body. The hinging means near the top of the door extends to a substantial extent inside the body, as does the lower hinge means. *The hinge is not inclined* in any manner as described by Howe. The Carr hinge is at the *rear* of the door, and if at the front edge, both top and bottom of the hinge means would be outside the body contour.

Mr. Hedeen stated that Carr showed a tumble-in body and describes a concealed hinge of gooseneck variety and inclination of axis rearwardly, and inwardly or outwardly, and glass in the doors. On cross-examination, he stated he never knew a car built like that shown in the Carr patent, which covered a single door hinged at the rear.

Defendant points out that Carr teaches that the hinge axis may be inclined inwardly as well as rearwardly which is the same as the compensating hinge axis inclination on the rear door in Figure 1 of the Howe patent. Carr's upper gooseneck hinge is of greater extent at the top than at the bottom so as to be of tapered shape like Howe.

274 **III. The Richard Patent.**

Plaintiff distinguishes the Richard Patent No. 1,325,109, which issued December 16, 1919, on an application filed March 10, 1919, for a "Hinge Construction" as disclosing a hinge for a touring car and not a car with an *inclined*

body. The axis of the pintles is vertical and there is no inclination whatsoever either described or shown. The hinge arms at the top and bottom of the door have the *same* reach. The hinge is *exposed* on the inside of the body. No car was ever made using the Richard hinge. Mr. Hedeen testified that since the wall or door edge was vertical in Richard and the hinge axis vertical, constant sized hinges could be used. The drawing discloses a curved body but not one inclined inwardly from the base up, rather a symmetrical curvature so that the axes of the hinges are in vertical alignment.

Defendant states that "Richard's body styling did not require an inclined axis" but that the problem he solved was to provide *concealed* hinging which would throw a curved door out away from the body at top and bottom, and Howe's hinge does so in a similar manner.

IV. 1917 Chevrolet.

The 1917 Chevrolet, cited as anticipatory, had *concealed* hinges, Mr. Hedeen testified. The door axis was inclined *outwardly*, with the result the door fell on opening, in the neighborhood of an inch, which he considered to be a substantially horizontal arc. Mr. Hedeen admitted the 1917 Chevrolet door was light weight, with axis inclined outwardly, not forwardly or rearwardly, and had a *tumble-*
275 *out* side. This 1917 Chevrolet, defendant maintains had its front doors supported by means of separate, spaced, concealed hinges of the U-shaped, gooseneck type secured to the edge of the door and which permitted the doors to swing in a horizontal arc.

V. The 1924 Oakland.

Plaintiff dispels anticipation by the defendant's 1924 Oakland car because *outside exposed hinges* were found to be necessary when using a full-sized door on a closed automobile body. Its body was built on a wooden frame and it was *straight and boxy.*

Mr. Hedeen testified it was a unitary type of hinging, gooseneck, concealed from both the inside and outside of the body, which was a tumble-out body and the hinge axis inclined outwardly and forwardly. On cross-examination, Mr. Hedeen stated the 1924 Oakland ~~doors~~ were *light* doors with three outdoor hinges all *exposed.* He also stated ~~the~~ type of hinge could not be used on modern automobiles because perfectly vertical pillars are not used.

Defendant relies on the fact the 1924-1925 Oakland hinge had "additive hinge inclinations" with the same structure, mode of operation and result as defendant's, and therefore if defendant infringes, the Oakland hinge anticipates and invalidates Howe (*Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186, 200 (1894)).

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that such exposed

VI. The Soss Patent.

The Soss patent, applied for June 17, 1920, and issued December 28, 1920, was for a "hinge." It disclosed 276 gooseneck hinges but made no reference to automobiles.

When it was applied for in 1920, closed automobiles were not in production except those which were custom made. Plaintiff points out there was no angularity in the disposition of the axis and there was no divergence between the top reach and the lower reach even if two hinges were used.

Defendant insists that its hinge is quite similar to the Soss hinge and therefore follows the prior art.

VII. The Feldwabel Publication.

The 1920 Feldwabel publication pertained to a "Door Installation on a Touring Car with Concealed Hinges." Plaintiff distinguishes this publication by pointing out that Feldwabel found it necessary to provide an *outside exposed hinge* for all car models except the light weight half-doors or gates to be used on carriages or touring cars. There was a fully exposed pintle. Plaintiff also points out that Feldwabel refers to hinging on the half-doors, expressly stating that the hinges will not be the same as on full doors. Mr. Hedeen testified that the Feldwabel door was a very light, narrow door with no glass in it. The hinge axis in Feldwabel inclined outwardly.

Defendant maintains that Feldwabel's structure is substantially the same as Howe's and the mode of operation and the result are the same. They have the same "cone effect." Feldwabel discloses two spaced, concealed, gooseneck hinges for supporting a door from a curved body pillar in an automobile body having an outwardly inclined wall;

an outwardly inclined hinge pin axis which would cause
277 the door to drop as it is opened; a rearwardly in-

clined hinge pin axis which would cause the door to rise and which therefore compensates for and subtracts from the outward inclination so that the door swings in a substantially horizontal arc. He also stated the hinge axis is inclined with respect to the adjacent edge of the door; gravity biases movement of the door toward a closed position; the hinge arms are of different lengths, the lower hinge arm being of a greater length than the upper hinge arm and each hinge arm being tapered from top to bottom. He also testified that in open position the gooseneck hinges hold the door away from the curved body, the lower or longer hinge holding the door further away from the body.

Mr. Hedeen in effect testified that Feldwabel disclosed

Howe's principle in reverse, the auto body being curved outwardly. Hedeen further testified there was no difference in technique between hinging of touring cars and open roadsters and the accused sedans. He stated that the only difference in having glass is the requirement of stronger hinges.

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VIII. 35 XP 510 Drawing.

The drawing 35 XP 510, dated September 23, 1935, which was as to an experimental structure evolved by experts at General Motors, showed the axis was inclined inwardly of the car body at the top hinge and outwardly of the car body at the lower hinge, with the top hinge *exposed inside* the body and the lower hinge *exposed outside* the body.
278 It was experimental and abandoned. It was never used and never went into production, Mr. Hedeen testified. He also testified the drawing showed a concealed hinge, which a model demonstrated to be a compensating hinge axis. The hinge was inclosed on the inside under the instrument panel, but the lower hinge was exposed. He said all of Howe's disclosures were found in the *upper* hinge of 35 XP 510.

Defendant maintains that 35 XP 510 was not purely experimental, but in fact was the forerunner of the commercial 1939 B. O. P. The September 23, 1935, date of 35 XP 510 is prior to plaintiff's earliest date of conception of June 7, 1937, and therefore supports defendant's defense of prior invention under 35 U. S. C. 102(g), and it is not necessary that the disclosure have been made public. Nor, defendant contends, did plaintiff prove a reduction to practice prior to his filing date, and a completed act of invention requires a reduction to practice by building and successfully testing the hinging after conception (*Automatic Weighing Machine Co.* v. *Pneumatic Scale Corporation*, 166 Fed. 288 (1909)).

IX. The 1939 "B. O. P." Defense.

The 1939 "B. O. P." (abbreviation for Buick, Oldsmobile and Pontiac for 1939) hinging means is claimed by defendant to anticipate or invalidate the patent in suit. These means were developed by General Motors' engineers and were manufactured early in 1938 by the Ternstedt Division and were first installed in the 1939 model in the spring of 1938 and the test bodies were shipped by Fisher Body 279 commencing in March, 1938, to Buick, Oldsmobile, Pontiac and Cadillac Divisions of General Motors for assembly into 1939 B. O. P. test cars. A test car was driven at the Milford proving grounds in July, 1938. Defendant's 1939 year model cars were first disclosed and sold to the public some time in September, 1938.

The stipulation, in addition to the above, states:

> "The '1939 BOP' models had front-door hinging means including an upper concealed hinge element and a lower hinge element which was not concealed, but extended beyond the contour of the body of such automobile models. The hinge axis on '1939 BOP' models extended between the upper concealed hinge portion and the lower unconcealed hinge portion and a portion of said hinge axis line extended outside of the body contour in such models."

As to the 1939 B. O. P. anticipation of the patent, defendant asserts the Howe patent claims are broadly worded to "a concealed hinge" and not hinge "means" and they do not require that the concealed hinge be the sole support for the door. The patent nowhere refers to a hinge means but only a "concealed hinge." Plaintiff by so construing is reading limitations into a broad claim in order to save it from anticipation, which has been condemned by the courts (*McCarty* v. *Lehigh Valley Railroad Co.*, 160 U. S. 110 (1895); *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 (1950): *Enterprise Railway Equipment Co.* v. *Pullman*

Standard Car Mfg. Co., 95 F. 2d 17 (7th Cir. 1938); *Permutit Co.* v. *Graver Corporation*, 43 F. 2d 898 (1930)).

Mr. Hedeen testified that the 1939 B. O. P. showed forward and inward inclination of hinge axis with goose-
280 neck hinges, with the upper hinge concealed and the lower hinge exposed, and with a "certain amount" of tumble-in condition.

Defendant states that the 1939 upper hinge is a "concealed hinge for supporting a door" as described in Claim 1 of Howe, even though it may not be the sole support. The 1939 upper concealed hinge is located at the same place as Howe's hinge. Further, Howe, by letter of July 10, 1942, charged infringement of his patent by that upper 1939 hinge.

Defendant points out that a patentee may not in one suit achieve a pronouncement of broad validity of his patent and in a subsequent suit seek to avoid anticipation by narrowing the scope (*Smith* v. *Hall*, 301 U. S. 216 (1937)).

The 1939 B. O. P. structure of General Motors, plaintiff claims, is simply an example of the type of outside exposed hinging which Smith described as typical and inadequate and presented the problem which patentee solved, and to which defendant turned after a year and a half of use of the 1939 B. O. P. structure.

The breadth of plaintiff's step of invention is supported, he maintains, by the fact that even the fashioning of the 1939 B. O. P. partially exposed, partially concealed, hinges took the skill of many hundreds of engineers several years to achieve, and was quickly abandoned in 1940 when Howe's invention became known.

The 1939 B. O. P. rear door hinging, plaintiff points out, was disclaimed early in this suit in the proceeding be-
281 fore Judge La Buy, as having anything to do with the Howe '490 patent. In any event, the 1939 B. O. P. rear door hinging was quite unsatisfactory, too weak, and

sagged. The upper portion of the hinge alone could not support the door. It had no double inclination, and its inclination inwardly was of but two degrees. It had no divergence between the top of the hinge and the bottom of the hinge with different reach at the top than at the bottom. No 1939 car was sold without both hinges, Judge La Buy found. The 1939 B. O. P. structure was abandoned by General Motors, and is not charged to infringe. Cessation of use of the 1939 B. O. P. hinges was due to changes in body styling, defendant points out.

The 1939 B. O. P. structures do not meet the terms of the Howe patent, plaintiff insists, because not only are they exposed hinge means, but the hinging comprises an upper gooseneck type hinge and a lower butt hinge, exposed beyond the contour of the body.

Plaintiff contends that the 1939 B. O. P. prior *knowledge* defense is inutile because, being presented under 35 U. S. C. § 102(a), plaintiff could not have had the requisite knowledge of the conception of the 1939 B. O. P. structure, it having been kept secret until its disclosure to the public on the sale of the 1939 model cars in the late fall of 1938, which was after Howe's disclosure (*Gayler* v. *Wilder*, 10 How. 477; *Rem-Cru Titanium, Inc.* v. *Watson*, 152 F. Supp. 282 (D. D. C. 1957)).

In discussing the B. O. P. defense, Judge La Buy stated, at 333-334 (167 F. Supp. 330):

282 "The hinging means of the so-called 'B. O. P. Defense' were first made available to the public by General Motors Corporation in the fall of 1938 upon the so-called 1939 automobile models. In such cars, the front doors were supported by two hinge portions, the lower one of such portions being concealed when the door was closed and the upper portion being exposed and protruding beyond the plane of the car body at that point.

"On the 1939 B. O. P. automobile bodies, both the

concealed hinge portion and the exposed hinge portion are required to support a door and no such 1939 automobiles were sold by defendant without both such hinging portions being used."

X. The Smith Patent.

The Smith Patent No. 2,050,469, plaintiff points out, discloses the *problem* solved by Howe. It states:

> "It is common practice to use hinges of the pintle type in mounting the doors on vehicle bodies, but such hinges require the pintles to be in alignment, and on the modern vehicle bodies that usually means one or more of the hinges *must extend laterally outward* beyond the surface of the body to such an extent as to afford considerable air resistance to the rapid transit of the vehicle." (Italics supplied.)

Smith, plaintiff claims, could see no way to use a pintle hinge on such structures and have fully concealed hinge means.

Smith used a *ball-and-socket* type hinge with recessed openings in the body wall exposing the hinge arms. The structure never went into commercial use and was impractical for use on production cars. Plaintiff further points out that the ball-and-socket arrangement was actuated through a slot formed in the body wall and was exposed to the elements, exterior of the body wall. Smith's door, suspended by two too slender rods, would be bound to sag.

283 In the *Howe* v. *Atwood* decision (47 F. Supp. 979 (E. D. Mich. 1942)), Judge Frank A. Picard distinguished the Smith patent from the Howe patent, noting, at 987:

> "Thus we find the Smith patent distinguishing its 'ball and socket' feature on an inclined axis as accomplishing a result not obtainable by 'pintles' and insisting that pintles could *not* be used on the new

doors without at least one or more of the hinges being *exposed* and adding that alignment was difficult. In practice, however, defendants found that their own Smith hinge was not feasible because the Smith ball and socket arrangement would not support a heavy car door and discontinued its manufacture.

"We do not question that the Smith patent was a pioneer in the inclined axis hinge type but there is more to the Howe hinge than an inclined axis. The pintles themselves are inclined. Even in the drawing accompaying the second hinge in which there are two pintles, both the top and bottom pintles are inclined in complete alignment. The claims are all specifically based on an inclined pintle built into the hinge and Claims 3 and 4 are additionally based on a gooseneck-hinge member of substantial curvature varying the extent of curvature from top to bottom to compensate for the inclination of the pintle." (Italics added.)

The court also said, at 988:

"* * * [T]his court holds that the examiner and the government intended to give plaintiff a patent covering a hinge having a gooseneck type hinge member with an inclined axis and an inclined pintle."

It further said, at 989:

"It is our holding that where there were hinges with the pintles inclined and aligned on an inclined axis fitted upon a door or in a depression of the door pillar to obtain results of the Howe patent made and sold by defendant, plaintiff may recover. This we hold whether in a duplex unitary type or in a single type hinge."

The court concluded that it was not passing upon validity of the Howe patent, but upon infringement.

284 Mr. Hedeen testified that Smith had a tumble-in type body with inward and forward inclination, and a ball-and-socket hinge inclosed in the body of the door but a portion exposed on the outer surface—a cover plate. Further, there is a compensating angle of inclination of the

hinge axis. And, Smith notes that the length of the hinge arms is different. Hedeen stated the only thing Howe adds to Smith is the gooseneck hinge.

On cross-examination, Mr. Hedeen stated the Smith vehicle never went into production and that the hinge, while workable, would not be practical for high production cars because too expensive.

Defendant argues that plaintiff cites only the insignificant features of Smith; that, in fact, Smith discloses substantially concealed hinges and a door having a tumble-in curvature more "severe" than Howe's, and Smith solved this problem by inclining the axis forwardly. Smith "anticipates Howe in all respects except as to the specific type of the hinge," and it would have been "obvious to a man skilled in the art to take the Richard gooseneck hinges or the 1917 Chevrolet gooseneck hinges or the 1924-1925 Oakland gooseneck hinges and apply the Smith teachings thereto to achieve the same result as Howe does with a gooseneck hinge."

Contentions of the Parties.

Plaintiff stresses that the '490 patent is *not* limited to a unitary hinge and is not limited to a forward inclination of the hinge means to compensate for an inward inclination of the structure; nor as claiming hinge means, portions of which are exposed. On the contrary, the claims 285 all call for a *concealed* hinge. Concealment is one of the most important objects of the invention. Therefore prior art hinges which are not fully concealed do not anticipate. Infringement arises from the installation of the hinge in an automobile because the Howe patent does not contemplate simply a hinge, but a hinge for use in an automobile. But even if the patent were limited to a unitary structure, defendant's two-part structure would

still infringe (*Sutherland Paper Co.* v. *Auburn*, 118 F. 2d 862, 864 (7th Cir. 1941)). Nor, plaintiff states, can his claims be construed to be limited to a gooseneck-type hinge —a butt-type hinge would also be within the claims. Claims 1 and 2 are not limited to gooseneck hinges whereas Claims 3 and 4 are so limited.

Plaintiff cites the phrasing of the claims and specifications indicative of complete concealment of the hinge.

It is emphasized by plaintiff that although gooseneck hinges for use on automobiles were old as shown by Richard, Feldwabel, Mouche, Soss, Carr, 1917 Chevrolet, 1924-5 Oakland, and 1939 B. O. P., *concealed* gooseneck hinges on *inclined* car door walls were not suggested in the prior art and were considered by the prior art to be unusable. Prior to 1920, the cars were roadsters or touring cars, some with no doors at all, and the doors had no hinging problems. They had no glass and were light weight.

All steel bodies came in in the early 1930's, and the "tumble-in" bodies were adopted. The doors were larger and heavier and hung at an angle, and being inclined
286 would tend to slam from the force of gravity. The growing width of the doors made the "lift" when they were inclined unsightly and undesirable, so efforts were made to cause such inclined doors to swing more horizontally and so with less effort.

Mr. Howe testified that a forward inclination causes a drop of the door on opening which in part compensates for the lift resulting from inward inclination with the result the door will swing more horizontally than otherwise. Plaintiff maintains it is immaterial at what portion of the swing the rise and drop occur so long as the final result is one of substantially horizontal movement with no excessive lift.

Plaintiff claims an invention date earlier than June 7,

1937, when he disclosed his invention to the Assistant Director of New Devices Committee of defendant, evidenced by a drawing dated April 26, 1937, and identified by two signatures dated April 29, 1937. Another drawing of Howe, which he took to have made into a model by Paul Henze of Detroit on September 1, 1937, disclosed the subject matter of the instant patent. It was returned by Henze with a note on the back dated September 2, 1937. Mr. Howe made a layout drawing in 1938 for his licensee, Metal Specialty Company, for submission to M. Hughes, Chief Body Engineer of Studebaker, writing Mr. Hughes a letter dated May 11, 1938. The drawings Howe made for the licensee are also dated earlier in 1938 than defendant's B. O. P. public announcement. So Howe insists he had disclosed his invention to the public long before the 1939 B. O. P. was shown and has proved it by satisfying evidence
287 (*Marconi Wireless Telegraph Co. of America* v. *United States,* 320 U. S. 1, 34 (1943).

As to DX 49-37 (the letter charging General Motors with infringement), plaintiff maintains defendant seeks to twist it into an assertion by plaintiff that the patent in suit covers *partially* concealed hinges. Plaintiff explains that the letter specifies "*patents*" without giving their numbers and, in fact, it concerned *two* patents of plaintiff, the other one of which covered partially concealed hinges.

Plaintiff maintains that the scope of the Howe patent is to be determined by the patent grant and its file wrapper, and not by matters appearing in the *Howe* v. *Atwood* litigation. An inventor himself, Howe points out, may not be cognizant of the breadth or principles of his own invention (*Eames* v. *Andrews,* 122 U. S. 40, 56 (1887)). An inventor cannot change the patent's scope by what he may say. He believes that his letter (DX 49-37) is being used to misinterpret the scope of his patent as to partially concealed

hinges, when in fact the letter was meant to cover his earlier patent, No. 2,163,323, as well as the patent in suit.

Also, Howe points out that "obviousness" of an invention must be tested as of the time of its conception and not from hindsight (*Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428, 435 (1911)). He argues that defendant relies on prior art for anticipation but did not itself choose to follow it until it had knowledge of plaintiff's work.

288 Plaintiff argues strenuously that the Atwood litigation does not constitute an estoppel in that General Motors was not a party to that litigation or in privity. All it did was furnish Atwood with material for defense. Further, the issue in the Atwood case was not infringement of the patent but *construction of a license agreement.*

Defendant states its interest in the Atwood litigation is *Howe's* then interpretation of his own patent—that it covered a single hinge that was concealed but was used at the top of the door in conjunction with a lower exposed conventional hinge (such as the 1939 B. O. P.). He is now saying the patent does not cover a single concealed hinge but only two concealed hinges used in concert.

Howe testified he had four pending applications, no patents, at the time of the Atwood license.

Infringement is present, plaintiff contends, because in the accused passenger car structures, the hinges are mounted as to be fully concealed within the door and the door pillar and built within the contours thereof both inside and outside of the car body. None is merely hidden from view with a shield such as the model of the 35 XP 510 drawing. In almost all of the structures the reach at the top of the hinge structure is longer than that at the lower portion thereof. The longer hinge reach at the top causes the door edge to swing further away from the door opening at that portion than at the connection with the shorter

hinge portion, and is a factor helping to compensate
289 for and solve the problem caused by inclined walls of tumble-in bodies of automobiles. All of the alleged infringing devices have their axis inclinations tilted inwardly at the top, none is either vertical nor tipped outwardly at the top. Most of them have their axis inclined forwardly as well. A couple of the devices have very slight rearward inclination. Plaintiff further insists that in all the accused structures "there was a swing 'through a substantially horizontal arc' and without excessive lift." None of the accused hinges is mounted at the rear. Not all of the accused structures are charged to infringe all the claims.

It is defendant's contention that the Howe patent is invalid because completely and directly anticipated by any one of the prior art Mouche and Carr patents, the Feldwabel publication, and the 1939 B. O. P. upper front door hinge; that what Howe did was obvious. Further, it contends that the patent claims define an aggregation of old elements all performing the same function in combination which they performed previously, with no new or surprising consequences (*Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950)).

Inasmuch as this prior art and the Richard patent and defendant's 1917-1918 Chevrolet hinges, and the 1924-1925 Oakland hinges were not cited by the Patent Office Examiner, the presumption of validity arising from the grant of the patent "is greatly weakened" (*Kennatrack Corporation* v. *Stanley Works*, 314 F. 2d 164 (7th Cir. 1963); *Milton Manufacturing Co.* v. *Potter-Weil Corporation*, 327 F. 2d 437 (7th Cir. 1964)).

290 Defendant further insists there was no "hinging problem" which had to be solved, dealing with steel bodies, full doors, and closed doors, which plaintiff discusses in his brief, but which the patent itself failed to mention. In

fact, the defendant asserts it had long used spaced pairs of concealed gooseneck hinges on inclined axes on open cars where the hinging is all below the belt line. It had, prior to Howe, used completely concealed spaced gooseneck hinges on an inwardly ~~and forwardly~~ inclined axis to support the rear door of the 1939 B. O. P. closed sedan having glass in the door and where the hinging was still all below the belt line. The ~~front~~ rear door of the 1939 B. O. P. closed sedan was thereby caused to swing in a substantially horizontal arc. If there were invention, defendant and its employees were the prior inventors as shown by 35 XP 510 and 1939 B. O. P.

Defendant states that in order to avoid the anticipating prior art—the Mouche patent, the Feldwabel publication and the 1939 B. O. P. and 35 XP 510 hinging—Howe attempts to read limitations into his broad claims by excluding from the patent open touring cars or roadsters having light weight narrow doors and including only closed sedans which have larger, heavier doors with glass. However, nowhere (except in the drawing) does Howe state therein that his patent is so limited. This reading of nonexistent limitations into the claims is in effect applying a double standard in an effort to save the patent over the prior art and at the same time to read claims on accused
291 hinges which is not allowed (*Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812 (7th Cir. 1943); *Enterprise Railway Equipment Co.* v. *Pullman Standard Car Mfg. Co.*, 95 F. 2d 17, 21 (7th Cir. 1938)). Nor is plaintiff interpreting his patent by the same standard in determining validity as for determining infringement (*White* v. *Dunbar*, 119 U. S. 47, 51-52 (1886)).

Defendant also challenges plaintiff's argument that his patent is limited to a completely concealed hinge in order to avoid anticipation by the 1939 B. O. P. defense and a limitation may not be read into a broad claim to save it

from anticipation (*McCarty* v. *Lehigh Valley Railroad Co.*, 160 U. S. 110, 116 (1895)).

Defendant insists the Howe patent nowhere claims that the variation in hinge lengths is another means for causing the door to swing in a substantially horizontal arc. Defendant maintains that it has been conclusively demonstrated that varying the length of the hinge arm has no effect on door swing and it is only the hinge axis and the angles of the hinge axis that control the swing of the door.

Defendant contends that the Howe patent is invalid for indefiniteness in many critical respects both in the specification and claims, and does not state the limits of the invention as required by 35 U. S. C. § 112. There must be guide lines so the public will be advised as to what would constitute infringement (*General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 368 (1938); *United Carbon Co.* v. *Binney Co.*, 317 U. S. 228, 236-237 (1942)). Among other deficiencies, the degree of forward inclination
292 to compensate for the inward inclination so as to cause the door to swing in a substantially horizontal arc is not given. Howe testified there might be a difference of engineering opinion as to what is excessive lift and excessive tumble-in. This itself is a basis for invalidity of claims (*A R Inc.* v. *Electro-Voice, Incorporated*, 311 F. 2d 508 (7th Cir. 1962)).

Defendant claims its 35 XP 510 in 1935 antedates plaintiff's earliest invention date, and the burden of proof in carrying back dates of invention is equally as heavy on a plaintiff patentee as it is on a defendant, and it is also required in this circuit and elsewhere that the inventor's testimony be corroborated, which Howe failed to do (*Pleatmaster, Inc.* v. *Golding Mfg. Co.*, 240 F. 2d 894, 898 (7th Cir. 1957)).

Defendant claims that not one of its doors is hinged at

the rear edge and so it cannot be deemed to infringe Claim 3, which described an axis inclined inwardly and rearwardly.

Mr. Hedeen methodically covered the accused infringing structures and found support for them in the prior art, and similarly found anticipation of the Howe patent therefrom.

Infringement where the structure is readily understandable is a question for the court to determine and expert testimony on the issue is not needed, and is in fact superfluous, defendant points out (*Singer* v. *Cramer,* 192 U. S. 265, 275 (1904); *Thabet Mfg. Co.* v. *Kool Vent Metal Awning Corp.,* 226 F. 2d 207 (6th Cir. 1955); *Kohn* v. *Eimer,* 265 Fed. 900 (1920)). Further, the mere reading by
293 Howe of his patent claims on the accused hinges does not establish infringement, because to infringe there must be real identity of means, operation and result (*Flowers* v. *Austin-Western Co.,* 149 F. 2d 955 (7th Cir. 1945); *Elgen Mfg. Corporation* v. *Ventfabrics, Inc.,* 314 F. 2d 440 (7th Cir. 1963); *North Star Ice Equipment Co.* v. *Akshun Manufacturing Co.,* 301 F. 2d 882 (7th Cir. 1962); *Weil Pump Co.* v. *Chicago Pump Co.,* 74 F. 2d 13 (7th Cir. 1934)). The claims cannot be given a broader construction than the actual teachings of the patent as shown by the drawings and the specifications (*Flowers* v. *Austin-Western Co.,* supra; *Weil Pump Co.* v. *Chicago Pump Co., supra*). And Howe's advance, if any, stated in his claims being in a crowded art, must be strictly construed (*Computing Scale Co.* v. *Automatic Scale Co.,* 204 U. S. 609 (1907); *Simmons Company* v. *Brandwein & Co.,* 250 F. 2d 440 (7th Cir. 1957); *Kennatrack Corporation* v. *Stanley Works,* 314 F. 2d 164 (7th Cir. 1963)). Defendant insists the axis of its hinges are determined by the body of the car, i.e., the styling of the car determines the inclination. It states, "after a body is styled, the hinge axis and length of hinge arms just happen."

Defendant further emphasizes that none of the accused structures is a *single* hinge as called for by the Howe claims. Also, some accused structures were inclined only inwardly and did not swing in a substantially horizontal arc causing the door rise to be excessive. In fact, a divergence in length of hinge arms does not affect door rise—only the inclination of hinge axis can do that. Since, as Judge La Buy found, all the claims call for a dual inclination
294 of the hinge axis, the accused structures which incline only inwardly cannot be deemed to infringe. Since plaintiff formulated the finding, he is bound by that interpretation of his patent. Further, those structures of defendant which have an inward and *rearward* inclination, cannot be deemed to infringe because there are additive angles which increase the door's tendency to rise on being opened, rather than making it swing in a substantially horizontal arc.

As to other of its hinges, defendant denies infringement because the inclination inwardly is so great as to make a door rise of some six and a half inches. Such a high door rise could not be said to constitute a substantially horizontal arc. Those hinges having but a very slight door rise do not infringe because the inclination was not directed to an excessive door rise but was dictated by body styling. Some of its hinges have an axis parallel with the door edge so do not constitute infringement, because the omission of a feature or structural relationship in a claim will avoid infringement (*Kennatrack Corporation* v. *Stanley Works*, 314 F. 2d 164 (7th Cir. 1963)).

Defendant says that Feldwabel found Howe's solution —but in the reverse—because the body in the Feldwabel vehicle inclined outwardly.

Defendant rejects any plausible basis of validity of Howe's patent over the prior art based on the prior art

having no glass and no frame above the belt because all the hinging in the prior art was below the belt line.

295 As to prior litigation, defendant points out the Carr patent, the Feldwabel publication and the B. O. P. defense were not before Judge La Buy in the trial before him. Defendant also challenges plaintiff's reliability citing the inconsistency of his position in the present case from that in the *Howe* v. *Atwood* matter.

Conclusion.

The determination of the issue of validity is not as clear-cut as might be desired. The court, however, concludes that in view of the state of the prior art the advance covered by the patent should have been "obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" (*Graham et al.* v. *John Deere Company of Kansas City, et al.*, Nos. 11, 37 and 43, decided February 21, 1966, United States Supreme Court). While the Supreme Court states that "the general level of innovation necessary to sustain patentability remains the same," still it is further observed, "The grant of an exclusive right to an invention . . . was not to be freely given." It said:

> "* * * Jefferson did not believe in granting patents for small details, obvious improvements, or frivolous devices. His writings evidence his insistence upon a *high level of patentability.*"
>
> * * * * *
>
> "* * * Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of

296 others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . . ."

* * * * *

"* * * [T]he inquiry which the . . . courts must make as to patentability must be beamed with greater intensity on the requirements of § 103, it bears repeating that we find no change in *the general strictness* with which the overall test is to be applied. We have been urged to find in § 103 a relaxed standard. . . . The standard has remained invariable in this Court. . . . He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office."

* * * * *

"The District Court and the Court of Appeals found that the prior art 'as a whole in one form or another contains all of the mechanical elements of the . . . Patent'." (Italics added.)

In commenting on the step taken in the matter there being considered, the court said:

"* * * Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of th shank, would immediately see that the thing to do was what Graham did, i.e., *invert* the shank and the hinge plate."

* * * * *

"* * * Furthermore, *even though the position of the shank and hinge plate appears reversed in Glencoe, the mechanical operation is identical.* The shank there pivots about the underside of the stirrup, which in Glencoe is *above* the shank. In other words, the stirrup in Glencoe serves exactly the same function as the heel of the hinge plate in '798. The mere shifting of the wear point to the heel of the '798 hinge plate from the stirrup of Glencoe . . . presents no operative mechanical distinctions, much less nonobvious differences." (Italics added.)

297 The court has considered plaintiff's argument that this invention can not be deemed obvious when defendant had hundreds of skilled men working many months with all the prior art at their disposal, and yet they did not come up with his solution of the inclination of the hinge means forwardly and inwardly, using a gooseneck hinge with the upper arm longer than the lower one to accommodate the resultant wider swing on top than on the bottom due to the inclination of the axis. As plaintiff points out, defendant used a partially, not a completely concealed hinge, and did not utilize prior art knowledge until plaintiff made his alleged disclosure to it.

It is apparent, however, under the *Graham* decision, *supra*, that a mere reversal of the inclination of the axis of the prior art on tumble-out auto bodies would be deemed an obvious change, not arising to the dignity of invention. Similarly, the utilization of the old gooseneck type hinge with a variation in arm length adapted to the change in inclination of the axis would also be a manifestation of mechanical skill.

It should have been clear to a skilled worker in the field that if the axis of a hinge on an outwardly inclined car body was outwardly inclined that when the auto body line was changed to curve inwardly, the axis of the hinge would undergo a comparable change. And it would follow that the arms of the gooseneck hinge would also have to be reversed with the longer one on top and the shorter one on the bottom. The Mouche patent and the Feldwabel article showed practically the inverse of plaintiff's conception, on a tumble-out body. Carr had a gooseneck hinge with arms of differing lengths.

298 The court concludes that the Howe '490 patent is invalid because not evidencing an advance sufficiently great over the prior art to be the basis of a valid patent. It therefore need not pass upon the issue of infringement.

Counsel for defendant is directed to prepare and submit to the court and opposing counsel, within ten days, findings of fact and conclusions of law, which shall simply state the adoption by the court of the facts disclosed in the stipulation of facts, the findings of this decision, and the conclusion of law of invalidity of the patent.

Edwin A. Robson,
Judge.

April 5, 1966.

299 UNITED STATES DISTRICT COURT.

Northern District of Illinois,

Eastern Division.

Name of Presiding Judge, Honorable Edwin A. Robson.

Cause No. 54 C 1893 Date Apr. 5, 1966

Title of Cause Earl E. Howe *vs.* General Motors Corporation.

Pursuant to Decision on the Merits filed herewith order deft. to prepare and submit to court and opposing counsel w/in 10 days, Findings of Fact, etc. as set forth in Decision. Robson, J., Apr. 6, 1966.

In the
United States Court of Appeals
For the Seventh Circuit

SEPTEMBER TERM, 1967 — JANUARY, 1968 SESSION

Nos. 15841, 15842
EARL E. HOWE,
Plaintiff-Appellant-Appellee,
v.
GENERAL MOTORS CORPORATION,
Defendant-Appellee-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

JULY 15, 1968

Before CASTLE, *Chief Judge,* KILEY and FAIRCHILD, *Circuit Judges.*

FAIRCHILD, *Circuit Judge.* Earl E. Howe brought this action in 1954 against General Motors Corporation to recover treble damages for infringement of a patent.[1] At issue are alleged infringements from 1948, six years before commencement of the action, to 1957, when the patent expired.

Defendant alleged laches and estoppel, among other defenses. Plaintiff had demanded a jury trial, and in 1958 this equitable defense was tried before Judge La Buy without a jury. Judge La Buy decided that defendant failed to prove laches or estoppel.[2] The other issues were tried in 1960, but the jury could not agree.

[1] No. 2,201,490, Inclined Hinge, issued May 21, 1940, to Earl E. Howe, application dated January 9, 1939.

[2] *Howe v. General Motors Corporation* (N.D. Ill. 1958), 167 F.Supp. 330.

The case was tried again in March and April, 1961. The jury found for defendant, but Judge Perry granted a new trial. This court denied defendant's applications for certiorari or mandamus.[3]

The demand for jury trial was withdrawn, and the case was tried before Judge Robson, without a jury. Judge Robson filed an extensive opinion[4] as well as findings of fact and conclusions of law, holding the patent invalid for obviousness under 35 U.S.C. sec. 103.

Plaintiff has appealed from the judgment accordingly entered. Defendant has appealed from the 1958 order dismissing its defense of laches and estoppel, the 1961 order granting a new trial, and the 1961 order denying its motions for a directed verdict. These latter challenges need not be considered if the judgment be affirmed on plaintiff's appeal.

—

The trial occurred before announcement of *Graham* v. *John Deere Co.*[5] and the decision was prepared shortly thereafter. As a result the analytical steps prescribed in *Graham* for resolution of the obviousness issue were not as meticulously set forth as is desirable.[6] We are satisfied, however, that the court did apply the correct tests and reached the proper result.[7]

1. *The problem addressed by plaintiff.* Plaintiff prepared his application in the latter 1930's. All-steel bodies had earlier begun to be prevalent. Designers found it desirable to shape them with curved side walls, usually inclined toward the interior as they extended upward (the so-called "tumble-in" body shape). The doors were heavy and must be hinged so as to swing free of the adjacent curved edges of the body. Sturdy hinges were necessary. It is undesirable to have a door so hinged that the force of gravity will make it difficult to open or will cause it to shut with dangerous force when open. On the

[3] *General Motors Corporation* v. *Perry* (7th Cir. 1962), 303 F.2d 544.

[4] *Howe* v. *General Motors Corporation* (N.D. Ill. 1966), 252 F.Supp. 924.

[5] (1966), 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545.

[6] See *Cloud* v. *Standard Packaging Corp.* (7th Cir. 1967), 376 F.2d 384, 391, and *Gass* v. *Montgomery Ward & Co.* (7th Cir. 1967), 387 F.2d 129, 130.

[7] Plaintiff challenges the court's use of "should have been obvious" in the reported opinion. In its findings, however, the court said "would have been obvious", as does the statute.

other hand a reasonable tendency to close, called a bias toward closing, is desirable. It is undesirable to have hinges protrude beyond the outer wall. These are some, but not all of the factors which are weighed in selecting a design.

Elements of the hinging problem are suggested in portions of Mr. Howe's application:

> "In an automobile body having upwardly converging side walls the door frame is, of course, inclined with the result that assembly of a hinge therein ordinarily disposes the hinge pin at an angle to the vertical. The angularity of the hinge pin is such that any point on the door swings through an arc which is inclined to the horizontal and inasmuch as the angle is such that gravity will cause the door to swing to its closed position, the angularity of the hinge pin is termed the tumble-in angle. The excessive tumble-in angle present in conjunction with the inclined walls of the later automobile body designs is undesirable in the respect that the door closes too rapidly and unless held may strike a person entering the automobile or who has completed his entrance except as to his foot and ankle. From the standpoint of appearance it is undesirable that the arc of swinging movement of the door should depart too great a degree from a horizontal plane. Accordingly, it is an important object of this invention to provide a concealed hinge which permits the door to swing substantially parallel to the ground, or in a substantially horizontal arc even in the presence of an extreme tumble-in angle.
>
> "Another object of the invention is to provide a concealed hinge for supporting an automobile door in such manner that gravity biases closing movement thereof. This feature is particularly desirable in conjunction with the left hand doors of an automobile in order that such doors will not remain open while the automobile is parked on a highway, as such doors in an open position constitute a hazard to traffic on the highway.
>
> "Another object is to provide a concealed hinge for supporting a curved door for swinging movement

about an axis which is disposed externally of the automobile body at both the top and the bottom of the door frame, and which passes through the body between the top and bottom of the frame. The purpose of the hinge in this respect is to avoid the necessity of comparatively long, outwardly projecting hinge elements, such as are ordinarily used in conjunction with curved doors. This is made possible by use of a single hinge, disposed within the plane of the body wall, and whose axis of pivotal movement if prolonged passes the top and bottom of the door frame externally thereof."

2. *Plaintiff's solution.* The patent contains four claims. Claim 2 reads as follows:

> "A concealed hinge for supporting a door from a door pillar in an automobile body having an inclined wall, said hinge comprising a plate member for attachment to the pillar, a pintle carried by said plate member disposed at an angle to the vertical as viewed in a transverse section through said wall, said plate member also supporting said pintle with its axis at an angle to the vertical as viewed in side elevation, an arm member connected to said pintle and adapted for attachment to a door, the axis of said pintle being inclined with respect to the adjacent edge of the door to the extent that said door swings through a substantially horizontal arc during opening and closing movements thereof, said arc departing from the horizontal only in an amount enabling gravity to bias movement of the door toward a closed position."

Claim 1 is identical to Claim 2 except that Claim 1 does not contain the last 22 words (beginning "said arc").

Claim 3 is somewhat similar in outline to Claim 2. It refers, however, to "a curved door on a curved automobile door pillar", to the hinge axis as inclining "inwardly of the automobile body and also rearwardly thereof with respect to the adjacent door edge", and to "a gooseneck hinge means of generally U shape—the U shape of said gooseneck member varying in length of its branch and in divergence from top to bottom thereof by an amount

sufficient to substantially compensate the inclination" of the axis.

Claim 4 is somewhat similar to Claim 3, but refers to the axis being "at an inclination to the vertical as required by the curvature of the automobile body. . . ."

The significant elements or devices described in one or more claims are concealment of the hinge, sloping the axis of the hinge pintle inwardly as it extends upwardly and either forwardly or rearwardly, and use of a gooseneck U shaped hinge arm so shaped as to allow for a greater distance between the axis and the point on the door to which that part or branch of the arm is connected than between the axis and the point on the door to which another part or branch of the arm is connected. Each claim specifies that the door "swings through a substantially horizontal arc."

Certain principles with respect to the inclination of the hinge axis clearly appear from the record:

If the hinge axis is vertical, a given point in the door will describe a horizontal arc when the door swings. If the hinge axis is inclined inwardly as it extends upward, but is inclined neither forwardly nor rearwardly, a given point in the door will rise as the door swings open toward 90°. If the axis is inclined inwardly and away from the door (forwardly if the door is hinged at its forward edge), a given point in the door will rise as the door swings partly open and then will fall. This is the effect described in every claim of the patent as swinging through a substantially horizontal arc. If the angle by which the axis is inclined inwardly is equal to the angle by which it is inclined away from the door, the change from rising to falling will occur when the door has swung open to 45°.

If the hinge axis is inclined inwardly and toward the door (rearwardly if the door is hinged at its forward edge), a given point in the door will rise at a faster rate as the door swings open toward 90° than if the only inclination were inwardly. This effect was referred to at trial as additive, rather than compensating.

If the hinge axis is inclined outwardly as it extends upward, but not inclined either forwardly or rearwardly,

a given point in the door will fall as the door swings open toward 90°. There will be a compensating effect if the axis is also inclined toward the door and an additive effect if away from the door.

As will be seen, concealed hinges and gooseneck hinge arms were known and used before this patent. The issue mainly debated here is whether the idea of inclining the hinge axis so as to achieve a compensating effect is old or obvious.[8]

Normally it is desirable to space the hinges relatively far apart along the axis. In the drawings included in the patent, Mr. Howe provided for a single unitary hinge, with a pintle apparently longer than the ordinary one, or with two pintles spaced slightly apart along the axis. Assuming this hinge could be made sturdy enough, the fact that it did not take up much space along the axis would work an advantage in fitting the hinging apparatus into one segment of a curved door. This idea, however, is not expressed in any claim.

3. *The prior art.* The patent contains no citations of prior art patents. Considerable proof in this area was produced on trial and is reflected in the opinion of the district court.[9]

Concealed, gooseneck, U shaped hinges were disclosed in the 1917 Chevrolet; in the Richard patent;[10] in the Feldwabel publication;[11] in the Soss patent;[12] in the Mouche patent;[13] and in the 1924 Oakland touring car.

[8] Literally, the claims apply whether the hinge axis be inclined inwardly or outwardly, although Mr. Howe stated the problem in terms of tumble-in bodies. Inclinations which produce an additive effect are outside the claims because each claim includes the element of swinging through a substantially horizontal axis.

[9] *Howe v. General Motors Corporation* (N.D. Ill. 1966), 252 F.Supp. 924, 927. We deem it unnecessary to repeat the details here.

[10] No. 1,325,109, Hinge Construction, issued December 16, 1919 to F. Richard on application filed March 10, 1917.

[11] Der Wagenbauer Lehr-und Hilfsbuch fur Wagenbau und Automobil-Karosserie, von J. Feldwabel, published in Germany and Austria in 1920. It was stipulated this was received in the United States early enough to be prior art.

[12] No. 1,363,270, Hinge, issued December 28, 1920 to C. J. Soss on application filed June 17, 1919.

[13] French patent No. 537011, Hinge retaining the vertical position during the opening of a door having a curvilinear profile vertically, issued February 23, 1922 to Elie Mouche on application filed June 4, 1921.

The Feldwabel publication and the Mouche patent also disclosed variations in the size or curvature of the goose-neck hinge member, required in order to accommodate the curved vertical profile of the door to the hinge axis.

Diagonal inclinations of the hinge axis, producing the compensating effect, was disclosed by the Feldwabel publication, the Mouche patent, and the Smith patent,[14] and was suggested as a possibility by the Carr patent.[15]

Table 25 of the Feldwabel shows an open car. The hinge axis of the door is inclined outwardly as it extends upward (a tumble-out type). The axis is also inclined rearwardly (toward the door), thus producing the compensating effect.

The Mouche patent disclosed a tumble-out body, with hinge axis inclined outwardly and rearwardly (toward the door), and producing the compensating effect.

The Carr patent depicted a door hinged at its rear edge. The hinge axis had a substantial inclination rearwardly as it extended upward. Carr preferred no lateral inclination, but indicated the axis might be inclined either inward or outward.

Carr, Feldwabel, and Mouche do not expressly describe the effect of inclination of the hinge axis upon the swing of the door, except that some language of Mouche indicates that his arrangement results in the door remaining vertical as it opens.

The Smith patent, however, though using a type of hinge different from Howe, expressly refers to the effect of diagonal inward inclination of the hinge axis. Smith says, in part:

> "By varying the relative lengths of the hinge plates and connector members, various characteristic door movements may be obtained. For instance, the plates and connector members may be so constructed and adjusted for bodies having walls and doors of any particular contour or shape that the axis about which the door hinges may be perpendicular or in-

[14] No. 2,050,409, Vehicle Door Mounting, issued August 11, 1936 to F. M. Smith on application filed September 5, 1935.

[15] No. 2,114,830, Vehicle, issued April 19, 1938, to R. L. Carr on application filed January 15, 1935.

clined forwardly, rearwardly or laterally relative thereto, whereby the door will tend to remain in any partly opened or wholly opened position or if inclined will tend to move to either opened or closed position, depending upon the direction of inclination of such axis.

"In order that the top and bottom edges of the door shall remain more nearly horizontal or parallel with the ground level when the door is opened, the hinge joint of the upper hinge is offset longitudinally of the vehicle to compensate for this inward inclination of the hinge axis. The hinge axis of the door is, therefore, diagonally inclined, that is, it is inclined both transversely and longitudinally of the vehicle. As a result of this diagonal inclination of the hinge axis, the door, when opened, will, in theory, tend to close until it is turned to the neutral position in the vertical plane of the hinge axis and beyond that it tends to swing to open position."

Smith's Claim 14 reads:

"In combination, a vehicle body ovate in cross section, a door for said body, upper and lower hinges for hingedly connecting said door to said body, the axis of the joints of said hinges extending diagonally inward whereby said door will tend to close when released at one side of the neutral position of said door, and will tend to open when at the opposite side of the neutral position."

4. *Differences between the prior art and the claims.* With respect to the type of hinge, its arrangement so as to be concealed, and its configuration so as to accommodate doors with a curved vertical profile, or otherwise having an edge not parallel to the hinge axis, the Howe patent does not differ from corresponding elements of the prior art. Howe was concerned with heavier doors, but resulting differences in size and strength of hinges would be immaterial for the present purpose. The district court found:

"The technique of hinging of doors to the bodies of touring cars, convertibles and closed cars or sedans is the same because the hinging of a car door and its hinge axis is dependent upon the contour

of the door and body surface below the belt line. The size and weight of the doors and the use of glass above the belt line do not affect the hinge axis. Howe did not urge before the Patent Office that the technique of hinging doors on closed cars was different from that of hinging doors on open touring cars which he so heavily relied upon at the trial."

With respect to the inclination of the hinge axis and its effect on the swinging of the door, some of the prior art is found in tumble-out bodies, whereas Howe was concerned with a corresponding effect in tumble-in bodies. The district court found:

"The problem of compensating for an inward inclination of the hinge axis in the transverse view in a tumble-in body to achieve a substantially horizontal door swing is the inverse of the problem of compensating for an outward inclination of the hinge axis in the transverse view in a tumble-out body and the solution of the problem is the same in each instance. Where there is an outward inclination of the hinge axis, the hinge axis is inclined rearwardly to compensate for it and achieve a substantially horizontal door swing. Where there is an inward inclination of the hinge axis, the hinge axis is then inclined forwardly to compensate for the inward inclination and this also causes the door to swing in a substantially horizontal arc."

The Smith patent disclosed a ball-in-socket hinge and not the pintle type described by Howe. The Smith hinge was not as fully concealed as Howe's. Both, however, were concerned with the tumble-in bodies prevalent in the latter 1930's. There is no material difference between their concepts of the inclination of the hinge axis and its effect on the swinging of the door.

There are combinations of concealed, gooseneck, U shaped hinges and diagonal inclination of the hinge axis, with compensating effect, in the tumble-out prior art. Defendant did not prove, as prior art, any similar combination in tumble-in bodies.[16]

[16] One possible, partial exception, not relied on, is the so-called 1939 B.O.P. hinging, which will later be referred to.

5. *The level of ordinary skill in the pertinent art.* It appears that in the late 1930's the level of ordinary skill in the field of designing automobile bodies, including hinges, was that of engineers of substantial training, and specialized skill.

6. *Obviousness.* It is perhaps possible to say that the Howe patent claims were anticipated by the tumble-out prior art. But in any event, viewing the subject matter of the patent either as an inversion of the tumble-out prior art, to adapt it to tumble-in bodies, or as a combination of the well-known type of concealed hinge with the diagonal inclination of axis disclosed by Smith, we conclude that the subject matter would have been obvious to a person having ordinary skill in the art.

Mr. Howe, of course, emphasizes the fact that no automobile manufacturer, before the time of his patent, produced a closed car with a tumble-in body, with all hinges concealed. This type of fact is referred to by the Supreme Court in *Graham* as relevant, but secondary. It would be more persuasive here if the record had satisfactorily shown that the problem, addressed by Mr. Howe, of accommodating a desirable pattern of door swing to an inclined hinge axis, was really the stumbling block for a substantial period. It is not surprising that the record fails to illuminate this point. The pertinent period was more than 25 years before the most recent trial, and, indeed, more than 15 years before Mr. Howe began the action.

We acknowledge the statutory presumption of validity of a patent.[17] It has little, if any, force as against relevant prior art not shown to have been considered by the patent office.[18] In our view the presumption has been overcome.

Other issues. We affirm the district court decision on invalidity because of obviousness. It is unnecessary to review the issues raised by defendant's appeal. It is also

[17] 35 U.S.C. sec. 282.

[18] *Skirrow* v. *Roberts Colonial House, Inc.* (7th Cir. 1956), 361 F.2d 388, 390; *Novo Industrial Corporation* v. *Standard Screw Company* (7th Cir. 1967), 374 F.2d 824, 877, *Cf. Hunt* v. *Armour & Co.* (7th Cir. 1950), 185 F.2d 722, 726; *Kennatrack Corporation* v. *Stanley Works* (7th Cir. 1963), 314 F.2d 164; *Milton Manufacturing Co.* v. *Potter-Weil Corporation* (7th Cir. 1964), 327 F.2d 437.

unnecessary to consider the hinging on defendant's 1939 Buicks, Oldsmobiles, and Pontiacs (1939 B.O.P.).

The 1939 B.O.P. upper front door hinge was concealed and the axis was inclined inwardly and forwardly (away from the door). The hinge was developed in or prior to 1938 when the 1939 models were first sold. They were sold before Howe filed his application. Plaintiff has claimed that his invention was earlier and that in developing this hinge defendant's representatives used information given them by plaintiff. Defendant has claimed that its development of this hinge began in 1935 and that if there is invention, defendant's 1939 B.O.P. hinge is invention prior to plaintiff's. The facts are in dispute and need not be resolved in view of our conclusion that the patent is invalid for obviousness.

The judgment appealed from is affirmed.

A true Copy:

Teste:

.....

Clerk of the United States Court of Appeals for the Seventh Circuit.

USCA 3696—The Scheffer Press, Inc., Chicago, Illinois—7-15-68—200

STATUTES.

UNITED STATES CODE

TITLE 5 ADMINISTRATIVE PROCEDURE ACT

Sec. 1: The provisions of this title shall apply to...the Dept. of Commerce

Sec. 597: The following named offices ..shall be under the jurisdiction and supervision of the Dept, of Commerce:...The Patent Office.

Sec.1001: Definitions. As used in this chapter (a) Agency. "Agency means each authority (whether or not within or subject to review by another agency) of the Government of the United States, other than Congress, the courts.....

Sec.1009: Judicial review of agency action. Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion— (a) Right of Review. Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof..... (e)Scope of review. So far as necessary to decision and where presented , the reviewing court shall decide all relevant questions of law,interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall ....(B) hold unlawful and set aside agency action ...found to be (1) arbitrary, capricious,an abuse of discretion ...(5) unsupported by substantial evidence in any case (on review of the record provided by 35 U.S.C. s. 141); or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court (provided by 35 U.S.C. s. 145)....

TITLE 35 PATENT ACT

Section 101: Inventions Patentable: Whoever invents or discovers any new and useful ...manufacture...or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 102:Conditions for Patentability;Novelty and loss of right. A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * * * * * * * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it.....

Section 103: Conditions for Patentability; NON-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

TITLE 35 PATENT ACT. Chapter 13 - REVIEW OF PATENT OFFICE DECISION

Sec. 141: Appeal to Court of Customs and Patent Appeals. An applicant, dissatisfied with the decision of the Board of Appeals, may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title.....

Sec. 145. Civil Action to Obtain Patent. An applicant, dissatisfied with the decision of the Board of Appeals, may, unless an appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court of the District of Columbia, ... The Court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law.....

Section 282. PRESUMPTION OF VALIDITY. A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * * * * * *

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

* * * * * * *

SUPREME COURT, U. S.

MAR 1 1969

J. F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. 1005

EARL E. HOWE,

Petitioner,

vs.

GENERAL MOTORS CORPORATION,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Rule 59(d) F.R.C.P. 4

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EARL E. HOWE,

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GENERAL MOTORS CORPORATION,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

The petition sets forth no valid reason for granting a writ of certiorari and none exists. The holding sought to be reviewed is not in conflict with the decisions of this Court nor in conflict with any decision in any other circuit. The holding does not involve any unsettled question of federal law or any issue of public importance.

This is a conventional suit for infringement of a patent which expired almost twelve years ago on May 21, 1957. There are no other suits pending on this patent and the filing of any new suit for infringement is barred by the six year statute of limitation (35 U.S.C. 286). Petitioner seeks review of the holding of the Court of Appeals primarily from the evidentiary standpoint rather than on any issue of

law. None of the provisions of Rule 19 of this Court is applicable to the present petition.

The Question Presented

Petitioner has not stated with preciseness and clarity the issue presented to this Court. The actual question involved is whether the Court of Appeals erred when it carefully followed the guidelines established by this Court in *Graham* v. *John Deere,* 383 U.S. 1 (1966), and held on the basis of the findings of fact of the trial court and upon the undisputed disclosures of the prior art patents and publications of record, that the trial court had correctly concluded that the inclined hinge of the Howe patent in suit was obvious at the time of its alleged invention (35 U.S.C. 103).

Petitioner's "threshold question" (Pet. 14-15) is frivolous. It has no legal basis whatsoever and is not before this Court. Judge Perry's comments as to validity on respondent's motion to set aside the order granting a new trial by no stretch of legal reasoning constituted a withdrawal of that issue from the jury nor was it *res judicata.* In the first place, petitioner at the second jury trial had made no earlier motion for a directed verdict or a motion for judgment N.O.V. Petitioner had only moved for a new trial after verdict and entry of judgment. Secondly, Judge Perry's remarks did not constitute a formal ruling, he gave no opinion or reasons therefor and entered no supporting findings or conclusions. Judge Perry, in fact, stated " * * * I believe another judge should take a fresh look at it." (Pet. Book* 27). Moreover, at no time thereafter, either before Judge Robson or in the Court of Appeals, did petitioner make such a contention of *res judicata.* It is raised here for the first time.

---

* Refers to booklet filed with the Petition.

Statement Of The Case

The Statement in the petition is incomplete and confusing and contains many unsupported statements, numerous errors and extraneous matters, as does the section entitled "Grounds For Granting The Writ". Accordingly, respondent makes this counter-statement only as to relevant matters and without attempting to correct all the errors in the petition.

Petitioner Howe brought this action against respondent in December 1954, more than fourteen years after he had first notified respondent of infringement and twelve years after petitioner stated he was going to resort to the courts. Petitioner demanded a jury trial.

The equitable defense of laches and estoppel was tried before Judge Walter J. La Buy and on October 17, 1958 Judge La Buy overruled this defense and entered findings of fact and conclusions of law (P.A. 51; 167 F.Supp. 330). The patent issues of validity and infringement were then tried in May, 1960 before Judge La Buy and a jury, the trial resulting in a hung jury. The denial of respondent's motion for a directed verdict by Judge La Buy was without opinion. He rendered no ruling as to patent validity.

Upon reassignment to Judge J. Samuel Perry, the case again came up for trial before a jury from March 20, 1961 to April 7, 1961. The jury brought in a general verdict of "not guilty" in favor of respondent (P.A. 96) and on May 1, 1961 judgment was entered on the verdict dismissing the Complaint and Supplemental Complaint (P.A. 96). On September 20, 1961, more than five months after trial, Judge Perry entered an order on petitioner's motion setting aside the judgment and granting a new trial (P.A. 102).

On October 23, 1961 respondent filed in the United States Court of Appeals for the Seventh Circuit a petition for a writ of mandamus directing Judge Perry to expunge his order granting the new trial and to reinstate the jury verdict. The primary ground of this petition was that Judge Perry in granting the new trial had exceeded his jurisdiction under the doctrine of *Kanatser* v. *Chrysler,* 199 F.2d 610 (C.A. 10, 1952), because the grounds upon which he relied were different from those in petitioner's motion and were initiated by Judge Perry after the expiration of the 10 days' period of Rule 59(d) F.R.C.P. The Court of Appeals denied the petition in *General Motors Corporation* v. *Perry,* 303 F.2d 544 (C.A. 7, 1962), holding that Judge Perry had not exceeded his jurisdiction, but it did not consider patent validity as petitioner here erroneously states (Pet. 15). The Court of Appeals' opinion on the mandamus issue is reproduced in the Appendix to this brief.

Following respondent's motion to dispense with a jury trial, petitioner filed an amended complaint and waived his jury demand (P.A. 17). The trial without a jury was concluded on March 9, 1965 before Judge Edwin A. Robson. After consideration of extensive briefs of the parties, Judge Robson, who was fully aware of the past history of the case and Judge Perry's remarks as to validity, filed a Decision on the Merits (P.A. 708) on April 5, 1966 holding the Howe patent invalid for obviousness under 35 U.S.C. 103. Thereafter, on May 6, 1966 Judge Robson entered findings of fact and conclusions of law supporting that holding (P.A. 739) and entered a final judgment dismissing the complaint (P.A. 742). We reproduce in the Appendix to this brief Judge Robson's findings of fact and conclusions of law which petitioner omitted from his booklet.

Neither Judge Robson nor the Court of Appeals has considered or decided the issue of infringement.

Petitioner appealed from the judgment of invalidity of the patent (P.A. 744), and respondent appealed from Judge La Buy's order dismissing the laches and estoppel defense and also from the order entered by Judge Perry on September 20, 1961 granting the new trial after the second jury trial (P.A. 745). In its opinion affirming Judge Robson's holding of invalidity because of obviousness, the Court of Appeals stated "It is unnecessary to review the issues raised by defendant's appeal" (Pet. Book 67). Hence, the infringement issue, the laches and estoppel defense and the new trial issue are still without final decision by the courts below. However, an affirmance of the trial court's holding of invalidity disposed of the entire controversy between the parties.

Any comments which Judge Picard may have made relative to any alleged inventiveness of the Howe hinge in his opinion in *Howe* v. *Atwood,* 47 F.Supp. 979 (E.D. Mich., 1942) are purely dicta as that was a suit by petitioner on a license agreement. Validity of the Howe patent was not involved. At the time of the 1942 Atwood trial the license had been cancelled. Petitioner has never licensed anyone else nor has he manufactured the hinge of his patent. Commercial success cannot be claimed for the Howe hinge. The hinges supplied by Atwood to Studebaker, Chrysler and Nash and held by Judge Picard to be covered by the Howe patent claims, were identical to respondent's 1939 B.O.P. front door hinging developed by respondent long prior to petitioner's alleged date of invention. The 1939 B.O.P. defense was not ruled upon by the trial court or the Court of Appeals as the prior art patents and publications clearly demonstrated invalidity.

ARGUMENT

Alleged Errors Of Other Courts In Other Cases Can Be No Ground For Granting A Writ In The Case At Bar

It cannot be a ground for granting a writ in the present case that some reviewing courts (not identified) in other cases deliberately have disregarded this Court's guidelines in *Graham* and *U.S.* v. *Adams,* 383 U.S. 39, and that other courts (not indentified) in other cases have also disregarded them although giving lipservice, as petitioner suggests (Pet. 11). Nor can it be a ground for granting the writ in this case that "most" of the courts "are still confused and perplexed" by the fourteen questions posed by the petitioner (Pet. 11, 12) without any showing that they are involved in the case at bar. Assuming, arguendo, that some courts have been in error in their decisions as petitioner suggests, that can be of no consequence as far as the present case is concerned. The present case must be determined on its own merits and the correctness of the Court of Appeals' decision herein must be considered on the basis of the present record and not by what other courts may or may not have done.

The Court of Appeals And The Trial Court Carefully Applied Graham v. John Deere In The Instant Case

Petitioner asserts that the trial court and the Court of Appeals misapplied this Court's decision in *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966). This assertion is disproved by the very opinions of the Court of Appeals (Pet. Book 58-68) and the trial court (Pet. Book 28-57) and by the trial court's findings of fact (Appendix to this brief).

In its opinion, the Court of Appeals expressly referred to the *Graham* v. *John Deere Co.* decision and to the analytical steps prescribed in that decision for resolution of the obviousness issue, and then proceeded to follow faithfully those analytical steps in reaching the same conclusion of obviousness as did the trial court. As indicated by the side headings in its opinion, the Court of Appeals first analyzed the alleged problems to which petitioner Howe had addressed himself in the patent and then reviewed petitioner's solution as stated in the patent claims. Then the Court of Appeals went on to inquire into and determine the scope and content of the prior art (Pet. Book 63-65), the differences between the prior art and the patent claims (Pet. Book 65-66) and the level of ordinary skill in the pertinent art (Pet. Book 67). Having followed and determined those required analytical steps, the Court of Appeals correctly concluded that "the subject matter would have been obvious to a person having ordinary skill in the art." Manifestly, the Court of Appeals adhered strictly to the dictates of *Graham* v. *John Deere Co.* and carefully applied the *Graham* guidelines to the instant case.

The trial court was also fully cognizant of this Court's ruling in *Graham* v. *John Deere.* That controlling case is expressly referred to in the trial court's Conclusion (Pet. Book 54) and the analytical steps are quoted verbatim. While, as stated by the Court of Appeals, the analytical steps may not have been "as meticulously set forth as is desirable," nevertheless the trial court's decision (Pet. Book 28-57) does cover precisely the same ground. After discussing the patent in suit, the trial court carefully analyzed the prior art and its applicability to petitioner's claimed invention (Pet. Book 33-54) and then concluded that the patented invention would have been obvious to a man skilled in the art. The Court of Appeals was fully

satisfied that the trial court had followed the *Graham* v. *John Deere* guidelines when it ruled:

> "We are satisfied, however, that the court did apply the correct tests and reached the proper result." (Pet. Book 59)

Nor is it of any consequence that the Court of Appeals and the trial court did not mention *U.S.* v. *Adams,* 383 U.S. 39, in their decisions as petitioner argues, because the same analytical steps and the same basic rule of law on obviousness were applied in *Graham* and *Adams.* In *U.S.* v. *Adams,* this Court said (p. 41):

> "While this case is controlled on the merits by No. 11, Graham, ante, * * *"

Significantly, petitioner made no reference to *U.S.* v. *Adams* in any of his briefs or petition for rehearing in the Court of Appeals.

As will become self-evident hereinafter, petitioner's further contention that the factual pattern of the case at bar "resembles very closely" the *U.S.* v. *Adams* case is entirely groundless. In *Adams,* the patented battery was held valid as nonobvious because noted experts had expressed disbelief in it, the operating characteristics and results had been shown to have been unexpected and to have far surpassed the then-existing wet batteries (p. 51-52). The factual situation in the case at bar, in view of the prior art which was carefully reviewed by the trial court and by the Court of Appeals, is a far cry from *Adams* and it is no wonder the courts below made no reference to it. *Graham* controlled.

The weakness of petitioner's case is indicated not only by complete agreement by the trial court and the Court of Appeals that the patent was invalid under 35 U.S.C. 103

and the *Graham* decision, but also by the fact that petitioner was unable to secure a favorable verdict from the jury against this respondent in both jury trials. Petitioner thus has failed on the merits in three district court trials and before the Court of Appeals.

The Howe Patent In Suit (P.A. 747)

The Howe patent discloses a single concealed gooseneck hinge for supporting a door in an automobile body with the hinge pin axis inclined to the vertical in such a manner that the door swings in a substantially horizontal arc when it is opened and closed. The patent states that where the side wall of an automobile is inclined or curved inwardly in a transverse view (Fig. 2), such body inclination causes the concealed hinge mounted therein to have its hinge pin axis also inclined inwardly. This inward inclination causes the door to rise too much as it is swung from closed to open position. Excessive door rise is said to be undesirable from the standpoint of appearance and because the door might close rapidly and injure a person's foot or ankle.

The Howe patent then states the solution of this alleged problem, at page 2, column 1, lines 41 to 50, (P.A. 749) to be as follows:

> "As may be seen in Fig. 2 the axis A of the hinge pintle is inclined to the vertical, it being disposed whereby it extends inwardly of the vehicle body as it extends upwardly. As viewed in Fig. 1, the axis A is inclined forwardly as it extends upwardly, whereas the plate portion 6, to which the door is attached is substantially vertical. *The result of this compound angularity of the axis A is that the door 2 when swung about the axis A travels in a substantially horizontal arc.*"*

---

* Emphasis added.

Thus, the basic concept of the Howe patent is the use of one angle of inclination to compensate for another angle of inclination of the axis of a concealed hinge so as to cause the door to swing substantially horizontally.

The Prior Art

The Court of Appeals correctly stated (Pet. Book 63) that, as shown by respondent's 1917 Chevrolet (P.A. 122-3) and 1924 Oakland automobiles (D.A. III 2130-38), by the Richard, Soss and Mouche patents (P.A. 803, 811, 758; P.A. 155-158, 187-8) and by the Feldwabel publication (P.A. 703; P.A. 157, 187-8), it was old to use concealed, gooseneck, U-shaped hinges in automobiles prior to Howe. It was further noted by the Court of Appeals that the Mouche patent and the Feldwabel publication further disclose tumble-out bodies of open touring cars wherein the concealed hinges are mounted on an axis which is inclined outwardly of the body and also inclined rearwardly, the rearward inclination thus compensating for the outward inclination so as to cause the door to swing in a substantially horizontal arc. Mouche and Feldwabel thus accomplished the same result sought by petitioner, namely, horizontal door swing.

Petitioner has already conceded that Mouche and Feldwabel with an outward inclination of the hinge axis had the same "problem" and the same solution as petitioner and his present arguments that there was an unsolved problem are baseless. At the second jury trial, petitioner testified (D.A. I 733):

> "Q. Now, is the problem of compensating for outward inclination any different than it is for compensating for inward inclination of the axis?
>
> A. You have got a problem the same way, two angles.

Q. It is the same problem, isn't it?

A. Yes.

Q. For solving both inward inclination and outward inclination?

A. Yes, it is.

Q. And the same solution, except in the one case you incline the axis forwardly toward the front of the car and in the other case you inclined it rearwardly toward the back of the car to compensate?

A. To compensate for it, yes."

At the later trial without a jury, the trial court was made aware of this testimony of petitioner (P.A. 358).

In a futile attempt to overcome Mouche and Feldwabel petitioner argues, in spite of his concessions at trial, that his patented invention (Pet. 4, 6, 22-3, 25-6) does not pertain to open touring cars or roadsters having light weight narrow doors (old fashioned cars) but only to closed cars having steel bodies and larger and heavier doors with glass (modern cars). While the Howe patent does show a closed car in the drawings, no point is made of that. Nowhere in the description or the file wrapper does it state that the invention is limited to closed cars or to larger, heavier doors with glass or that the invention has no application to smaller, lighter doors of open cars. Moreover, the patent claims themselves are unlimited in their terminology, each broadly calling for "a door" and "an automobile body" without regard to size, weight or type of door or body. Defendant's accused convertibles when the windows are down are, in effect, open cars.

Petitioner also argues (Pet. 25), without any basis whatsoever, that his invention is applicable only to tumble-in bodies wherein the hinge axis is inwardly inclined (modern

cars) and is not applicable to tumble-out bodies of open cars where the hinge axis is outwardly inclined (old fashioned cars). Yet, nowhere in the patent or the file wrapper does petitioner say that his invention is to be so limited. Even the claims are not limited to a tumble-in body but broadly call for "an automobile body having an inclined wall" (Claims 1 and 2), "a curved automobile door pillar" (Claim 3), or "an automobile body curved in transverse section" (Claim 4). The claims are not limited to an inward inclination of the hinge axis in a tumble-in body. Their language is so broad as to cover an outward inclination of the hinge axis in a tumble-out body and this broad language accounts for the Court of Appeals' statement:

> "It is perhaps possible to say that the Howe patent claims were anticipated* by the tumble-out prior art." (Pet. Book 67)

Petitioner's attempts to distinguish from Mouche and Feldwabel in the foregoing manner are pure afterthoughts. In *Graham* v. *John Deere,* this Court stated:

> "Graham did not urge before the Patent Office the greater 'flexing' qualities of the '798 patent arrangement which he so heavily relied on in the courts." (P. 23)
>
> • • •
>
> "Petitioners' argument basing validity on the free-flex theory raised for the first time on appeal is reminiscent of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 U.S. 545 (1938), where the Court called such an effort 'an afterthought. No such function . . . is

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* In its appeal brief, respondent by means of colored claim charts had demonstrated to the Court of Appeals precisely how the Howe claims were directly anticipated by reading as to all elements on prior art Mouche, Feldwabel, Carr and the 1939 B.O.P. hinge.

hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted.' At p. 550. No 'flexing' argument was raised in the Patent Office. Indeed, the trial judge specifically found that 'flexing is not a claim of the patent in suit . . . ' and would not permit interrogation as to flexing in the accused devices." (P. 25)

The pertinency of the Mouche and Feldwabel disclosures is fully supported by findings of fact 4 and 5 of the trial court:

"4. The technique of hinging of doors to the bodies of touring cars, convertibles and closed cars or sedans is the same because the hinging of a car door and its hinge axis is dependent upon the contour of the door and body surface below the belt line. The size and weight of the doors and the use of glass above the belt line do not affect the hinge axis. Howe did not urge before the Patent Office that the technique of hinging doors on closed cars was different from that of hinging doors on open touring cars which he so heavily relied upon at the trial. (P.A. 739)

"5. The problem of compensating for an inward inclination of the hinge axis in the transverse view in a tumble-in body to achieve a substantially horizontal door swing is the inverse of the problem of compensating for an outward inclination of the hinge axis in the transverse view in a tumble-out body and the solution of the problem is the same in each instance. Where there is an outward inclination of the hinge axis, the hinge axis is inclined rearwardly to compensate for it and achieve a substantially horizontal door swing. Where there is an inward inclination of the hinge axis, the hinge axis is then inclined forwardly to compensate for the inward inclination and this also causes the door to swing in a substantially horizontal arc." (P.A. 739-40)

In its discussion of the differences between the prior art and the claims (Pet. Book 65-66), the Court of Appeals took particular note of the above findings of the trial court. However, the Petition wholly ignores these findings of fact.

Further evidence that the trial court was influenced by and carefully followed the *Graham* decision is shown by its opinion (P.A. 736) wherein it stated:

> "It is apparent, however, under the *Graham* decision, supra, that a mere reversal of the inclination of the axis of the prior art on tumble-out auto bodies would be deemed an obvious change, not arising to the dignity of invention. Similarly, the utilization of the old goose-neck type hinge with a variation in arm length adapted to the change in inclination of the axis would also be a manifestation of mechanical skill.
>
> "It should have been clear to a skilled worker in the field that if the axis of a hinge on an outwardly inclined car body was outwardly inclined that when the auto body line was changed to curve inwardly, the axis of the hinge would undergo a comparable change. And it would follow that the arms of the gooseneck hinge would also have to be reversed with the longer one on top and the shorter one on the bottom. The Mouche patent and the Feldwabel article showed practically the inverse of plaintiff's conception, on a tumble-out body."

The trial court was quite correct in its factual comparison with *Graham* v. *John Deere,* 383 U.S. 1, 25, where the patented parts were arranged inversely from the prior art. In finding obviousness, the Supreme Court said:

> "Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of the shank, would immediately see that the thing to do was what Graham did, *i.e.,* invert the shank and the hinge plate."

The Carr patent (P.A. 769; P.A. 155, 187-8), also relied upon as prior art by the trial court and the Court of Appeals, illustrates in Figs. 1, 2, 6, 8, and 11-13 of the drawings, a closed car with a tumble-in body having a door with glass hinged at its rear edge. The hinge axis is rearwardly inclined and Carr states that the axis may also be inclined inwardly, thus calling for the very same compensating hinge angles as in the Howe patent.

The Court of Appeals further held (Pet. Book 64-66) that it would also have been obvious to a man skilled in the art to apply the inwardly and forwardly inclined hinge axis taught by the Smith patent (P.A. 751; P.A. 155, 187-8) to the already well-known concealed gooseneck hinges. Although the Smith hinge was different from Howe, nevertheless Smith clearly discloses and emphasizes a tumble-in body with the inward inclination of the hinge axis being compensated for by a forward inclination (just as in Howe) to cause the door to swing in a substantially horizontal arc. Smith expresses the theory of compensating angles and horizontal door swing for inclined hinges as follows:

> "In order that the top and bottom edges of the door shall remain more nearly horizontal or parallel with the ground level when the door is opened, the hinge joint of the upper hinge is offset longitudinally of the vehicle to compensate for this inward inclination of the hinge axis. The hinge axis of the door is, therefore, diagonally inclined, that is, it is inclined both transversely and longitudinally of the vehicle. As a result of this diagonal inclination of the hinge axis, the door, when opened, will, in theory, tend to close until it is turned to the neutral position in the vertical plane of the hinge axis and beyond that it tends to swing to open position." (P.A. 756, Col. 1, lines 36-51)

This statement of Smith is a direct parallel to that above quoted from the Howe patent. By reference to Smith's

broad Claim 14, the Court of Appeals recognized that Smith's teaching of compensating angles for inclined hinges to a man skilled in the art was not limited to any specific type of hinge but applied to all hinges, including concealed gooseneck hinges (Pet. Book 65).

Thus, both the trial court and the Court of Appeals, after reviewing the scope and content of the prior art, the differences of the prior art from the claims and the level of skill in the art, came to the same conclusion that petitioner's alleged invention was obvious.

The "very serious and vexing" hinging problems which petitioner pretends others had failed to solve until he disclosed his patented hinge (Pet. 6-8) are pure fantasy. That the record is devoid of any convincing evidence in this regard was fully recognized by the Court of Appeals when it said:

> "Mr. Howe, of course, emphasizes the fact that no automobile manufacturer, before the time of his patent, produced a closed car with a tumble-in body, with all hinges concealed. This type of fact is referred to by the Supreme Court in *Graham* as relevant, but secondary. It would be more persuasive here if the record had satisfactorily shown that the problem, addressed by Mr. Howe, of accommodating a desirable pattern of door swing to an inclined hinge axis, was really the stumbling block for a substantial period." (Pet. Book 67)

Petitioner's contrary arguments, in effect, request this Court to make an evidentiary review of the record.

In any event there was no existing hinge problem in the automobile industry as suggested by petitioner (P.A. 541-2). The Smith, Carr and Mouche patents and the Feldwabel publication had already taught the solution to

the alleged problem of substantially horizontal door swing with a concealed hinge on an inclined axis prior to Howe and that is true whether the doors were modern sedan doors or old fashioned touring car doors. (P.A. 541-2).

Nor did respondent have any unsolved hinge problems as petitioner suggests. Respondent had long used spaced pairs of concealed gooseneck hinges on inclined axes on open cars where the hinging was all below the belt line as in the Howe patent and the accused hinges. Prior to Howe, respondent had used a pair of concealed spaced gooseneck hinges on an inclined axis to support the rear door of the 1939 B.O.P. closed sedan having glass in the doors. Also prior to Howe, respondent had used a concealed gooseneck hinge on an inwardly and forwardly inclined axis (compensating angles) for supporting the front door of the 1939 B.O.P. closed sedan which was thereby caused to swing in a substantially horizontal arc. Petitioner's contention that he taught respondent how to mount concealed gooseneck hinges on an inclined axis is not supported by the record nor is his contention of confidential disclosure.

At pages 8, 24 and 29-30 of his petition, petitioner attempts to inject the issue of breach of confidential relationship for the first time into this case. Such claim for relief was never set forth in the pleadings nor tried as an issue at any of the trials nor was it raised in the Court of Appeals. It cannot be before this Court.

CONCLUSION

The affirmance by the Seventh Circuit Court of Appeals of the trial court's holding of invalidity of the Howe patent in suit for obviousness under 35 U.S.C. 103 is based upon a well-reasoned and fully supported decision. The Court of Appeals' opinion indicates a thorough knowledge of the record and a careful application of the tests promulgated by this Court in *Graham* v. *John Deere*. No ground exists for granting the petition.

The petition is without merit and must be denied.

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APPENDIX

ENTERED BY JUDGE EDWIN A. ROBSON

304 IN THE UNITED STATES DISTRICT COURT.
* * (Caption—54-C-1893) * *

FINDINGS OF FACT.

1. The stipulations of fact made by the parties are adopted by the Court as a part of its findings of fact.

2. The facts stated in the Decision on the Merits announced by this Court on April 5, 1966, are also adopted as a part of this Court's findings of fact.

3. Applying the test of clarity of disclosure required of a foreign patent and publication (Borg-Warner *vs.* Mall, 220 F. 2d 803, 805 (C. A. 7)), the disclosures of the Mouche patent and the Feldwabel publication are in sufficiently clear and definite terms that a person having the ordinary skill in the art of automobile door hinging could correctly understand and reproduce and use the hinging constructions shown and described therein.

305 4. The technique of hinging of doors to the bodies of touring cars, convertibles and closed cars or sedans is the same because the hinging of a car door and its hinge axis is dependent upon the contour of the door and body surface below the belt line. The size and weight of the doors and the use of glass above the belt line do not affect the hinge axis. Howe did not urge before the Patent Office that the technique of hinging doors on closed cars was different from that of hinging doors on open touring cars which he so heavily relied upon at the trial.

5. The problem of compensating for an inward inclination of the hinge axis in the transverse view in a tumble-in body to achieve a substantially horizontal door swing is the inverse of the problem of compensating for an outward inclination of the hinge axis in the transverse view in a tumble-out body and the solution of the problem is the same in each instance. Where there is an outward inclina-

tion of the hinge axis, the hinge axis is inclined rearwardly to compensate for it and achieve a substantially horizontal door swing. Where there is an inward inclination of the hinge axis, the hinge axis is then inclined forwardly to compensate for the inward inclination and this also causes the door to swing in a substantially horizontal arc.

306 6. At the time Howe made his alleged invention of the patent in suit the differences between the subject matter sought to be patented and the prior art were such that it would have been obvious to a man having ordinary skill in the art of automobile door hinging;

That if an outwardly inclined or tumble-out automobile body having concealed gooseneck hinges mounted on an outwardly inclined hinge axis with a longer arm at the bottom was changed to an inwardly inclined or tumble-in body, the axis of the hinges would undergo a comparable change or reversal to be inwardly inclined; and it would inevitably follow that the rearward inclination of the hinge axis that compensated for outward inclination to cause a substantially horizontal door swing would also be reversed to a forward inclination in order to compensate for the inward inclination and achieve the same compensating effect, and the differences in length of the hinge arms would also be reversed so that the longer arm would then be at the top instead of at the bottom.

307 Conclusions of Law.

1. Defendant has maintained its burden of proof in establishing the invalidity of the Howe patent No. 2,201,490.

2. Under 35 U. S. C. Section 103, the Court concludes, as a matter of law, that the differences between the subject matter sought to be patented by Howe in patent No. 2,201,490 and the prior art are such that the subject matter as a whole would have been obvious at the time the alleged invention was made to a person having ordinary

skill in the art of automobile door hinging and, therefore, the claims, 1, 2, 3 and 4, of the Howe Patent No. 2,201,490, are invalid.

3. Defendant is entitled to a final judgment dismissing with prejudice the Complaint and Supplemental Complaint, as amended, and awarding costs to defendant, except with respect to the issue of laches and estoppel, previously awarded plaintiff in the order of October 22, 1958.

Edwin A. Robson,
United States District Judge.

May 6, 1966.

der advisement during the course of the trial, for a directed verdict.

Petition denied.

1. Patents ⇐315

Grounds for grant of new trial in patent infringement action, including undue influence on jury because of defendant's presentation of excessive evidence, were included among the grounds asserted in plaintiff's motion for new trial, including confusion of issues by "gross duplication" of pertinent evidence, and were not initiated by judge, so that new trial was properly granted more than ten days after judgment for defendant. Fed.Rules Civ.Proc. rule 59 (d), 28 U.S.C.A.; 28 U.S.C.A. § 1651; U.S.Ct.App. 7th Cir. Rule 19, 28 U.S.C.A.

2. Federal Civil Procedure ⇐2121

Where defendant in patent infringement action had made motion in writing in form of a brief for directed verdict at close of evidence, but where motion had been taken under advisement, and where, subsequent to verdict and judgment for defendant, a new trial had been granted, judge did not abuse his discretion by refusing to grant leave to defendant to file memorandum in support of the motion for directed verdict and by denying the motion.

GENERAL MOTORS CORPORATION, Petitioner,

v.

Honorable Joseph Samuel PERRY, United States District Judge, Respondent.

No. 13540.

United States Court of Appeals Seventh Circuit.

April 23, 1962.

Rehearing Denied June 21, 1962.

Proceeding on petition by defendant having judgment in patent infringement action, for writ of mandamus or writ of certiorari or both following grant of new trial. The Court of Appeals, Kiley, Circuit Judge, held that new trial had properly been granted more than ten days after judgment and that trial judge had not abused his discretion by denying defendant's motion, originally taken un-

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Warren C. Horton, Chicago, Ill., for respondent.

Before DUFFY, KNOCH and KILEY, Circuit Judges.

KILEY, Circuit Judge.

This is a petition by General Motors Corporation for a Writ of Mandamus, or for Writ of Certiorari, or Both,[1] arising from Howe v. General Motors Corporation, No. 54C1893, pending in the District Court. A rule to show cause issued from this court[2] and respondent

1. 28 U.S.C. § 1651; 7 Cir.R. 19, 28 U.S.C.

2. 7 Cir.R. 19.

answered, presenting the issues before us.

The Howe suit was filed in December 1954, charging patent infringement.[3] The first trial of eleven days resulted in a jury disagreement in May 1960. In September 1960 General Motors' motion for directed verdict in that trial was denied. The case was reassigned to respondent and the second trial, pertinent here, began in March 1961 and lasted three weeks. At the close of the evidence, General Motors' motion for directed verdict was taken under advisement. The jury's sealed verdict of April 10 found General Motors not guilty, and judgment was entered on the verdict May 1, 1961. Respondent granted plaintiff a new trial September 20, 1961. October 3, he denied General Motors leave to file a memorandum in support of its motion for directed verdict, and denied its motion for judgment in accordance with its motion for directed verdict.

[1] The first question is whether the Certiorari should be granted on the ground that respondent exceeded his jurisdiction by granting a new trial September 20, 1961, more than ten days following judgment, in violation of Fed. R.Civ.P. rule 59(d), 28 U.S.C.A.

General Motors contends that the ground of granting the new trial was initiated by the judge and not asserted in the motion. If this is so, Fed.R.Civ. P. rule 59(d) requires the ruling within ten days of the judgment. Kanatser v. Chrysler Corp., 10 Cir., 199 F.2d 610, 615 (1952) cert. denied, 344 U.S. 921, 73 S.Ct. 388, 97 L.Ed. 710 (1953). Respondent's answer to the rule to show cause is that the new trial was granted on a ground in the motion for new trial. Unless the ground can fairly be said to be in the motion for new trial, the rule in the Kanatser case supports General Motors' contention.[4]

We agree with respondent. In the motion, Ground "2" was directed at the "confusion" of "issues" by presentation of irrelevant evidence, and "gross duplication" of pertinent evidence; Ground "4" asserts that presentation of evidence misled the jury as to the meaning of the patent in suit; Grounds "15" and "16", respectively, claimed error in the admission of evidence of a 1925 Oakland automobile and a 1918 Chevrolet with no notice of defenses concerning the exhibits; and Ground "17" assigned error in admission of "full size door models" made for purposes of the suit.

The pertinent part of the order granting the new trial is, "After a careful review of the record and of the proceedings had at the jury trial of this cause, and having given due consideration also to the complicated nature of the issues and evidentiary material presented to the jury, this court feels constrained to grant plaintiff's motion."

One of the reasons stated by respondent at the trial for his ruling was "* * * I * * * thought that the tremendous amount, tremendous amount, of demonstrative evidence that was presented by the defendant, the innumerable doors that were brought in, the excessive amount of evidence, did unduly influence the jury * * *." We think this reason was not initiated by respondent in violation of Fed.R.Civ.P. rule 59(d), but was presented in the motion for new trial. That is sufficient for our conclusion that respondent did not exceed his jurisdiction by ruling on the motion more than ten days after judgment. Cooper v. Midwest Feed Products Co., 8 Cir., 271 F.2d 177, 179 (1959). The petition for Writ of Certiorari seeking to expunge the new trial ordered and to reinstate the judgment must be denied.

3. General Motors asserted, among other defenses, laches and estoppel. These two equitable defenses were tried separately and were determined in October 1958 against General Motors. 167 F.Supp. 330.

4. It is only where the court on its own initiative grants a new trial under Fed. R.Civ.P. rule 59(d) that the order "shall" specify the grounds for the ruling.

[2] The next question is whether a Writ of Mandamus should issue on the claim that respondent abused his discretion in concluding that General Motors' motion for directed verdict of April 1961 was moot, and in denying General Motors leave to file a memorandum in support of its September 29, 1961 motion or to grant it a hearing.

General Motors cites Montgomery Ward & Co. v. Duncan, 311 U.S. 243, 61 S.Ct. 189, 85 L.Ed. 147 (1940); Tribble v. Bruin, 4 Cir., 279 F.2d 424 (1960); and Thurber Corp. v. Fairchild Motor Corp., 5 Cir., 269 F.2d 841 (1959) in support of its contention that respondent erred in concluding that the motion for directed verdict was moot because of the verdict in General Motors' favor and the granting of the new trial. We need not consider this contention because although respondent made a statement to that effect September 29, he ruled on the motion October 3, presumably changing his mind as to the mootness.

General Motors' motion for directed verdict, filed originally in April 1961, was in writing, "in form of a brief," twelve pages long, presenting facts, arguments and authorities. The new trial was granted September 20, 1961, after full argument July 29 by both sides on Howe's motion. September 29 General Motors made its motion for judgment in accordance with its motion for directed verdict. October 3, 1961, respondent entered the order denying General Motors leave to file a memorandum in support of its motion and denying the motion.

We see no abuse of discretion in the order of October 3, 1961. There was pending the memorandum filed in April in support of the motion upon which General Motors' motion of September 29 was based. In the absence of a clear showing to the contrary, we presume that respondent considered the original motion and supporting memorandum with its facts, arguments and authorities. He stated that he spent "hours and hours" on the briefs in the case. Fed.R.Civ.P. rule 59(d) did not require that respondent permit the filing of a written memorandum and his decision was within his discretion. And the rule did not require that respondent grant a hearing in the form of oral argument. This request was also addressed to the sound discretion of respondent.

General Motors had the burden of showing in this court a clear right to the Writ, and if respondent exercised judgment on reasons based on what was properly before him, we are not to say that he abused his discretion. Bankers Life & Cas. Co. v. Holland, 346 U.S. 379, 382, 383, 74 S.Ct. 145, 98 L.Ed. 106 (1953); Chemetron Corp. v. Perry, 7 Cir., 295 F.2d 703 (1961). We conclude that respondent made his ruling on grounds in the motion for new trial, that General Motors has not shown a clear right to the Writ of Mandamus prayed, and that the Writ must be denied.

For the reasons given, the petition for Writ of Mandamus or, in the alternative, for Writ of Certiorari, or Both, is denied.

§ 286. Time limitation on damages

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

* * * *

SUPREME COURT, U. S.

FILED
MAR 20 1969
JOHN F. DAVIS, CLERK

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1968

No. 1005

EARL E. HOWE,
Petitioner

vs.

GENERAL MOTORS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

REPLY TO RESPONDENT'S BRIEF IN OPPOSITION

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In The

SUPREME COURT OF THE UNITED STATES

October Term, 1968

No. 1005

EARL E. HOWE,

Petitioner,

vs.

GENERAL MOTORS CORPORATION,

Respondent.

REPLY TO RESPONDENT'S BRIEF

This Reply will take up Respondent's Brief in Opposition page by page, successively, as much as possible, with cross-references to the same subject matter where duplication can be avoided, or the reply made clearer.

POINT I. Page 1,2d par.,2d sent., and p. 3, 2d par. It is sought to prejudice this Court against Howe at the outset, by making

it appear he has been guilty of laches and unclean hands to GM's great damage, and that his claim is stale, '490 having expired in 1957. If ultimately successful, he would be entitled to recover for patent infringement from 1948, his suit having been filed in 1954 (La Buy, J. finding No. 27, Pet.Bk. 18). It is undisputed that Howe notified it, on June 21, 1940, soon after '490 issued (Pet. 9) and kept notifying it periodically in 1941 and 1942 (La Buy, J. finding No. 21, Pet. Bk. 16) that it was infringing '490, and he threatened suit (Pet. 20, par. 2). Intercompany correspondence indicates GM expected, at this time and for some time thereafter, a suit for infringement and misappropriation of confidential information (DA III 1964,1994, La Buy, J. finding No. 33, Pet. Bk. 20). Why did not GM file a declaratory suit? Trial of the laches issue went against it (Brief 3; Pet. 2). This was not the only suit deferred till after War II and the Korean War. Howe's

suit against Atwood, begun March 5, 1941, occupied him fully (See pp. 13-18, 19-21 infra for the strong tie-in with the case at bar). War II, following immediately after, suspended civilian auto production. It was the patriotic duty of all to go all-out in the war effort, as did Howe for the duration. A similar situation arose before Judge Robson in Armstrong v. Motorola, 374 2d 764 (C.A. 7, 1967). Similar situations were cited therein in the 2d, 6th and 8th Circuits.

POINT II. Pages 1, 2, 6, top par., gloss over the twilight areas referred to in Pet. 11-12. They exist in the Seventh, as well as in other Circuits, and in the case at bar. Rule 19(b) relates to important questions in federal law, such as have arisen under the 1952 Patent Act in the case at bar; to a disregard of this Court's decisions, as was true in Disney, 369 F. 2d 230 (C.A. 7, Nov. 9, 1966) (Pet. 11, fn 28;) and in the case at bar; to departures "from the accepted and

usual course of judicial proceedings" when the Circuit Court spelled out in the case at bar some of the first step and all of the third step required under Graham, in determining the issue of unobviousness under Sec. 103, instead of remanding for further investigation and trial, if need be; to a reviewing court's sanctioning "such a departure by a lower court, as to call for an exercise of this court's power of supervision" when, on appeal to it from Judge Robson's judgment, it did not hold the second jury was without jurisdiction ab initio to render a verdict of "Not Guilty", and that Judge Perry's ruling in setting that verdict aside on the ground that it was his legal conclusion the patent was valid and infringed (Pet. 9-10) really constituted a final judgment until reversed (Pet. 14-15).

Appendix C is provided herein should this Court wish to pursue the Rule 19(b) compliance issue. The Petition (11-12) lists ten twilight areas of confusion and contradictions

indicated in the case at bar, in other cases in the Seventh Circuit, and in other Circuits. The case at bar affords opportunities for their much needed resolution. Brief summaries of sample cases only can be made, lest the Memo become a Minibrief. If required, upon grant of certiorari, the full-dress brief can consider the issue more fully. As if to reinforce its point, Respondent states (Brief 2, 1st par.) that the Petition did not state the "Question Presented" with preciseness and clarity. The phrasing of that question is verbatim from the United States' Petition in U.S. v. Adams. Rule 19(b)'s last clause was added to cover the threshhold question, etc. This Court apparently thought that Petition's statement of the question presented, and all questions subsumed under it, adequately precise and clear. The statement (Brief, p. 2, 1st par. line 7) that disclosures in GM's cited prior patents and publications are undisputed is highly presumptuous (Pet. 14,

16, 17, 19, 22, 24, 25-28 disputes this).

POINT III. Page 2, 2d par., is, in some respects, a quibble on form rather than on substance. However proceedings in trial courts may be viewed, such as instructions to the jury, motion for directed verdict, or withdrawal from the jury of a question of law beyond its province, Respondent, throughout the proceedings before Judges La Buy and Perry, recognized that obviousness was a legal conclusion for the trial judge, wherefore motions were made by it repeatedly to withdraw the issue from the jury. When trial of patent infringement suits before a jury was more common, its province was restricted to answering interrogatories in a Special verdict (this Court may wish this opportunity to lay down such guidelines or the kind of questions the jury should answer, to make clear the division of judge and jury functions), the trial judge reserving the determination of invention by either directing the jury to

find it present or absent, or granting a motion N.O.V., or setting aside the jury's verdict. Judge Perry did the latter, and stated as his reasons that (1) the jury was confused (as must have been the predecessor hung jury) by the Respondent's barrage of matter that was either immaterial, such as depositions, or that had been stipulated, for which reason the Court of Appeals modified its decree to cut the cost award in half, and that (2), out of his long experience of having tried over 40 patent infringement suits (Pet. 9, bottom), he had not the slightest doubt '490 was valid and infringed. That his cogent and full opinion, referring to his previously stated findings of evidence and conclusions of law, was given orally does not make it the less formal or less entitled to the weight of judicial pronouncement. Petitioner is at a loss to know why Judge Perry's ruling (Pet. Bk. 22-27) did not constitute an opinion or reasons. That he made

the closing consoling remark to Respondent to let it down easy, does not detract from the force of his statement, repeated in part several times for re-emphasis, as an opinion, without again repeating to counsel the facts and the law, as he had stated he had done. If the second jury usurped jurisdiction in reaching a legal conclusion on obviousness by its verdict of "Not Guilty", why cannot lack of jurisdiction over the subject matter be availed of at any time, even in this Court? POINT IV. Page 3, 1st par., Respondent has failed, at its peril, to object to matters it considered so haughtily as beneath its attention. It dodges reply to a very basic question as to the presumption of '490's validity. On the question of burden of proof on the issue of obviousness, where confidential disclosure had been made to GM (Pet. 8-9, 18-19), the matter is dismissed by denials that the issue of confidential disclosure was ever raised in the pleadings, or was testified to

and contested at the trials, or raised in the Court of Appeals. Judge La Buy's Finding No. 32 (Pet. Bk. 20) indicates GM claimed its 1939 B.O.P. carrying a concealed hinge was the same as Howe's claimed invention, making its employee prior inventor under 102(g). Judge Robson's Decision on the Merits (Pet. Bk. 31, next to last par.) stated that Respondent's Answer "asserted invalidity of the patent on the ground that . . . the alleged invention had been known and reduced to practice by General Motors". (See also La Buy, J. finding 16, Pet. Bk. 15; see also Pet. 24-25) This defense under 102(g) (La Buy, J. finding 16, Pet. Bk. 15; Findings 19-20, Pet. Bk. 16) was hotly contested, General Motors in rebuttal seeking to show that Howe was a mere peddler of an allegedly new product its employee had invented (DA III, 1958, 1964). Yet GM's interdepartmental communication revealed a disposition, after a war of attrition on Howe, to buy him off by compensation which it regarded as

a nuisance fee for the cost of the drawings, models, etc. (DA III 1840-1842; 1854-5; 1966; 1968; 1973)

The Petition for Rehearing to the Court of Appeals (p. 23), requesting it to permit plaintiff to apply to the trial court to amend paragraph 7 of his Complaint (P.A. 29), explained:

> "Since there was no finding as to appellant's common law rights to his secrets disclosed confidentially to the defendant, no issue could be included among the Contested Issues in his appeal to this Court."

Regardless of the above, attention of this Court was drawn to a fact pattern that comes up often enough and in many Circuits, especially the 7th, 2d, 6th and 9th (Pet. Appendix B), as it has in the case at bar, as to which it may use this case to provide guidelines for the Bar and the Courts in the future, on proof am't.

POINT V. Page 3, 3d par., Judge La Buy's denial of Respondent's motion for a directed verdict, at the conclusion of all the evidence,

certainly indicated he did not agree GM's evidence of prior art proved obviousness. A hung jury is ground for no inference it found '490 invalid (GM Brief 9, top), much less the non-sequitur that petitioner failed on the "merits" in both jury trials, since the 12 confused members of those juries may have been of the belief '490 was valid but not infringed. Though Judge La Buy did not rule formally, as by entry of judgment holding '490 valid and infringed, his accord with Judge Picard, as later Judge Perry was in accord with both, is unmistakable in noting that the industry's problem with the tumble in body was more than mere alignment, but that the other problem, or other half of the same problem, was to so align the door that no hinge, or any part of it, would be seen from either outside or from the inside of the car (La Buy, J. findings 18, 19, 20, Pet. Bk. 16).

POINT VI. Page 4, 1st par., Respondent seeks to cast doubt on the soundness of the reviewing

court's denial of its petition for mandamus. That court's opinion (Brief, Appendix) compared the motion for new trial with his opinion to show the proper grant of that motion. Petitioner's errata sheet added a clause on page 15 of the Petition that, in effect, the reviewing court indirectly held with Judge Perry's legal conclusion that '490 was valid and infringed.

POINT VII. Page 4, last line. Rule 23 nowhere requires a petition for certiorari to include a trial court's findings and conclusions of law. Moreover, finality does not attach to them under F.R.C.P. 52(a) where the conclusions of law are based on errors, such as a failure to define accurately the claimed invention in suit, or to follow strictly the Graham procedure under Sec. 103, in the precise order of steps thereunder, or to determine accurately the prior art without which it cannot describe the hypothetically ordinary skilled mechanic in the art, or because they

are conclusory, or because, in weighing the pros and cons, no decision was made on each issue as to which side had the weight of the evidence. All these defects appear in the case at bar.

POINT VIII. Page 5, 2d par. While giving lip service to a licensee's estoppel to deny the validity (Pet. Bk. 8, col. 1, last par. under "Fourth Question"), Judge Picard followed decisional law which has been codified in Sec. 103 and, upon reviewing Howe's invention in'323, he noted no inventive distinguishable feature from the prior art and so held '323 was invalid for non-invention (Pet. Bk. 5, col. 1, last par. under "Third Question"). He followed the same procedure in a consideration of '490 involved in the case at bar (Pet. Bk. 5, col. 1 to p. 8, col.1). Judge Picard defined '490's problems and solutions and the most pertinent prior art so clearly, and then showed the material structural differences between that art and the claimed invention,

producing such different and unexpected results from the prior art, that it is highly persuasive, if not completely dispositive, of the issue of obviousness involved in the case at bar. He concluded (Pet. Bk. 8, col. 1, next to last par. under "Fourth Question"):

> "It is our holding that, where there were hinges with the pintles inclined and aligned on an inclined axis fitted upon a door, or in the depression of the door pillar, to obtain results of the Howe patent made and sold by the defendant, plaintiff may recover."

The industry was plagued with two problems in making the post-De Soto closed, steel car: First, to eliminate "persuasion" to have the door swing substantially horizontal to the ground to enable the door to fit into the opening on the body securely; second, to do so without the use of outside hinge or hinges as support for a concealed hinge.

Judge Picard construed Howe's claims in the light of his drawings. Accordingly, Smith 2,050,469 relied on as the closest to '490, as it was in the case at bar (Note from Pet. Appen-

dix A that Smith recognized the problems in the all steel tumble in auto body and the long-felt needs that still remained unsolved, and had some of the features of '490) because his door could swing substantially horizontal to the ground, was, nevertheless, materially different structurally from '490 and could not solve the problem of doing without exposed support butt hinges in addition to his ball and socket hinge to effect the door's horizontal swing for proper alignment. He claimed that his ball and socket hinge was structurally different from the pintle hinge which he insisted could not be used on the tumble-in body for proper alignment without the use of at least one outside butt hinge for support (Pet. 22; Pet. Book 6).

Atwood, owner of the Smith patent, relied on it as having pioneered the dual inclination axis but Judge Picard explained that '490 was further materially structurally different in that the pintles in '490 were themselves inclined (Pet. Bk. 6, col. 2, last par.):

> "Even in the drawing accompanying the ('490) hinge in which there are two pintles, both the top and bottom pintles are inclined in complete alignment. The claims are all specifically based on an inclined pintle built into the hinge and Claims 3 and 4 are additionally based on a gooseneck hinge member of substantial curvature varying the extent of curvature from top to bottom to compensate for the inclination of the pintle."

Additionally, the hinge members were disposed within the plane of the body wall and door pillar (Pet. 27, top).

Judge Picard's legal conclusion of '490's non-obviousness over the prior art, and especially Smith, was direct and not dictum. He demonstrated there was no identity of structure, mode of operation or results.

POINT IX, page 5, last par., is intended to show non-acceptance of '490 by the industry proved non-invention, and that Judge Robson was, therefore, justified in not considering the secondary indicia of invention, such as the post-De Soto problems, attempts at solution

and their failure by Smith, GM, and others, the replacement by the '490 hinge of the exposed butt hinges, unexpected result, etc., in resolving his doubt on the issue of obviousness. Contrariwise, it was sought to show that it was the GM hinge construction, claimed to have been invented by its employee, which Atwood's auto manufacturer customers were using.

In the period immediately following De Soto, in 1930, standard exposed butt hinges were used to support the heavy doors. Upon its acquisition of Smith, Atwood then made a ball and socket concealed gooseneck construction which embodied Smith's dual inclination axis (this Reply 15). He sold it to Chrysler, which used an exposed butt supporting hinge in addition. It proved unsatisfactory, and was discarded (Pet. Bk. 6, 3d par., last sent.). Upon learning Howe could align the heavy door without "persuasion" and without a hinge that was exposed in any degree, it acquired a

sublicense from Howe's exclusive licensee, Metal Specialty, under a three-party agreement of April 19, 1969. Thereupon, it switched to making Howe's gooseneck pintle type, totally concealed hinge, on which it was obligated to pay royalties. It was sold to Chrysler, De Soto, Dodge and others. They used it on the front door, upper area, of their 1941 model cars, but they had to have an exposed butt hinge, in addition, to support the heavy door. In late 1939-40, GM had the same arrangement on all its models, including the 1939 B.O.P. model, a concealed plus an exposed supporting hinge. This is what is meant in Brief 5, last par., lines 10-14. In 1940, Studebaker used the same arrangement on the Commander, President and Champion models; and so did Nash. In 1939, GM first used the Howe concealed hinge on both the front and rear doors of its Torpedo model. In late 1941, it used the Howe concealed hinge entirely on all models; they had

no exposed hinges.

GM could not thus befuddle Judge La Buy (Findings 18, 19, 20, Pet. Bk. 16), nor Judge Perry before whom testified Beatty (DA 881-82); Hedeen (DA 1519), both GM employees, and Patent Attorney Lutz (DA 1599-1600), that GM's concealed hinge on the 1939 B.O.P. model could not alone support a heavy door and that an exposed hinge was also required.

As indicated in Pet. 2, Atwood repudiated under strange circumstances at the behest of GM, in the light of strong circumstantial evidence. As sublicensee, it assisted in getting the strongest claims possible in the Howe applications (Pet. Bk. 2, 1st par.). Howe had disclosed to GM the contents of his application (which ripened into '490) soon after it was filed on January 9, 1939 (Pet. 8). Atwood began to chisel, refusing to pay royalties on the ground of non-infringement. Dunned constantly, it warned that big automobile companies might challenge Howe's patents (Pet.

Bk. 2, col. 1, last par.). Metal Specialty was obliged, finally, on May 24, 1940 (3 days after '490 issued) to cancel Atwood's sub-license. Atwood had Metal Specialty reconsider, but still refused to pay royalties. Metal Specialty's survival depended on GM which it supplied with sundry metal stampings, such as cowl and ventilator screens. GM threatened, in its usual verbal and subtle manner, to deny it orders unless it ceased its connection with Howe who it had, in the meantime, gulled until he first charged GM with infringement, on June 21, 1940. On September 24, 1940, due to GM pressure, Metal Specialty cancelled its March 16, 1938 agreement and exclusive license with Howe and, on October 1, 1940, so notified GM (DA III 1966) and Atwood whom it also then advised it had assigned to Howe the three-party agreement of April 19, 1939, to which Atwood was a party. On October 3, 1940, Atwood wrote Metal Specialty it would thenceforth deal with Howe. It

refused to pay Howe any royalties. On March 5, 1941, Howe sued Atwood. After being served, on March 21, 1941, Atwood wrote Howe that it no longer recognized the license (Pet. Bk. 2, col. 2, 5th par.).

GM has employed the same oppressive methods by threatening several other of its suppliers, licensees under other Howe patents to Howe's great damage. If the situation were not so pitifully tragic, the statement that he never licensed or himself made the hinge under '490 would be laughable. A comparatively poor man, who could not even afford to pay counsel in the Atwood suit, except on a contingent fee basis, Howe had to settle the judgment in his favor for a pittance because he could not afford the cost of an appeal. Whether he or any other licensee sought to make the hinge and could raise the considerable capital needed, who would buy it? Atwood has been and is still supplying Howe's hinge to the few auto manufacturers. An

oligopoly exists in the auto industry. Since GM's sales account for more than half the cars sold, it belongs and is well nigh a monopsy, the biggest single buyer, to whom thousands of businesses are tributary satellites. Howe had the courage, in due course, with his own meagre funds and borrowed capital, to wage an uneven, gruelling and extremely costly battle against the largest corporation in the United States. At the Atwood trial, its counsel was present throughout and its engineers testified; it did all it could with data, records, prior art, to break '490, short of creating an estoppel. As was said by the 7th Circuit in Devex Corp. v. GM, 321 F.2d 234, 237, col. 2, this interest does indicate '490 had special value and was of great importance in hinging heavy doors on "tumble-in" bodies.

POINT X, ARGUMENT

A. Pages 1, last line, and 16, next to last par., state this Court is requested to make

an evidentiary review of the record. Page 12 of this Reply has indicated already that F.R.C.P. 52(a) has no finality where the evidence in the record does not support the legal conclusion of obviousness. A legal conclusion drawn from facts interpreted wrongly or overlooked must be, itself, wrong. Much of the preceding Reply applies to this argument, and will not be repeated at great length.

B. The confusion in this case is due, first, to the defendant's contention that the Howe invention is overclaimed to cover any hinge, and hence the '490 claims read on the pre-De Soto butt hinges, and even on those to the gates in Heaven. In its Motion for More Definite Statement (P.A. 33(2)) GM inquired if it is charged with infringement of the use of the hinge per se. The Response was (P.A. 43(2)) that infringement is charged by the "use of such structures in automotive vehicles manufactured, used, or sold by defendant." Defendant

persisted, nevertheless, in the defense which Judge Robson and the reviewing court sustained, that the claims were for a hinge per se. Judge Picard's opinion and Judge La Buy's finding No. 18 (Pet. Bk. 16) construed the claims, in the light of the description and drawings, to call for a concealed hinge "for supporting" or "adapted to support" a door.

The second cause of the confusion is due to the contention that '490 claimed a solution of hinging so that the door would move parallel to the ground to cause proper alignment of the door in the opening provided in the body. Since such alignment was disclosed, this result was obvious. As Judge Picard concluded (p.14,15,supra) this was but half the broad problem or another problem. It was not solved wholly in the post-De Soto tumble-in cars, since pinch bars had to be used, and more remained to be done to get satisfactory alignment (Pet. Bk. 5, col. 2,

next to last par.). While Smith pioneered with the inclined axis hinge, Howe eliminated the need for persuasion by a type of hinge which modified the pillar. But part of the broad problem, or another related problem, was to so align that no part of a pintle-type hinge (butt or gooseneck) would protrude beyond the body wall or be visible from either outside or inside the car. Carr's was exposed over the back seat, as well as at the fender which covered it. No combination prior art reference anticipated '490. Absent such a "knockout" reference, shot gun references were resorted to, to show what Howe did was obvious from disclosures in pre-De Soto and post-De Soto art. Of the latter, the closest was Smith and he admitted what Howe did could not be done with pintle hinges, except to add an exposed butt hinge to a concealed gooseneck hinge. To establish its mosaic, the lower courts did not cite which patent was primary and which supported it.

It is established patent law that one reference only can anticipate, but two such references are required to show such disclosures made the claimed invention obvious. (Appendix C will show that the Seventh Circuit holds erroneously that one patent only will thus suffice.) Even so, it is also established law that no prior patent or publication is a valid reference unless it has disclosed the broad problem or the other problem, as involved in the case at bar. Pet. Appendix A shows Smith only was aware of the problem.

C. Brief, page 10-11, quotes Howe's testimony in the trial before Judge Perry as admitting the alignment problem to be the same in the tumble-out art from which the solution was obvious. Slyly, it notes at page 11, after quotes, this impeaching testimony was read to him upon cross in the trial before Judge Robson (P.A. 358). It failed to quote the record accurately and fully, because the cross continued: "Now, are you

changing your testimony now, Mr. Howe?"
A. "Well, I was wrong in that statement, in that I didn't consider the other problems that were attendant with the tumble-in bodies."
Q. "So you are changing your testimony now?"
A. "In that respect, yes."

D. Contrast this with the critical admission against interest by Lutz, its $50 per hour expert, which goes to the heart of the case at bar (DA II, 1599-1600):
Q. "You say that there was nothing <u>new</u> or <u>unexpected</u> in the Howe patent?" A. "That's right."
Q. "Yet, there is not anything in the prior art which shows a pintle-hinge supporting a door in an automobile inclined inwardly in a converging top automobile with a hinge entirely concealed and the inclination on that axis compensated for by the hinge, isn't that true?" * * * A. "Correct, and all of those phrases (a concealed hinge for supporting the door) read on the top hinge of the B.O.P."
Q. "Yet the fact is that in a B.O.P. you have

had to have two hinge means, did you not?" A. "Two hinges, correct." Q. "No car was ever made or ever sold of that variety which had only one top hinge to support the door?" A. "That is correct." Q. "And the top hinge alone can't support the door?" A. "That is correct."

E. In the above respect, the case at bar shows the new and unexpected result which should have been considered as it was in Adams. Other similarities with U.S. v. Adams are the following:

a. Adams was told his invention was fantastic. Smith told the industry that there could be no alignment by pintle hinges alone, that even if one were concealed another had to be exposed for additional support.

b. The U.S. later got a patent as did GM on its assist and adopted Howe. (GM use of Howe hinge. Figures for 1939 - 1955 at DA III 2117-2121, summarized on 2121).

c. The chemical compositions were equivalent in the prior art, but Adams added that little something as did Howe, Judge Picard having pointed out the structural differences.

d. In both the test was applied whether the difference between the claimed inventions and the prior art had an identity of operation and result. They had not, nor was the pre-De Soto prior art purposes the same as Howe's.

e. The lower court did not go seriously into the claim of confidential disclosure because it held Adams could not recover twice.

F. The dissimilarities between '490 and Graham are that the latter did not even describe the flex to support a claim therefor; Graham's own expert testified it was minimal; there was no confidential disclosure and the same substantial degree of secondary considerations, if any, were missing in Graham; there was no such record of experimental history as there was in '490 (DA III 1929; 1854-55; 1785; 1796-97; 1806; 1812-13; 1818-19; 1832-33) which Brief 16 asserts was "pure fantasy".

CONCLUSION

Respondent's Brief states no valid objections to the grant of the writ. The Petition and this Reply show that great departures have taken place in the lower courts from the guidelines laid down by this Court in both Graham and U.S. v. Adams. Appendix C shows the many twilight areas in patent law areas which relate to the issues in the case at bar, and amplifies some in the Seventh Circuit that require resolution. The issuance of the writ is prayerfully prayed.

Respectfully submitted,

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Attorney for Petitioner.

William Hettleman,
Of Counsel

APPENDIX C

The 10 twilight areas in patent infringement litigation needing resolution by this Court are listed in a sequence following more nearly the progress of the cause. The figure within parenthesis indicates the order of its appearance on Pet. 11-12.

AREA

1 (3) Confusion Between Court and Jury Functions.

See Pet. 14-15; Point III, Subject Index. GM's attempt to defeat Howe's right to a jury trial under the 7th Amendment raises the question as to the limitations this Court should place on the determination of the laches or other equitable issues first which, if successful, will defeat that constitutional guarantee. Earle v. Sawyer, 8 Fed. Case No.4247 (Mass.1825); Hotchkiss v. Greenwood, 12 Fed.Case No.6718(Oh.,1848), and Many v. Sizer, 15 Fed.Case No.9056(Mass.1849); were all jury cases involving relative functions in deciding questions of law and of facts. In more recent times, the 5th Cir. cases of Thermo v. Chem.,294 F.2d 486(1961) (an excellent history), and Swofford (1968)(Pet.15); the 9th Cir.cases of Beatty v. Upright, 306 F.2d 626(1962), and Shubin v. U.S. Oil, 313 F.2d 250(1963); and the 10th Cir. case of Admiral v. Zenith, 296 F.2d 708(1961) bear on this question in relation to FRCP 38(a) and 42(b).

One commentator, in 49 J.P.O.S. 130-31,raises the question whether Graham has not eliminated the need for a jury.

2 (7) Divergencies in Various Courts' Interpretations of the Presumption of Validity Under Sec. 282.

See Pet. 30-32; Reply 8. The cases show considerable confusion, even among different panels in the same Cir. as is true in the 7th,as to the

effect of omission of a non-file wrapper reference. Some ignore the omission entirely. Others hold no resumption or inference arises, as it is just as reasonable to suppose it was considered and rejected tho not mentioned. Others say omission weakens, or does not aid the plaintiff, or that it destroys completely the presumption. Others hold one such omission is enough. Others make inquiry whether the omitted reference is the most pertinent, or whether the file wrapper references are of equal or better pertinence.

2d Cir.	David v. Meyerson, 388 F.2d 292 (1968)
3d "	Sperti v. Coca Cola, 399 F.2d (1967)
4th "	Power Curbers v. Etnyre, 298 F.2d 484 (1962)
	Universal v. Kay, 301 F.2d 140 (1962)
	Berry Bros. v. Signon, 317 F.2d 700 (1963)
5th "	Siskow v. Southern, 373 F.2d 866 (1967)
	Metal Arts v. Fuller, 389 F.2d 319 (1967)
	Smith v. Hughes, 396 F.2d 735 (1968)
6th "	Preformed v. Fanner, 328 F.2d 265 (1964)
	F.M.C. v. Myers, 384 F.2d 4 (1967)
	Goodrich v. Rubber Latex, 400 F.2d 401 (1968)
7th "	Crane v. Spitfire, 276 F.2d 271 (1960)
	Ekstrom v. Onsrud, 298 F.2d 765 (1962)
	MMM v. Technical, 309 F.2d 55 (1962)
	Shumaker v. Gem, 311 F.2d 273 (1962)
	Devex v. GM, 321 F.2d 234 (1963)
	Milton v. Potter, 327 F.2d 437 (1964)
	Schnell v. Allbaugh, 348 F.2d 444 (1965)
	Zegers v. Zegers, 365 F.2d 156 (1966)
	Great Lakes v. Reese, 402 F.2d 346 (1968)
9th "	Neff v. Cohu, 298 F.2d 82 (1961)
	Beatty v. Upright, 306 F.2d 626 (1962)
10th "	Admiral v. Zenith, 296 F.2d 708 (1961)

3 (5) What is Meant by Prior "Pertinent" Art?

See Pet. 24; Reply 13-15. Inquiry has ranged far afield at times, depending on construction of claims (Pet.16-17; Reply 12,13-15), into lost art, "accessory" art,etc. The test has been generally if the references show an identity of operation, similarity of results, or similar structural characteristics:

D.C. Cir.	Comm'r v. Deutsche, 397 F.2d 658 (1968)
3d "	Egan v. Modern, 387 F.2d 319 (1967)
6th "	Kaiser v. McLouth, 400 F.2d 36 (1968)

7th Cir. MMM v. Technical, 309 F.2d 55 (1962)
Deyex v. GM, 321 F.2d 234 (1963)
Nordberg v. Jackson, 393 F.2d 192 (1968)
See also 32 Geo.Wash. L.R.656 (1964);
Amer U.L.R. 211 (1964); 35 Geo.Wash.
L.R. 818(1967); 50 J.P.O.S. 214(1968).

9th " Pursche v. Atlas, 300 F.2d 467 (1961)
Beatty v. Upright, 306 F.2d 626 (1962)
Yavitch v. Seewick, 323 F.2d 560 (1963)

4 (1) The Confusion Due to Citing Sec.102 References as Anticipatory Under Sec.103.

1st Cir. Colour Pictures v. Mike,394 F.2d 431(1968)

2d " Continental Can v. Old Domin.,393 F2d 321 (1968)

3d " Rains v. Cascade, 402 F.2d 241 (1968)

4th " Berry Bros.v.Signon,317 F.2d 700 (1963)

6th " Allied Wheel v. Rude,206 F.2d 752 (1953)
Kaiser v. McLouth, 400 F.2d 36 (1968)

7th " Minn.Honey v.Midwest,298 F.2d 36 (1961)
Copease v. Amer.,298 F.2d 772 (1961)
Ekstrom v. Onsrud, 298 F.2d 765 (1962)
Johnson v. Kendall, 327 F.2d 391 (1964)
Milton v. Potter, 327 F.2d 437 (1964)
Briggs v. Diesel, 342 F.2d 573 (1965)
Toro v. Jacobsen, 357 F.2d 901 (1966)
Nat'l Dairy v. Borden,394 F.2d 887 (1968)
Amphenol v. General, 397 F.2d 431 (1968)
Ill.Tool v. Continental,397 F.2d 517 (1968)
Great Lakes v. Reese,402 F.2d 346 (1968)

9th " Ceramic v. Tile, 378 F.2d 283 (1967)
Jeddeloh v. Coe, 375 F.2d 85 (1967)

5 (2) Must Inquiry Be Made Under Sec.103 Into Prior Art Purposes and Results,as Well as Structural Differences?

D.C.Cir. Comm'r v. Deutsche,397 F.2d 658 (1968)

3d " Egan v. Modern, 387 F.2d 138 (1967)

5th " Metal v. Fuller, 389 F.2d 319 (1968)

7th " Crane v. Spitfire,276 F.2d 271 (1960)
Ekstrom v. Onsrud, 298 F.2d 48 (1962)
Devex v. GM, 321 F.2d 234 (1963)
Johnson v. Kendall,327 F.2d 391 (1964)
Welsh v. Chernivski, 342 F.2d 586 (1965)

10th " Admiral v. Zenith, 296 F.2d 708 (1961)

7 (9) How Certain,Clear and Operable Must Foreign Patent or Publications Be?

2d Cir. Rich v. Mitchell,357 F.2d 176 (1966)
Preususs v. GE, 392 F.2d 29 (1968)
6th " Allied Wheel v. Rude, 206 F.2d 752 (1953)

8 (6) How Far Are Disclosures in Non-Anticipatory Art Pertinent to Sec. 103 Obviousness?

2d Cir. Ling Temco v. Kollsman,372 F.2d 263 (1967)
3d " Corning Glass v. Anchor, 374 F.2d 473(1967)
4th " Grinnell v. Va., 401 F.2d 451 (1968)
5th " Nat'l Filters v.Research,383 F.2d 516(1967)
6th " Allied Wheel v. Rude, 206 F.2d 752 (1953)
Preformed v. Fanner, 328 F.2d 265 (1964)
7th " Crane v. Spitfire, 276 F.2d 271 (1960)
Toro v. Jaconsen, 357 F.2d 901 (1966)

9 (8) Erroneous Conclu ions of Law Confused With Erroneous Conclusions as to Facts.

D.C.Cir.Comm'r v. Deutsche, 397 F.2d 656 (1968)
1st " United Shoe v.Industrial,335 F.2d 577(1964)
2d " Royal v. Smith, 295 F.2d 1 (1961)
5th " Swofford v. B&W, 395 F.2d 362 (1968)
6th " Goodrich v. Rubber, 400 F.2d 401 (1968)
7th " Copease v. Amer., 298 F.2d 772 (1961)
P&D v. Winter, 334 F.2d 830 (1964)
9th " Ceramic v. Tile, 378 F.2d 283 (1967)
10th " Admiral v. Zenith, 296 F.2d 708 (1968)

10 (10) No Uniformity Exists Re Consideration of Secondary Indicia of Non-Obviousness,Much Being Left to Trial Judge's "Intuitive Leap."
5th Cir.Smith v. Hughes, 396 F.2d 735 (1968)
6th " G.E. v. Sciaky, 304 F.2d 724 (1962)
7th " Shumaker v. Gem, 311 F.2d 273 (1962)
Great Lakes v. Reese, 402 F.2d 346 (1968

6 (4) What is Meant by "As a Whole" in S.103?

4th Cir. Power Curbers v. Etnyre, 298 F.2d 484 (1962)

UPREME COURT. U. S.

Office-Supreme Court, U.S.
FILED
APR 17 1969
JOHN F. DAVIS, CLERK

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1968

No. 1005

EARL E. HOWE,
Petitioner

vs.

GENERAL MOTORS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

PETITION FOR REHEARING

Warren C. Horton,
208 S. LaSalle Street,
Chicago, Illinois 60604

Attorney for Petitioner.

William Hettleman,
Of Counsel.

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1968

No. 1005

EARL E. HOWE,
Petitioner,

vs.

GENERAL MOTORS CORPORATION,
Respondent.

PETITION FOR REHEARING

To The Honorable Chief Justice and Associate Justices of the Supreme Court of the U.S.:

Comes now EARL E. HOWE, petitioner for certiorari in the above case, and presents this, his petition for a rehearing of the above case; and, in support thereof, shows respectfully:

1. On Monday, March 24, 1969, this Honorable Court entered an order denying the petition for certiorari.

2. That William Hettleman, counsel in this cause, who had been responsible for the preparation of all documents in this Court to date, became quite ill on March 26, 1969, the date of his receipt of notice from the Clerk of this Court of the denial of the petition for certiorari, as evidenced by the attached certificate by Dr. Wesley H. Gregor, the original of which was filed with the Internal Revenue Department in his application for an extension of time for filing his Income Tax Return for the year 1968.

3. That, as will appear from the affidavits attached hereto by George G. Seibert, David D. Mathis, John Shelley, and William Hettleman, through no fault of petitioner, his Reply to the Respondent's Motion in Opposition to the Petition for Certiorari was delivered to the Clerk of this Court on Thursday, March 20, 1969, and it is believed that either the copies of his said

Reply did not reach the members of this Court, or did not reach them before their decision in sufficient time prior thereto for careful study and digest, to the possible great prejudice of your petitioner:

(a) The affidavit of George Seibert recites that a driver of the Associated Air Freight, Inc., on Tuesday, March 18, 1969, picked up a carton containing 40 copies of the Reply, and that the same was delivered at 10:25 P.M. that evening to the United Airlines for Flight 2786 due to arrive in Washington, D.C. on Wednesday, March 19, 1969 at 8:00 A.M.

(b) The affidavit of David D. Mathis evidences the receipt by United Airlines of said carton on Tuesday, March 18, 1969 at 10:25 P.M. (12:25 Airplane Time).

(c) The affidavit of John Shelley indicates that the consignee of Associated Air Freight, Inc.,Rick's Delivery Service, Alexandria, Virginia, picked up said

carton at the United Airlines on Wednesday, March 19, 1969 at 6:00 P.M., and that said Ricks Delivery Service delivered said carton to the office of the Clerk of this Ccurt about the forenoon of Thursday, March 20, 1969.

(d) The affidavit of William Hettleman indicates that United Airlines made no Manifest of any cargo, such as said carton, and hence had indicated no Flight number, nor the time of the departure from Chicago, carrying said carton, or of its arrival in Washington, D.C., which the United Airlines agent admitted to affiant, Hettleman, was highly unusual and irregular.

(e) The affidavit of George Seibert indicates that because of alleged untimely delivery of the Reply these documents may not have been presented to the members of this Court.

(f) Attached to the affidavit of William

Hettleman is the original letter received by him from the Clerk of this Court, signed E. P. Culliman, Chief Deputy, and dated March 10, 1969, which would seem to indicate that the Reply, delivered on or before March 22, 1969, would be timely.

4. Justice requires, in a full consideration of this case, that said Reply be read and studied carefully by this Court because it refutes the Brief in Opposition and shows that there is no valid objection to the grant of the petition for certiorari.

WHEREFORE, it is prayed respectfully that this case be re-opened for further study and consideration by this Court.

Respectfully submitted,

Warren C. Horton

WARREN C. HORTON
208 So. LaSalle Street
Chicago, Illinois 60604
Attorney for Petitioner.

Pursuant to Rule 58, I hereby certify that the foregoing is presented in good faith, not for delay, and is restricted to the grounds specified in par. 2 thereof.

Warren C. Horton

WARREN C. HORTON

9669-71 Allen Avenue
Rosemont, Illinois 60018

STATE OF ILLINOIS)
COUNTY OF COOK) SS.

GEORGE E. SEIBERT, FIRST BEING DULY SWORN, DEPOSES AND SAYS:

1. I AM THE DISPATCHER OF ASSOCIATED AIR FREIGHT LOCATED AT THE ABOVE ADDRESS.

2. ON TUESDAY, MARCH 18, 1969 ONE OF OUR DRIVERS, GEORGE RENTZEL, PICKED UP FROM THE WHITEHALL COMPANY, 320 WEST ADAMS STREET, CHICAGO, ILL. A CARTON CONTAINING FORTY COPIES OF A REPLY, IN ACCORDANCE WITH OUR UNIFORM AIR-BILL, A PHOTO COPY OF WHICH IS ATTACHED HERETO.

3. FROM MY TELEPHONE CONVERSATION WITH THE UNITED AIRLINES, TO WHICH SAID CARTON WAS DELIVERED ON THAT SAID TUESDAY, MARCH 18, AT 10:25 P.M., I WAS ADVISED THAT SAID CARTON WAS ABOARD FLIGHT NO 2786 WHICH LEFT O'HARE AIRPORT, NEARBY CHICAGO, AT 5:00 A.M. WEDNESDAY, MARCH 19TH, AND ARRIVED IN WASHINGTON D. C. AT 8:00 A.M. THE SAME DAY.

4. IN CHECKING INTO THE DELIVERY, OF SAID CARTON IT WAS INTIMATED TO BE UNTIMELY AND MIGHT JUST AS WELL BE DUMPED INTO THE POTOMAC RIVER.

SUBSCRIBED AND SWORN TO ME THIS 15TH DAY OF APRIL 1969.

George E Seibert

GEORGE E SEIBERT
DISPATCHER

H. Stanley Reid

NOTARY PUBLIC

CHIC.

ASSOCIATED AIR FREIGHT INC.
9669-71 ALLEN AVENUE, ROSEMONT, ILLINOIS 60018

STATE OF ILLINOIS } SS.
COUNTY OF COOK

DAVID D MATHIS, FIRST BEING DULEY SWORN, DEPOSES AND SAYS,

1. I AM THE DISTRICT MANAGER OF ASSOCIATED AIR FREIGHT, LOCATED AT THE ABOVE ADDRESS, AND I AM IN CHARGE OF ALL THE RECORDS AT THIS PLACE.

2. ATTACHED HERETO IS A UNITED AIRLINES AIRWAYBILL NUMBER 16 ORD 3016440 C, SIGNED BY ITS AGENT , MR HUGHES, ON MARCH 18, 1969 AT 10:25 PM, EVEDENCING ITS RECEIPT FROM US OF 1 CTN BOOKS, WEIGHING 6 POUNDS, BEING 40 COPIES CONTAINED IN SAID CTN, ADDRESSED TO THE CLERK, SUPREME COURT OF THE UNITED STATES, WASHINGTON D. C. AND CONSIGNED BY US c/o RICKS DELIVERY SERVICE 6 W ALEXANDRIA AVE, ALEXANDRIA VIRGINA.

SUBSCRIBED AND SWORN TO, BEFORE ME THIS 14TH DAY OF APRIL 1969.

DAVID D MATHIS
DISTRICT MANAGER

NOTARY PUBLIC

Associated Air Freight, Inc.
(ATTACHED TO THE G. E. SEIBERT AFFIDAVIT)

MAIN OFFICE:
167-16 146th AVENUE, JAMAICA, N.Y. 11434

UNITED AIRBILL
NON-NEGOTIABLE

AIRBILL NUMBER
020 - 48873

AIRLINE 16-3016440-C

FROM (CONSIGNOR) White Hall Pr. Inc.

CONSIGNOR'S STREET ADDRESS 320 W Cedar

CITY Chicago ZONE 60610 STATE Ill

BY C. Howe

X DECLARED VALUE $ NVD #10

CONSIGNOR'S NO.

DESTINATION AIRPORT (CITY) DCA

CONSIGNEE'S NO.

TO (CONSIGNEE) Clerk Supreme Court of U.S.

CONSIGNEE'S STREET ADDRESS 1 Supreme Court Plaza

CITY Washington D. C. ZONE STATE

CHARGES ☒ PREPAID ☐ COLLECT

NO. OF PIECES	DESCRIPTION OF PIECES AND CONTENTS	WEIGHT	SCALE	RATE	PREPAID CHARGES	COLLECT CHARGES
1	Box Books	6 lbs	7		900	

(ATTACHED TO D. D. MATHIS AFFIDAVIT)

☐ DISTRIBUTION ☒ ASSEMBLY ☐

SHIPPER'S MANIFEST

UNITED AIR LINES

SHIPPER NAME: PSSOCIATED AIR FRT	MASTER AIRBILL NUMBER: 16-ORD-301644 C — PART: C
INSTRUCTIONS TO CARRIER	CONSIGNEE NAME: PSSOCIATED AIR FRT c/o PICKS DLVY. SVC.
	STREET ADDRESS: 6 W. ALEXANDRIA AVE. (1)
	CITY: ALEXANDRIA — STATE: VIRGINIA — ZIP CODE: DCA
DECLARED VALUE: $	DIMENSIONAL WEIGHT
	TOTAL CUBIC INCHES: (202) 836 6363

PIECES	DESCRIPTION (INCLUDE METHOD OF PACKING, MARKS AND NUMBERS)	WEIGHT
1 Pcs	Books	6
TOTAL		TOTAL 22.5

THE ABOVE IS RECEIVED IN APPARENT GOOD CONDITION EXCEPT AS NOTED. BY SIGNATURE: Hough DATE: 1/1 TIME

1 - SHIPPER

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1968

No. 1005

EARL E. HOWE,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent.

AFFIDAVIT OF WILLIAM HETTLEMAN

STATE OF ILLINOIS)
COUNTY OF COOK) SS.

WILLIAM HETTLEMAN, being first duly sworn, deposes and says:

1. That he is of counsel in the above-entitled cause and has been responsible for preparing the documents therein to date;

2. That he had been too ill to proceed further until a few days ago, as evidenced by the attached photocopy of a certificate of Dr. Gregor filed with his application for extension of time to file his 1968 Federal Income Tax Return.

3. That it came to his attention late Friday of last week that an Assistant Clerk of this Court, upon delivery to him of the carton containing Petitioner's Reply to the Brief in Opposition, about the forenoon of Thursday, March 20, 1969, is supposed to have remarked to the delivery messenger that delivery was late and the carton might as well be dumped into the Potomac River.

4. That it would seem the members of this Court may not have had a chance to study the Reply carefully prior to conference on Friday, March 21, 1969, and the decision handed down on Monday, March 24, 1969 denying the Petition for writ of certiorari.

5. That affiant, in the short time left to prepare print and file a Petition to file Reply, commenced an investigation into what transpired following United Airlines' receipt by Hughes, of the carton on Tuesday, March 18, 1969 at 10:25 p.m.

a. A Mrs. Allen of United Airlines at its Chicago office (phone 686-3581) could supply no information as to Air Bill No. 16 Ord. 301 6440C, other than that said carton was unmanifested and had no flight number assigned to it so that she was unable to state when said carton left Chicago or arrived in Washington, D.C., which she admitted to affiant, was quite an unusual and irregular procedure.

b. Mrs. Allen early this morning finally advised affiant that her inquiries for information from the United Airlines office in Washington, D.C. remained unanswered for several days and suggested affiant phone that office directly at 202-783-8095.

c. Affiant promptly dialed said number and spoke to a Mr. Andrews who, upon examination of 16 Ord 301 6440C, stated "Ord" meant O'Hare Airfield, near Chicago; and that "C" meant this carton was part of a cargo whose assembly must first be effected upon arrival in Washington before delivery to the consignees. He

verified the carton's receipt at O'Hare on Tuesday, March 18, 1969 at 10:25 p.m. The Flight 2768 indicated a cargo liner; that its scheduled departure from Chicago was at 5:15 a.m., Wednesday, March 19, 1969 and arrival at Baltimore 7:52 a.m. the same day; that the carton then travelled by surface truck thence to Washington where it must have arrived about 1:30 p.m. the same day; and that a phone call was made by a person unknown, of United Airlines, at 2:45 p.m. the same day to Rick's Delivery Service, Alexandria, Virginia; and that one E. Ricks signed for and picked up said carton at 6 p.m. the same day.

William Hettleman

SUBSCRIBED and SWORN to before me this 16th day of April, 1969.

Marie B. Lemmer
Notary Public

(ATTACHED TO HETTLEMAN AFFIDAVIT)

ROY G. NAGLE, M. D.
WESLEY H. GREGOR, M. D.
700 N. MICHIGAN AVE.
CHICAGO, ILLINOIS 60611

TELEPHONE WH 4-4552

April 9, 1969

Re: Mr. William Hettleman

To Whom It May Concern:

Mr. Hettleman was seen by me on April 7, 1969 for a complete history and physical. He has had a problem with a recent bronchitis which has led to disability over the past month. His inconvenience and trouble with the malady, I would think is sufficient grounds for the extension requested.

W. H. Gregor

Wesley H. Gregor, M.D.

(ATTACHED TO HETTLEMAN AFFIDAVIT)

OFFICE OF THE CLERK
SUPREME COURT OF THE UNITED STATES
WASHINGTON, D. C. 20543

March 10, 1969

AIRMAIL

William Hettleman, Esq.
1350 Astor Street
Chicago, Illinois 60610

Re: Howe v. General Motors Corp.
No. 1005, October Term, 1968

Dear Mr. Hettleman:

Replying to your letter of the 3rd, you are advised that your reply brief will be regarded as timely any time next week, in the above-entitled case.

Very truly yours,

JOHN F. DAVIS, Clerk

By

E. P. Cullinan
Chief Deputy

EPC:bs